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TREATISE

ON

THE PATENT LAW

OF

THE DOMINION OF CANADA,

INCLUDING THE REVISED PATENT ACT, AS AMENDED TO DATE, WITH ANNOTATIONS. THE PATENT OFFICE RULES AND FORMS, GENERAL FORMS, AND FORMS RELATING TO PRACTICE IN THE EXCHEQUER COURT OF CANADA, ETC.

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1894.

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PREFACE.

This work is based on about 1,100 cases, and its object is to provide a Treatise on the Patent Law of Canada from a Canadian standpoint, embodying therein all the reported cases in the different Provinces and in Canada from the earliest dates to the present time, some unreported Ontario Cases and Standard Cases, as well as a large number of the latest English and American decisions of Courts of Last Resort, not to be found in other text books; to analyze the provisions of our Revised Patent Act as amended to date; to point out what are deemed errors and inconsitencies, as well as to suggest improvements, and to endeavor to supply a want long felt by Canadian lawyers, as well as by Solicitors of Patents in this and other countries.

As our present Act has been largely framed on old United States enactments, besides containing matter original to this country, and as in some cases British, and in others United States authorities should be followed, care has been taken to select only those English and United States cases which may be applicable as precedents to the present state of our law or to illustrate differences, and which bear on points of interest most likely to arise in the practice of lawyers in Courts, as well as in the daily practice of

Solicitors of Patents (who may not be lawyers) throughout all parts of the Dominion.

Digests of judgments delivered as late as May, 1894, and which appear in recent reports of cases of interest in U. S. A., England and Canada, have been made and noted.

The text of the Patent Act in the body of this work, as well as in Appendix III., where the various sections have been assembled, includes all amendments up to date; the Acts being noted at the end of each section.

The side notes relating to each of the sections of the Patent Act, as amended to date, have been collected in the Table of Contents at the commencement of this work, so as to indicate briefly the provisions of the Patent Act, and the pages where each of the sections may be found, as well as the notes relating thereto.

Besides the Patent Office Rules and Forms in Appendix I. there will also be found in Appendix II. a number of General Forms relating to Patents and to Practice in the Exchequer Court Canada, in *sci. fa.* and other cases, which may be useful to practitioners in the Courts and in the Patent Office, as well as to inventors. The work also contains an outline of Exchequer Court Practice, also matters relating to Appeals in Patent Cases to the Privy Council, England.

Points of interest bearing on foreign patents and foreign practice generally, are noted, but this branch of the work is necessarily limited; further information can be obtained from Solicitors of Patents.

Seventy years have elapsed since our first Patent Act was passed, and during the whole of this period there has been no Canadian Treatise on Canadian Patent Law, or the work of a Solicitor of Patents; hitherto we have been obliged to rely entirely on American and English text books, which, in many respects, are manifestly inapplicable; this, obviously, should not continue to be the case.

As a pioneer work this is intended to be adapted to our own Patent Act as amended to date, and is put forward with some misgivings, for errors and oversights are likely to occur. If, however, it prompts discussion, and directs attention to various matters of importance, to lawyers, Solicitors of Patents, and inventors generally, a useful end will be attained, and the work may be, as it is hoped, the forerunner of an improved state of the law, and of an improved series of Canadian text books.

As the country grows, the legal business in the Courts in this branch of the law, as well as in the soliciting of Patents, must increase in volume and importance, and will call for specially trained men who are not only lawyers, but also mechanical, electrical, and chemical experts, competent as draftsmen, and who have a large stock of general information relating to the arts and sciences generally, and thus this somewhat difficult, but interesting branch of the law, now occupied by Solicitors of Patents, may be elevated to the rank of a science, instead of being left, in its present unsatisfactory state, as a means of livelihood for any unqualified person.

Having had nine years' experience as a Solicitor of Patents, and having acted both as Counsel and Solicitor in some of the most important causes in our Ontario and Dominion Courts, the author trusts that in putting forward this work as the result of some of his experince, he may be of assistance to the legal profession in Canada, as well as to the large number of Patent Solicitors in this and other countries who do business with our Patent Office, and that he may also advance the interests of many inventors and manufacturers who are interested in the Patent Law of Canada and its administration, and in the procuring of properly prepared specifications, claims, and drawings of all degrees of complexity, and relating to all classes of subjects.

JOHN G. RIDOUT.

TORONTO, 22nd August, A.D. 1894.

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Should be 4, Geo. IV., c. 25	l. 17, p. 3
Should be "invention or" instead of "invention of"	l. 5, p. 4
Should be 1 Wm. IV., c. 24	l. 24, p. 5
Should read "an article" for "a patent"	l. 25, p. 7
"Named" to be inserted after "arbitrator"	l. 29, p. 11
Add after "document," "affecting or"	l. 22, p. 19
"Insufficiently," for "sufficiently"	l. 34, p. 107
Should be "Estey v. Burdett" instead of "Esky v. Burdett"	l. 13, p. 137
Humpherson v. Syer "4 Rep. Pat. Cas." instead of "4 Web., Pat. Cas."	l. 33, p. 144
Read "Intermediate" for "Immediate" in block letter head	l. 22, p. 189
"Diverted" for "divested"	l. 3, p. 256
"Rollins v. Hinks" for "Rollers v. Hinks"	l. 23, p. 261
"Invalidity" for "validity"	l. 12, p. 292
"5 Fisher" for "4 Fisher" (Baldwin v. Bernard)	l. 10, p. 300
"Decree" to be substituted for "writ" on lines 12, 13 and	16, p. 308
Should be read "Prouse v. Pagnuelo, 2 L. C. R.," instead "2 S. C. R."	l. 28, p. 312
"The London and Leicester Hosiery Co." for "The London and Lancashire Hosiery Co."	l. 25, p. 314
"The Courts hould fix the amount" instead of "to fix," etc., in block letter head line	l. 35, p. 359
Substitute "licensor" for "licensee" on last line of	p. 496
The word "Under," in front of 12 Vic., ch. 24, sec. 22, to be struck out	l. 30, p. 520

ABBREVIATIONS.

N.B.—THOSE CASES MARKED WITH ASTERISK REFER TO CANADIAN WORKS.

Ala.....Alabama Supreme Court.
Allen (Mass.).....Allen's Massachusetts Supreme Court Rep.
App. Cas.....Appeal Cases. English House of Lords and Privy Council.
*App. R., Ont.....Appeal Reports, Ontario.

B. & A .....Barnewall & Alderson's Reports, K. B.
B. & Ad.....Barnewall & Adolphus Reports (Eng.).
B. & C.....Barnewall & Cresswell's Reports, K. B.
B. & P.....Bosanquet & Puller's Reports, C. P.
B. & S.....Best & Smith's Reports, Q. B.
Ban. & Ard.....Banning & Arden's Circuit Court Rep., U. S.
Barb. (N. Y.).....Barbour's New York Supreme Court.
Beav.....Beavan's Reports, Rolls Court.
Bing. N. C.....Bingham's New Cases, C. P., Eng.
Bissell.....Bissell's Circuit Court Cases, U. S.
Black.....Black, U. S. Supreme Court.
Blackf.....Blackford, Indiana Supreme Court.
Blatch.....Blatchford's Circuit Court Rep., U. S.
Bond.....Bond's U. S. Circuit Court Rep., 6th Circuit.
Brodix.....Brodix, English and American (Sup. Ct.) Patent Cases.
Bump .....Bump on Patents, 2nd Edition.
Bush (Ky.).....Bush, Kentucky Court of Appeals.

C. B. (N. S.).....Common Bench New Series (Eng.).
C. D.....Commissioner's Decisions (U. S.).
C. and F.....Clark & Fennelly's House of Lords Cases.
C. L. R.....Common Law Reports.
C. M. & R.....Crompton, Meesan & Roscoe's Reports (Eng.).
*C. S. C.....Consolidated Statutes of Canada.
*C. S. U. C.....Consolidated Statutes of Upper Canada.
Cal.....California Supreme Court.
*Can. L. J.....Canadian Law Journal.
*Can. L. T.....Canadian Law Times.
Car. & Kir.....Carrington & Kirwin's Reports.
Car. & M.....Carrington & Marshman.
Car. & P.....Carrington & Payne's Reports, N. P.

(1893) Ch. Vol. 1 ....Law Reports Chancery, Vol. 1, for 1893.
*Cassels' Digest.....Cassels' Digest of Supreme Court Decisions.
Ch. Ap.....Chancery Appeal Cases (Eng.).
Ch. Div.....Chancery Division Law Reports (Eng.).
Chit. Prerog.....Chitty's Prerogatives of the Crown.
Cl. & F.....Clarke & Finelly's Reports, House of Lords.
Cliff .....Clifford's U. S. Circuit Court Reports.
Collier.....Collier on Partnership, 2nd Ed.
Conn.....Connecticut Supreme Court of Errors (U. S.).
*Con. Stat. Can.....Consolidated Statutes of Canada.
Cow. N. Y.....Cowen, New York Supreme Court and Court of Errors.
Cranch.....Cranch, United States Supreme Court.
Curt.....Curtis, U. S. Circuit Court Rep., 1st Circuit.
Curtis.....Curtis on Patents, 4th Edition.
Curtis C. C.....Curtis Circuit Court Cases (U. S.).

De G. & J.....De Gex and Jones' Reports Chancery (Eng.).
De G., F. & J. .....De Gex, Fisher & Jones' Reports, Chancery.
De G., J. & S. .....De Gex, Jones & Smith's Reports.
De G., M. & G .....De Gex, Macnaghten & Gordon.
Daniels.....Daniels' on Patents (Eng.).
Dill.....Dillon's U. S. Circuit Court Rep, 8th Circuit.
Duer (N. Y.).....New York City Superior Court.
Duryee.....Duryee on Assignments of Patent Rights.

Edmunds.....Edmunds on Patents (Eng.), 1890.
El. & Bl.....Ellis & Blackburn Reports, Q. B.
Ex. R.....Welsby, Hurlstone & Gordon's Reports.
*Ex. Ct. R. Can.....Exchequer Court Reports (Can.).

Fed. Rep.....Federal Reporter (U. S.).
Fisher.....Fisher's Circuit Court Patent Cases (U. S.).
Frost.....Frost on Patents (Eng.).

Gall.....Gallison, U. S. Circuit Court, 1st Circuit.
Gilpin.....Gilpin, U. S. District Court, Eastern District of Pennsylvania.
Goodeve.....Goodeve's Patent Cases (Eng.).
*Grant.....Grant's Chancery Reports, Upper Canada and Ontario.

H. L.....House of Lords.
H. & N.....Hurlstone & Norman's Reports Ex. (Eng.).
Hem. & M.....Hemming & Miller, Chancery (Eng.).
Higgins' Digest.....Higgins' Digest of Patent Cases (Eng.).
Hindmarch.....Hindmarch on Patents (Eng.).
Holmes.....Holmes U. S. Circuit Court, 1st Circuit.
How.....Howard's Reports, Supreme Court (U. S.).
Hughes.....Hughes' U. S. Circuit Court Reports, 4th Circuit.
Hun. N. Y.....Hunter's New York Circuit Court Reports (U. S.).
Hy. Bl.....Henry Blackstone Reports (Eng.).

Ind.....Indiana Supreme Court.
Inst.....Coke's Institutes.
Iowa .....Iowa Supreme Court (U. S.).

J. N. S.....Jurist New Series.
John.....Johnson's Reports, Chancery.
Jones (N. C.).....Jones' North Carolina Supreme Court in Equity.
Jur. N. S.....Jurist New Series (Eng.).

K. & J.....Kay & Johnston's Reports, Chancery.
Kay.....Kay's Reports, Chancery.
Kerr on Inj.....Kerr on Injunctions.

*L. C. .....Lower Canada.
*L. C. J.....Lower Canada Jurist.
*L. C. R.....Lower Canada Reports.
L. J.....Law Journal Reports in all the Courts.
L. J. Ch.....Law Journal Chancery.
*L. N.....Legal News, Lower Canada.
L. R. Ch.....Law Reports Chancery Appeal Case (Eng.).
L. R. Ch. D.....Law Reports Chancery Division (Eng.).
L. R. E. & I. App...English and Irish Appeal Cases.
L. R. Eq.....Equity Cases (Eng.).
L. R. Ir.....Law Reports, Ireland.
L. T.....Law Times.
L. T., N. S. .....Law Times, New Series (Eng.).
L. T. R., N. S .....Law Times Reports, New Series.
Lev.....Levintz Reports, K. B.

N.B.—Since January 2nd, 1893, L. R. is omitted when referring to The English Reports and the year (1893), etc., takes its place.

M. & W.....Meeson & Welsby's Reports (Eng.).
Mac. & G.....Macnaghten & Gordon's Reports, Chancery.
Man. & G.....Manning & Granger.
Mason.....Mason's U. S. Circuit Court Reports, 1st Circuit.
McLean.....McLean U. S. Circuit Court Reports, 7th Circuit.
Me.....Maine Supreme Court.
Mer.....Merivale's Reports, Chancery.
Merwin.....Merwin on Patentability of Inventions (U. S.).
Mich.....Michigan Supreme Court.
Mod.....Modern Cases or Modern Reports.
My. & Cr.....Mylne & Craig's Reports, Chancery.
Myers F. D.....Myers' Federal Decisions.

N. H.....New Hampshire Supreme Court.
N. R.....New Reports, Bosanquet & Pullen C. P.
N. Y.....New York Court of Appeals.

O. G. ....Official Gazette, United States Patent Office.
Ohio St. .....Ohio State, Ohio Supreme Court.
*Ont. App. R. .....Ontario Appeal Reports.
*Ont. Dig. ....Ontario Digest (1880–1890).
*Ont. R. .....Ontario Reports.

P. C. .....Privy Council.
Pa .....Pennsylvania Supreme Court.
Pen. N. J. Rep. .....Pennington New Jersey Supreme Court Reports.
Peters .....Peters' U. S. Supreme Court Report.
Pick (Mass.). .....Pickering Massachusetts Supreme Court Report.
P. O. News. .....The Patent Office News (U. S.).
P. O. R. .....Patent Office Reports, Eng. (Cutler). See R. P. C.
*Prac. Rep. (Ont.). ..Practice Reports (Ontario).

Q. B. .....Adolphus & Ellis, Queen's Bench Reports, New Series.
(1893) Q. B. V. I. ....Law Reports Queen's Bench Division, V. I. for 1893.
*Q. L. R. .....Quebec Law Reports.
*Q. L. R., S. C. .....Quebec Law Reports, Supreme Court.

Renwick .....Renwick on Patentable Invention.
*R. L. .....Revue Legal (Quebec).
R. S. .....Revised Statutes (U. S.).
*R. S. O. .....Revised Statutes Ontario.
*R. S. C. .....Revised Statutes of Canada (D).
R. P. C. ....Reports of Patent Cases, Eng. (Cutler). See P. O. R., otherwise abreviated O. R., Official Reports.
R. P. S. .....Revised Patent Statutes (U. S.).
Rich. (S. C. Law Rep.). Richardson's South Carolina Law Reports.
Robinson. .....Robinson on Patents.
Russ. .....Russell's Reports, Chancery.

Salk. .....Salkeld Reports, K. B.
Sawyer. .....Sawyer, U. S. Circuit Court Rep., Northern Circuit.
Sedgwick. ....Sedgwick on Damages.
Stark. .....Starkies' Reports, N. P.
Story. .....Story's U. S. Circuit Court Reports, 1st Circuit.
Sumn. .....Sumner's Circuit Court Reports (U. S.).
*Sup. Ct. R. (Can.). .Supreme Court Reports (Can.).
*S. C. R. .....Supreme Court Reports (Can.).
Sup. Ct. U. S. .....Supreme Court United States.

T. Rep. .....Term Reports (Dumford & East) K. B.
Terrell. .....Terrell on Patents, 1st Edition.

*U. C. .....Upper Canada.
*U. C. C. P. R. .....Upper Canada Common Pleas Reports.
*U. C. Q. B. R. .....Upper Canada Queen's Bench Reports.
U. S. .. ..United States Supreme Court Reports.
U. S. or U. S. A. ....United States or United States of America.
U. S. C. Ct. of Appeals. United States Circuit Court of Appeals.

Vt.....Vermont Supreme Court.

W. N.....Weekly Notes (Eng.).
W. R.....Weekly Reporter (Eng.).
Walker.....Walker on Patents (U. S.).
Wall.....Wallace's Supreme Court Reports (U. S.).
Wallace.....Wallace on Patents (Eng.).
Wash.....Washington, United States Circuit Court, 3rd Edition.
Web. P. C.....Webster's Patent Cases.
Wend. (N. Y.).....Wendell's New York Supreme Court and Court of Errors.
Whart. (Pa.).....Wharton's Pennsylvania Supreme Court.
Wis.....Wisconsin Supreme Court.
Wood .....Wood's U. S. Circuit Court Reports, 5th Circuit.

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CHAPTER I.

Review of Legislation Relating to Patents of Invention in the Various Provinces Prior to and Subsequent to Confederation.

Before referring to our prior legislation, it may be well to touch briefly on the earliest patent enactment for English speaking people.

There is no common law right to the grant of Letters Patent of invention, and the grant of Letters Patent in Great Britain is not a right which may be demanded, but is discretionary on the part of the Crown. This discretion was exercised during and most probably prior to the reign of Edward III: See Year Book, Part IV., 40 Edward III., and was preserved by the Statute of Monopolies, 21 James I., c. 3.

Prior, however, to "The Statute of Monopolies," a royal grant of an exclusive privilege to manufacture playing cards within the realm, or of an exclusive privilege, without limitation, to import and sell such cards, was held to be void: See *Darcy* v. *Allein*, King's Bench, 1602.

In the Cloth Workers of Ipswich Case, King's Bench, 1615, it was held, before the Statute of Monopolies, that the Crown has not the general power to grant to a corporation a monopoly of a particular trade; but if a man has made a discovery or brought a new trade within the kingdom, the Crown, in recompense of his expenditure, may grant him an exclusive right for a limited time.

The foundation of the present patent law in the United Kingdom is section 6, 21 James I., c. 3, which obtained the royal assent March 24th, 1624, and is the first positive patent enactment for English speaking people; the Statute of Monopolies was merely declaratory of the common law existing at that time, which pro-

vided against monopolies and exclusive rights to manufacture or sell, and this section 6, as an exception to the general rule, enacts as follows:

"Provided, also, and be it declared and enacted, that any declaration before mentioned shall not extend to any Letters Patent and grants of privilege for the term of fourteen years or under, hereafter to be made for the sole working or making of any manner of new manufactures within this realm to the true and first inventor or inventors of such manufactures, which others, at the time of making such Letters Patent and grants shall not use, so as they shall not be contrary to law nor mischievous to the State, by raising prices of commodities at home or hurt of trade, or generally inconvenient. The said fourteen years to be accompted from the date of the first Letters Patent or grant of such privilege hereafter to be made, but that the same shall be of such force as they should be if this Act had never been made, and of none other."

Under the Statute of Monopolies, an importer or first introducer into the realm was considered the true and first inventor. The present form of British patent follows the spirit of this section and provides, that if the grant be shown to be contrary to law or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof within the United Kingdom of Great Britain and Ireland and the Isle of Man, or that the said patentee is not the first and true inventor within the realm, it shall be void.

The British Patent Act, however, does not affect Canada, except in so far as section 103 relating to International arrangements for protection of inventions.

In *Adams* v. *Bell et al.*, 1 L. C. R., 130, 1850, it was held, that Letters Patent granted under Her Majesty's privy seal in England are of no force in Canada, Letters Patent having no other force than that given by our Provincial Statutes.

The history of legislation relating to patents of invention dates back in Lower Canada to 1823, and in Upper Canada to 1826. Previous to these dates, there do not appear to have been any Acts passed relating thereto in either of these Provinces.

As very little is known on the subject of our patent laws, and as seventy years have elapsed since the date of our first Patent Act without any commentary or text book of any kind on the Canadian Patent Law, it may be of interest to briefly review

some of the leading features of the various previous Acts, and to show in some measure how they have been revised, modified and altered down to the present time, and to see in what respect any of the old enactments have been retained in our present Patent Act and amendments thereto.

4 GEO. IV., c. 25 (1823), L. C.

The earliest Statute on Patents found in the legislation of the Provinces now constituting the Dominion, is the Act of Lower Canada, 4 Geo. IV., c. 25, entitled "An Act to promote the progress of useful arts in the Province." It appears to have been derived from the United States Act of 1793.

7 GEO. IV., c. 5 (1826), U. C.

The first Patent Act of the Province of Upper Canada was 7 Geo. IV., c. 5, passed 30th January, 1826, being "An Act to encourage the progress of useful arts within this Province."

This was the same Act as enacted in the Province of Lower Canada, by 7 Geo. IV., c. 5, firstly referred to.

The preamble of the Act states: "Whereas it is expedient for the encouragement of genius and of arts in this Province to secure an exclusive right to the invention of any new and useful art, machine, manufacture or composition of matter," etc.

This definition of the subject matter of an invention is of the same wording as that in section 7 of our present Patent Act.

The Act of 1826 requires that the invention should not "be known or used before the application" while our present Act requires that the invention should "not be known or used by any other person before his invention thereof."

In *Vannorman* v. *Leonard*, 2 U. C. Q. B. R., p. 72 (1845), Robertson, C. J., points out the distinction between the 6th section of the English Act, 21 James I., c. 3, exempting patents of invention from the sweeping provisions of the Act (The Statute of Monopolies), and the 6th clause of the Provincial Act, 7 Geo. IV., c. 5, and shows that our Act does not, like the English Act, speak of "new manufactures within this realm," but on the contrary, it requires the applicant in Canada to swear that he was the true inventor or discoverer of the art, which no one could do who merely imported the invention.

By this Act, 7 Geo. IV., "any subject of His Majesty, being an inhabitant of this Province," could obtain a patent for an invention for a term not exceeding fourteen years for the full and exclusive right and liberty "of making, constructing, using or vending to others to be used, the said invention of discovery," which is the same wording as still appears on our present Patent Deeds.

This Act also provided for the granting patents for improvements on the principle of a patented article, but this did not give the right to use the original invention, nor that the first inventor shall be at liberty to use the improvement, and provides that simply changing the form or proportion of any machine or composition in any degree shall not be deemed a discovery.

"Any person making, manufacturing or making use of any machine or instrument so invented *without the consent in writing* of the patentee, etc., shall be liable to such damages as shall be awarded by a jury, and the party injured shall receive treble costs" (s. 5).

This Act requires that the consent should be in writing, the same as by section 29 of the present Patent Act, and it also provides for a jury trial and for treble costs; both of which have no part in our present practice.

By way of defence (section 6), it might be shown that the patent contained more or less than the truth, which concealment or addition shall have been made for the purpose of deceiving the public, or that it was originally discovered by the patentee, but had been in use or described in some work anterior to the supposed discovery.

Provision was made (section 7) for the determining as to *interfering applications* by three arbitrators; one to be chosen by each of the parties, and one by the Secretary of the Province.

A patent fraudulently, improvidently or surreptitiously obtained, or obtained upon false suggestion, or that the patentee was not the true inventor or discoverer (section 8), might be impeached by any one within three years after the issuing of such patent by *sci. fa.* in the Court of King's Bench.

The same fees were payable as for other instruments under the great seal; one per cent. per folio of seventy-two words, and ten shillings for affixing the seal.

This Act, 7 Geo. IV., c. 5, for Upper Canada, was repealed by 14 and 15 Vic., c. 79 (1851), hereafter referred to.

9 GEO. IV., c. 47 L. C. (1829).

In 1829, 4 Geo. IV., c. 25, for Lower Canada, first referred to, was continued by 9 Geo. IV., c. 47, and its benefits extended to any subject of His Majesty, being an inhabitant of the Province, who should in his travels in a foreign country have discovered or obtained a knowledge of and be desirous of introducing into the Province any new and useful invention not known or used in the Province before his application.

1 WM. IV., L. C., c. 24, L. C. (1831).

In 1831, inventions in the United States and in His Majesty's dominions in America (1 Wm. IV., L. C., c. 24), were withdrawn from the operation of the last mentioned enactment.

In 1851, it will be seen that by 14 and 15 Vic., Can., c. 79, inventions in the United States and in His Majesty's dominions in Europe and America were withdrawn from the operation of a similar enactment. And in this latter shape, it reappears in section 10 of the Consolidated Statutes of Canada, c. 34 (1859), and continued in force till repealed by the Patent Act of 1869.

6 WM. IV., c. 34, L. C. (1836).

In Lower Canada in 1836, the Act 6 Wm. IV., c. 34, "An Act to repeal certain Acts therein mentioned, and to consolidate the provisions therein made for the encouragement of useful arts," formed the Revised and Consolidated Patent Act for the Lower Province, 4 Geo. IV., c. 25, and 1 Wm. IV., c. 34, L. C., just mentioned, were repealed, and their provisions re-enacted.

Until after the union of the two Provinces of Upper and Lower Canada, there was no change in the patent law of either of these Provinces.

12 VIC., c. 24 (1849), CAN.

The next Act of the Province of Canada after the union, was 12 Vic., c. 24, passed 30th May, 1849, being "An Act to consolidate and amend the laws and patents for invention in this Province," which recites that 6 Wm. IV., c. 34, was in force in Lower Canada, and 7 Geo. IV., c. 5, in Upper Canada, and that they differed, and that it was necessary to assimilate the laws and provisions.

This Act provides (section 1), that any person a resident of this Province and a subject of Her Majesty, who had discovered or invented any new and useful art machine, manufacture or composition of matter, etc., or "the principle thereof," might obtain a patent; this was erroneous, as a principle could not be patented, and, consequently, the words or "the principle thereof," were struck out subsequently by 14 and 15 Vic., c. 79.

Under this Act, the invention must be one "not known or used *in this Province* by others before his or their invention or discovery thereof, and not at the time of the application for a patent in public use or on sale *in this Province*, with his consent or allowance as the inventor thereof."

In *Bernier* v. *Beauchemin*, 5 L. C. J., 29 Q. B. (1859), held, on appeal, that the plaintiff having sold a large number of stoves before obtaining the patent, the patent was null and void.

In *Ritchie* v. *Joly*, 12 L. C. R., 49 Q. B. (1861), the patentee must be the sole and only inventor of the thing patented.

In *Driggs* v. *Baird et al.*, 13 U. C. Q. B. (1856), Robinson, C. J., refers to 12 Vic., c. 24, and 14 and 15 Vic., c. 79, and states "that it appears to me to be the obvious meaning of the statute that the inventor must be an inhabitant of Canada as well as a British subject when he made the discovery, which certainly is not the case here," and intimates that the invention having been first patented in the United States could not thereafter be the subject of a patent in Canada.

The issue was to be tried by a jury, and the same provision as to treble costs in addition to damages appears.

The following was introduced as a proviso (section 2) relating to an action for damages, and subsequently appeared in Consolidated Statutes Canada, c. 34 (1859), sec. 25, viz.: "If the patentee believed himself to be the first inventor, the patent shall not be void on account of the invention or discovery, or part thereof, having been known or used in a foreign country, it not appearing that the same or any material or substantial part thereof had before been patented or described in any printed publication."

This provision, by the Patent Act of 1869, disappeared from our statutes, but in the United States now, a thing may be known and used in foreign countries, but if not introduced into the States or published in a printed publication, may be the subject of a patent in the States. By the 15th section of the United States Patent Act of 1836, a provision similar to the one referred to in Consolidated Statutes Canada, c. 34 (1859), sec. 25, was

enacted; the Canadian section was probably taken from this United States Act.

DISCLAIMER.

There is also a provision as to disclaimer for the first time (section 8), for if the plaintiff fails to sustain his case, on the ground that he claimed more than that for which he was first inventor, but defendant had used part justly claimed as new, the Court may adjudge and award as to costs.

Provision is made for legal representatives taking out Letters Patent.

REISSUE.

A patent may be reissued if error shall have arisen through inadvertency, accident or mistake, and without fraudulent or deceptive intention, and there might be a reissue for additions to an existing patent.

SPECIFIC MACHINE.

By section 22, 12 Vic., there is a provision as to the use of any "specific machine," prior to the application for a patent, which is discussed and set out in full hereafter in the body of this work under section 46.

DESIGN PATENTS.

By this Act, 12 Vic., c. 24, Design Patents were issued for seven years, which was a new provision.

MARKING PATENTED.

By section 16, for marking a patent wrongfully "as patented," there was a penalty of fifty dollars or two months' imprisonment, or both. And there were the same penalties for neglecting to mark the article as patented.

These provisions as to marking appear for the first time.

By section 17, the proceedings for the repeal of a patent by *sci. fa.* must be instituted within two years of the date of the patent or on the term of Court next after the said two years, and not after; this provision appears again as section 20 of the Consolidated Statutes of Canada, c. 34 (1859).

14 AND 15 VIC., C. 79 (1851), CAN.

"An Act to enable parties holding patents for inventions confined to one section of this Province to obtain the extension thereof to the other section thereof, and for other purposes therein mentioned."

This Act was passed by the Parliament of Canada, and relates to patents issued under Provincial Acts prior to the union between Upper and Lower Canada, and authorized their extension to that portion of Canada, not embraced by the patent already issued.

There was a proviso as to those using the invention in other parts of Canada before any application under this Act, that such users may have the right to use the specific machine, manufacture or composition of matter so actually constructed, purchased or used.

The Upper Canada Act, 7 Geo. IV., c. 5 (1826), and the Lower Canada Act, 6 Wm. IV., c. 34 (1836), were repealed by this Act.

By section 3, patents were *granted for fourteen years*, and were examined by the law officers of the Crown.

By section 7, any person making, manufacturing or using the patented article without the written consent of the patentee, shall be liable to damages and treble costs as taxed, as provided by the previous Act.

By section 8, the patent may be declared void, if the invention had been in use or had been described in some public work anterior to the supposed discovery; this section is broad, and requires novelty, both as to Canada and elsewhere, in the same way as the Act 7 Geo. IV., c. 5, required.

FIRST INTRODUCER INTO CANADA.

By section 11 of this Act of 1851, there was a strange provision (analogous to the English Act), whereby the first introducer into Canada was considered entitled to a patent; it provided that travellers, subjects of Her Majesty and inhabitants of Canada, bringing inventions from foreign countries, not known and not in use in the Province prior to their application for a patent, might obtain a patent; but this was not to extend to inventions made or discovered in the United States or any part of Her Majesty's dominions in Europe or America, or to prevent the free importation from such places; and by section 12, the traveller had to make a declaration that he had obtained a knowledge of the invention while travelling in some foreign country other than the United States or Her Majesty's dominions in Europe or America.

This Act of 1851 was subject to all the provisions in 12 Vic., c. 24 (1849), and the words "or the principle thereof in sec. 1 of 12 Vic., c. 24," were struck out.

16 VIC., C. 11 (1852), CAN.

By 16 Vic., c. 11, "An Act to provide for the establishment of a Bureau of Agriculture," etc. The Minister of Agriculture was to receive all applications, specifications and models for patents and to keep the records; the jurisdiction was transferred from the Provincial Secretary to the Minister of Agriculture.

20 VIC., C. 33 (1857), CAN.

By 20 Vic., c. 33, assented to June 10th, 1857, "An Act to extend patents for inventions granted for one section of the Province to both sections thereof on certain conditions."

By this Act, patents issued between the date of the union between Upper and Lower Canada (1840) and the Act of 1849 were extended to the whole Province of Canada, and the privileges of the Act of 1849, and of the Act of 1851, were also extended to them.

By the Act of 1849, provision had been made for extending the protection of the patent laws to patents issued in Upper and Lower Canada after 1849 to the whole Province of Canada. And by the Act of 1851 those patents issued in Upper and Lower Canada before the union in 1840 were also extended to the whole Province of Canada.

But until this Act no provision had been made for those patents issued in the Provinces between the date of the union in 1840 and 1849.

C. S. C., U. C., c. 21 (1859).

By C. S. of U. C., c. 21,22 Vic. (1859), "An Act respecting the practice and procedure in suits instituted on behalf of the Crown in matters relating to the revenue and the repeal of Letter Patent," provided, that Supreme Courts may issue writs of *scire facias* to repeal Letters Patent and that the practice shall be the same as in England, and that the *fiat* of the Attorney-General was to be obtained, and that an exemplification of the Letters Patent was to be filed, on which the writ of *scire facias* was to be founded.

C. S. C., c. 34 (1859).

Con. Stat. Canada, c. 34 (1859), 22 Vic., "An Act respecting patents of invention" (repealed by Patent Act, 1872). The provisions of 12 Vic., c. 34 (1849) and of 14 and 15 Vic., c. 79, were consolidated. And in the interpretation of the Act the expression "useful art, machine, manufacture or composition of matter" includes any such thing herein referred to, "whether it be made by hand or machinery or by both of these means."

The patent was issued for fourteen years.

There was a provision for extending the term of a patent by a Board, consisting of the President of the Executive Council, the Attorney-General and the Minister of Finance.

There was no power under this Act to grant an injunction or to order the keeping of an account, which machinery, however, was provided in Upper Canada by C. S. U. C., c. 23 sec. 12 (1859), "An Act respecting writ of mandamus and injunction." *Vide Huntingdon* v. *Lutz*, 13 U. C. C. P. R., p. 168.

DESIGN PATENTS.

By section 4, there was a provision for obtaining patents for designs and works of art as was the case in 12 Vic., c. 24, ten years previously, and this section 4 defines, for the first time, what a design is; whereas, in the "Trade Mark and Design Act" Rev. Stat. Can. 49 Vic., c. 63 (1886), there is no such definition.

DEFINITION.

By this section 4, the design relates to any "manufacture, whether of metals or mixed metals or other materials, or any new and original design for the printing of woollen, silk, cotton or other fabrics, or any new and original design for a bust, statue or bas relief, or composition in alto or bas relief, or any new and original impression and ornament, the same being formed in marble or other material, or any new or useful pattern in print, or print or picture to be worked or cast, printed or painted on or otherwise fixed on any article of manufacture," etc. The wording of this section is similar to section 4,929 of the United States Revised Statutes, and should be retained or re-enacted in our present Trade Mark and Design Act. Section 11 of the Trade Mark and Design Act of 1861 is still in force in Canada, and may be available for that definition of a Design which is wanting in our present Act.

By sections 10 and 11, sections 11 and 12 of the Act of 1851,

relating to the first introducers into Canada of inventions brought from foreign countries by subjects of Her Majesty and inhabitants of Canada, was re-enacted, which was finally repealed by the Act of 1869.

Section 21 provides that simply changing the form or the proportion of any machine or composition is not patentable.

By section 22 the proceedings on the repeal of a patent by *sci. fa.* were to be according to the law and practice of the Court of Queen's Bench in England. In *The Queen* v. *Hall*, 27 U. C. Q. B. 146, 31 Vic. (1867), it was held that the effect of this section was to introduce the Imperial Act, 15 and 16 Vic., c. 83, and that particulars of the breaches should have been delivered along with the declaration.

The Con. Stat. Can., c. 34 was repealed by the Patent Act of 1872 so far as it was inconsistent with the Act of 1872, except as to rights accrued or penalties incurred before the coming into force of this last Act.

Patent Act Amendment (1866), 29 Vic., c. 19, Can.

In 1866 "An Act to amend c. 34 C. S. C., relating to patents of invention" (assented to August 15th, 1866), was passed, and related to interfering applications, and provided that an oath should be taken by the arbitrators referred to in sec. 15 C. S. C., c. 34, who could summon witnesses to give evidence on oath, and that any wilfully false statement should be deemed a misdemeanour and be punishable in the same manner as wilful and corrupt perjury; but no witness should be compelled to answer a question so as to lay himself open to a criminal prosecution.

The fees of the arbitrators to be paid by the parties naming them, and those of the third arbitrator by the Minister of Agriculture, to be paid jointly.

The Patent Act of 1869, 32, 33 Vic., c. 11, Can.

In 1869 "An Act respecting patents of invention" was passed and assented to 22nd June, 1860.

This was the first Canadian Patent Act passed since "Confederation," and the Patent Office was constituted for the first time.

The Minister of Agriculture was made Commissioner of Patents of Invention, and his Deputy was made Deputy Commissioner of Patents.

Section 6 provided that "Any person having been a resident of Canada *for at least one year* before his application, and having invented or discovered any new and useful art, machine, manufacture or composition of matter, etc., not known or used by others before his invention or *discovery* thereof, and not being at the time of his application for a patent in public use or on sale *in any of the Provinces of the Dominion*, with the consent or allowance of the inventor or discoverer thereof, may on petition to the Commissioner, etc.; but no patent shall issue for an invention or discovery having an illicit object in view nor for any scientific principle or abstract theorem."

By this Act aliens, as well as British subjects, provided they have been residents of Canada for at least one year before application, may obtain a patent; this is enacted for the first time; and the Act required that the invention should not have been in public use or on sales in any of the Provinces of the Dominion, and that it should not be known or used by others before the invention thereof.

So that the Act, apparently, required absolute novelty as to the world, and did not permit of prior use or sale in any of the Provinces of the Dominion, and therein differs from our present Act, which admits of prior use or sale, with the consent or allowance of the inventor, for a period of one year prior to application.

In *Bonathan* v. *Bowmanville Furniture Manufacturing Co.*, 31 U. C. Q. B. R., p. 413, 1871—tried under the provisions of the 6th section of the Patent Act of 1869, 32-33 Vic., c. 11—it was held that there had been public use of the invention with plaintiff's consent or allowance before the plaintiff applied for the patent, so as to disentitle him under the Act to a patent. And in *Woodruff* v. *Mosely*, 17 L. C. J. 306, S. C. (Que.), and 19 L. C. J. (Que.), and 169 Q. B. (1875), an importer of a device patented in the United States by some other person is not an "inventor or discoverer" under the Act of 1869.

The patentee was also not to be deprived of a patent by reason of having taken out a patent therefor in any other country at any time within six months of the filing of his specification

and drawings. Now your application for a Canadian patent must be filed within one year from the date of the issue of the first foreign patent.

An oath of affirmation was to be made before a J. P. in Canada that the applicant was the true inventor and had been a resident of Canada for one year prior to his application.

It provided for filing neat working models, and the patent was to be examined by the Minister of Justice before it was signed.

There were provisions as to disclaimer (section 20) and reissue, and for registration of assignments.

The remedy for the infringement of a patent follows the wording of section 29 of our Revised Act of 1886.

DURATION OF PATENT.

By section 17, patents shall be valid for five years, but at or before the expiration of that time may be renewed for another five years, and again a further extension of five years—making in all fifteen years, being one year longer than the period heretofore in force.

The patent was to be void in certain cases if the specifications were defective or valid as to part, as provided in the 28th section of the present Act, R. S. C., c. 61.

MANUFACTURE.

In section 28, Act of 1869, patents were conditional on manufacture, the same as in the Act of 1872, except that there must be manufacture by the patentee in Canada within three years from the date of the patent.

IMPORTATION.

And the patent was to be void if after the expiration of eighteen months the patentee or his assignee, for the whole or part of his interest in the patent, imports or causes to be imported into Canada the invention for which the patent was granted.

In this Act of 1869, no provision was made for extending the time to manufacture or of importation.

And a caveat under this Act of 1869 was void unless within four years, application be made for a patent.

The commissioner had authority to correct clerical errors happening in the framing of any instrument of the patent office.

All patents issued by the Province of Canada and of Nova Scotia and New Brunswick, and all patents issued for the Province of Ontario and Quebec by the legislature of Canada to remain in force for the same term and territory as if the Act under which it had issued had not been repealed, but subject to the provisions of this Act so far as applicable.

NEW BRUNSWICK.

The earliest Act relating to patents in New Brunswick was 4 Wm. IV., c. 27 (1834), and subsequent Acts were 6 Vic., c. 34; 14 Vic., c. 35; 16 Vic., c. 32; 19 Vic., c. 21; 23 Vic., c. 41; 26 Vic., c. 33—R. S. N. B., c. 118.

New Brunswick and Prince Edward Island were the only Provinces, in which, prior to the union, foreigners were admitted to the advantages of the patent laws of the Province (14 Vic., c. 35), there was also provision as to disclaimer. Such as in the Province of Canada in the Act of 1849.

Chapter 118 of the Revised Statutes related to patents of invention "not known or used by others before the invention or discovery and not then in public or common use in the Province of New Brunswick." No patent was refused because of a patent in a foreign country, but the New Brunswick patent expired on the same date as the foreign patent.

In an infringement suit, three times the actual damage sustained was recoverable, and the action was to be commenced within six months of the Act complained of. And the patentee had three years within which time he was to establish manufacture within the Province. This Act was repealed by the Patent Act of 1872, sec. 52, so far as inconsistent with that Act, and except as to rights acquired or liabilities incurred before the repealed Act.

NOVA SCOTIA.

3 Wm. IV., c. 45 (1833), was the earliest Patent Act; its benefits were limited to inhabitants of the Province who had resided there one year prior to the application for a patent. In later

Acts, the word residents is used instead of inhabitants. The applicant for a patent had to declare that he was the true inventor or discoverer, and that the invention had not, to his knowledge, been used in Nova Scotia or any other country; if described in a printed publication anterior to his invention, the Letters Patent were void. The law passed through several revisions: R. S. N. S. (1851), c. 120; R. S. N. S. (1864), c. 117; and R. S. N. S. (1869), c. 120.

In 1859-60-61, certain private Acts were passed to enable parties who had complied with the provisions of the Nova Scotia Act to obtain Letters Patent, notwithstanding that they resided out of the Province, and the patent right was conditioned to cease if the improved manufacture was not introduced within three years.

In 1862, c. 27, the right to apply for Letters Patent was restricted to residents. And by the Act of 1865, residents of other countries might obtain patents for inventions relating to the amalgamation or separation of gold, etc., amending R. S. N. S., c. 117.

By chapter 117, Revised Statutes of Nova Scotia (1864), any person a resident in the Province for a year might obtain a patent for the term of fourteen years. No change of form or proportion was to be deemed an improvement on an original patent. This Act was similarly repealed by the 52nd section of the Patent Act of 1872.

Patent Act of 1872, Can.

The Patent Act of 1872, 35 Vic., c. 26, is that on which our present Act, c. 61, R. S. C. 49 Vic. (1886), is founded, being a revision of that Act (1872), and the subsequent amending Acts. It is more in place to discuss some of its provisions when dealing hereafter with the various sections of our present Patent Act.

By this Act, foreigners could obtain patents on the same terms as Canadians; the restriction as to residence in Canada for one year as contained in the sixth section of the Act of 1869, being withdrawn.

Chapter 34 C. S. C.; c. 117, R. S. N. S. (3rd series); c. 118, R. S. N. B. Patent Ordinances 1867, British Columbia and the Patent Act 1869 were repealed, so far as is inconsistent with the Act of 1872 or any Act amending them, or any other Act relating to patents, except as to rights acquired and penalties incurred, but not to affect any pending suit.

ACT AMENDING THE PATENT ACT 1872, 36 VIC., C. 44 (1873), CAN.

The oath could be taken before a Judge of a "Court of Record" or a "Public Notary," section 11; and section 14 was amended by adding, "but the said commissioner may dispense, in his discretion, with the said duplicate specification and drawing, and in lieu thereof cause copies of the specification and drawing in print or otherwise to be attached to the patent of which they shall form an essential part."

37 VIC., C. 44 (1874), CAN.

Section 29 of the Patent Act of 1872 was amended by substituting the words, "Supreme Court in the Province of New Brunswick" for the "Court of Queen's Bench in the Province of New Brunswick."

38 VIC., C. 14 (1875), CAN.

An Act still further to amend "the Patent Act of 1872," and to extend the same as amended to Prince Edward Island. Assented to April 8th, 1875.

Section 1, of section 19, of the Act of 1872, was amended, by adding thereto after the word patent in the last line "and the commissioner may entertain separate applications and cause patents to be issued for distinct and separate parts of the thing patented upon payment of the fee for a reissue for each of such reissued patents," which addition is now sub-sec. 4, sec. 23.

By section 2, sub-section 2, section 28, of the Act of 1872, was repealed and a new one substituted. The commissioner may extend the time for manufacture beyond two years, at any time not more than three months before the expiration of that period, on proof that the patentee, for reasons beyond his control, was prevented from complying with the conditions. The substituted section being the same as sub-section 2, of section 37, of the Revised Patent Act of 1886.

By section 3, the 49th section of the Patent Act of 1872, was repealed, and a section the same as section 54 of the Revised Patent Act of 1886 substituted.

PRINCE EDWARD ISLAND.

By section 4, the provisions of the Patent Act of 1872 and its amending Acts were extended to Prince Edward Island.

By section 5, the following Acts of the General Assembly of Prince Edward Island were repealed, viz.: 7 Wm. IV., c. 21; 32 Vic., c. 20, amending; and 33 Vic., c. 19; where they were inconsistent, except as to rights acquired and penalties incurred.

By section 6, existing patents in Prince Edward Island to remain in force, and might be extended to the Dominion on payment of the proper fees.

By section 7, the records of the Patent Office of Prince Edward Island to be handed over to the Commissioner of Patents, Ottawa.

By chapter 21, Revised Statutes Prince Edward Island (1837), any inhabitant of the Island, or one who had resided therein one year previous to the passing of the Act, might apply for Letters Patent, making oath that he was the true inventor, and that such invention had not been known or used in the Island or in any other country.

By 32 Vic., c. 20 (1869), a non-resident might obtain a patent under 7 Wm. IV., c. 21, if the country in which he resides extends like privileges to the inhabitants of Prince Edward Island.

From 1876 to 1881 inclusive, there was no amendment of the Patent Act of 1872.

45 VIC., C. 22 (1882), CAN.

By 45 Vic., c. 22, sec. 1, Stat. of Can. (1882), sec. 28 of the Patent Act of 1872 was amended, and the time for importation was extended for a period not exceeding one year, if application be made within three months of the expiration of the twelve months mentioned in the first sub-section of section 28 of the Act of 1872; the words, "or any extension thereof," as applied to importation, are, from the context, evidently erroneous. They appear in this Act of 1882 for the first time.

46 VIC., C. 19 (1883), CAN.

By chapter 19, 46 Vic., of the Stat. of Can., 1883, sec. 17 of the Patent Act of 1872, which provided that patents shall be valid for five, ten, or fifteen years at the option of the applicant, but at or before the expiration of five or ten years the holder may obtain an extension, was repealed, and the following provisions were substituted. Patents were issued for fifteen years, but partial fees may be paid, but in such case the patent was to lapse at the end of five or ten years unless the remainder of the fee is paid; and it was further provided that "Every patent heretofore issued by the Patent Office in respect of which the fee required for the whole or for any unexpired portion of the term of fifteen years has been duly paid according to the provisions of the now existing law, has been and shall be deemed to have been issued for the term of fifteen years, subject, in case a partial fee has been paid, to cease on the same conditions on which patents hereinafter issued are to cease under the operation of this section."

This last quotation forms section 58 of the present Patent Act, with some slight alterations.

47 VIC., C. 38 (1884), CAN.

47 Vic., c. 38 (1884), "An Act for the better prevention of fraud in connection with the sale of patent rights," provided that a bill or note, the consideration for which consists in whole or in part of the purchase money of a patent right, etc., shall have written across its face "given for a patent right."

The transferee to take subject to the equities between the original parties.

Parties to be subject to imprisonment for not more than one year, or to a fine not exceeding $200, on failure to write such words across the face of the bill.

This Act was re-enacted with additions (as to the note being void between the original parties if these words omitted, etc.,) by sub-secs. 4, 5 and 6, sec. 30, of the Bill of Exchange Act of 1890, 53 Vic., c. 33, as to which see the last chapter of the book.

49 VIC., C. 25 (1886), CAN.

49 Vic., c. 25, sec. 14 (1886), The Supreme Court of the North-West Territories "to have all the rights, etc., of a Court of Record as exercised by Her Majesty's Superior Courts in England on the 15th July, 1870."

THE PATENT ACT.

49 VIC., c. 61, R. S. C. (1886).

49 Vic., c. 61 (1886), "The Patent Act." By this Act, c. 26, 35 Vic. (1872), and amendments thereof, were revised, and constitute the present Act, where not amended or repealed subsequent to revision.

51 VIC., c. 18 (1888), CAN.

Chapter 18, 51 Vic. (1888), "An Act to amend the Act respecting patents of invention," assented to 22nd May, 1888, relates to the appointment of a Deputy Commissioner of Patents and his duties. Section 5 of Rev. Stat. (1886), was repealed.

53 VIC., c. 13 (1890), CAN.

"An Act to amend the Patent Act," assented to 24th April, 1890, gives the Exchequer Court jurisdiction in the matter of the repeal of Letters Patent by *sci. fa.* in addition to the other Courts mentioned in sub-sec. 1 of sec. 37 of the Patent Act.

Sub-sec. 1 of sec. 37 of the Patent Act was repealed, and the substituted section did away with the jurisdiction of the Minister of Agriculture or his Deputy, and the jurisdiction was extended to the Exchequer Court, but was not to affect the jurisdiction that any Court, other than the Exchequer Court, possesses.

The 39th section of the Patent Act, relating to fees, was amended, by adding after "assignment," "or any other document relating to a patent."

The 49th section of the Patent Act was amended by substituting "a certified copy thereof" for "another patent of like tenor, date and effect."

BILLS OF EXCHANGE ACT (1890), CAN.

The Bill of Exchange Act, c. 33, 53 Vic. (1890), provides that bills and notes given for a patent right shall be marked "given for a patent right."

Section 30, sub-sections 4, 5 and 6, being a re-enactment, with additions of chapter 38, 47 Vic. (1884), "An Act for the better prevention of frauds in connection with the sale of patent rights."

54 AND 55 VIC., C. 26 (1891), CAN.

"An Act to amend the Exchequer Court Act," assented to 30th September, 1891, gives the Exchequer Court jurisdiction (sec. 4): (*a*) In all cases of conflicting applications for any patents of invention, or the registration of any copyright, trade mark or industrial design; (*b*) in all cases in which it is sought to impeach or annul any patent of invention, etc.; (*c*) in all cases in which a remedy is sought respecting the infringement of any patent of invention, copyright, trade mark or industrial design.

This is an important innovation, a decree of the Exchequer Court, being a Dominion Court, extending over the whole of the Dominion, proceedings in patent suits having heretofore been instituted only in the Provincial Courts with respect to infringement, etc., occurring within the respective Provinces.

54 AND 55 VIC., C. 33 (1891), CAN.

54 and 55 Vic., c. 33 (1891), "An Act to amend the Patent Act," sub-sec. 1, of sec. 37, of c. 61, R. S. C., relating to the non-manufacture and importation which was amended by 53 Vic., c. 13, was again amended.

55 AND 56 VIC., C. 24 (1892), CAN.

55 and 56 Vic., c. 24 (1892), assented to 9th July, 1892, section 8 and sub-section 3, of section 10; sections 14, 15, 22 and sub-section 1 of section 37 of the Patent Act, were amended, and section 39 was repealed and a new one substituted. By this Act, patents were, for the first time, granted for eighteen years, and various other changes were made, which are commented on hereafter.

56 VIC., C. 34 (1893), CAN.

By 56 Vic., c. 34, "An Act further to amend the Patent Act," assented to 1st April, 1893.

Provision was made in section 12 for sending in an additional copy of the claim or claims, and in section 21, for the signature of Letters Patent by the Deputy Commissioner of Patents.

In section 22, sub-section 2, provision was made for the payment of the fees for eighteen years patents and for the payment of partial fees for six year periods. And in section 39, for the payment of a two dollar fee on giving notice to the commissioner under section 8 of the Patent Act.

CHAPTER II.

The Patent Act (Canada), as amended, with annotations:—

Chapter 61, Revised Statutes of Canada, "An Act respecting patents of invention" (A.D. 1886), as amended by 51 Vic., c. 18 (1888); 53 Vic., c. 13 (1890); 54 and 55 Vic., c. 33 (1891); 55 and 56 Vic., c. 24 (1892); 56 Vic., c. 34 (1893).

PART I.

Her Majesty, by and with the advice and consent of the Senate and House of Commons of Canada, enacts as follows:—

SHORT TITLE.

1. This Act may be cited as "*The Patent Act*," 35 V., c. 26, s. 53.

INTERPRETATION.

2. In this Act, unless the context otherwise requires,—

(*a*) The expression "the Minister" means the Minister of Agriculture;

(*b*) The expression "Commissioner" means the Commissioner of Patents, and the expression "Deputy Commissioner" means the Deputy Commissioner of Patents;

(*c*) The expression "invention" means any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement in any art, machine, manufacture or composition of matter;

(*d*) The expression "legal representatives" includes heirs, executors, administrators and assigns or other legal representatives.

NOTE TO SEC. 1.—The Act came into operation 1st March, 1887.

NOTE TO SUB-SEC. (*a*), SEC. 2.—By 16 Vic., c. 11, Can. (1852), when the Bureau of Agriculture was first established for the late Province of Canada, the Minister of Agriculture was directed to receive all applications, specifications and models for patents, and to keep the records, the jurisdiction being transferred from the Provincial Secretary to the Minister of Agriculture, and the Patent Office has been a part of the Bureau of Agriculture ever since.

NOTE TO SUB-SEC. (*b*), SEC. 2.—Since 22nd May, 1888, the Deputy of the Minister of Agriculture is no longer Deputy Commissioner of Patents but a special officer is now appointed as such. See substituted section 5.

NOTE TO SUB-SEC (*c*), SEC. 2.—This defines what constitutes an invention under section 7 of this Act and elsewhere, and is the same wording as that in the United States Act.

An Art means, when it describes the subject of a patent, "any new and useful art," or as usually described—any new and useful process; in section 9 of Curtis on Patents, 4th ed., this term, as there stated, "was intended to embrace those inventions where the particular apparatus or materials employed may not be the essence of the discovery, but where the essence consists in using apparatus or materials in new processes, methods or relations so as to constitute a new mode of attaining an old result; or a mode of attaining a new result in a particular department of industry, which result may not of itself be any new machine, manufacture or composition of matter; or finally, an entirely new process of making or doing something which has not been made or done before by any process." It is a mode, or method, or manner of accomplishing some certain result in distinction from said result.

As defined by the Supreme Court of the United States, an art or process is "an act or series of acts performed upon the subject matter to be transformed and reduced to a different state or thing, and if new and useful, it is patentable." *Cochrane* v. *Diener*, 94 U. S. 789, 11 Brodix, 396.

"An Art," is a "process." *Vide New Process Fermentation Co.* v. *Maus*, 17 Brodix, 157.

In Walker on Patents, section 3, it is stated "the word 'art' has a narrower meaning in the Patent Laws than it has in the dictionaries." In the latter, its signification is "the use of means to produce a result." In the Patent Laws, it covers only a certain limited meaning of the word "process." The common meaning of the latter word is "an operation performed by rule to produce a result."

And in section 4 Walker, in *Corning* v. *Burden*, 15 How. 267 (1853), the Supreme Court of the United States announced that processes which consist only in the use of mechanism are not patentable, and that all other methods of producing useful results are patentable as processes, they being such processes as are covered by the word "art" in the statute.

The meaning of the term "Art" is very fully described in

Curtis on Patents, 4th ed., sec. 9 *et seq.*, and Walker on Patents, sec. 3 *et seq.* A process as distinguished from a machine is patentable and comes under the term "useful art" in the Patent Law. See Myers' Federal Decisions, vol. 25, sec. 5028. A process is a mode, method, or operation, by which a result or effect is produced by chemical action, by the operation or application of some element or power of nature, or of one substance to another: Myers' F. D. vol. 25, sec. 5030. *Ex parte* Turner, C. D., January 12th, 1894. See O. G., vol. 66, p. 1592. An art, within the meaning of the Patent Laws, must accomplish some change in the character or condition of material objects. When the practice of the alleged art will not produce any physical effect, but will merely carry out a plan or theory of action without the production of any physical results proceeding directly from the operation of the theory or plan itself, it is not an art in the sense of the Patent Law. The art of advertising which induces only a state of mind in the purchaser of the newspaper is not patentable.

A Machine is the next subject of Letters Patent. In section 20, Curtis, it is thus defined, "When the supposed invention is not a mere function or abstract mode of operation, separate from any particular mechanism, but a function or mode of operation is embodied in mechanism designed to accomplish a particular effect, it will be a machine in the sense of the Patent Law": *Blanchard* v. *Sprague*, 3 Sum. 535-540, and a machine is rightfully the subject of a patent whenever a new or an old effect is produced by mechanism new in its combinations, arrangements, or mode of operation.

A "machine" includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain result: *Vide* Myers' Federal Decisions, vol. 25, sec. 5029.

A "machine" in Webster's Dictionary, is defined to be in general, "any combination of bodies so connected that their relative motions are constrained, and by means of which force and motion may be transmitted and modified, as a screw and its nut, or a lever arranged to turn about a fulcrum, or a pulley about its pivot, etc., especially a construction more or less complex, consisting of a combination of moving parts or simple mechanical elements calculated to constitute a prime mover, or to receive force and motion from a prime mover, or from another machine, and to transmit, modify and apply them to the production of some desired mechanical work or effect," etc.

A Manufacture: In the note to section 27 of Curtis, the definition of a "manufacture" as the subject of a patent is, "Any new combination of old materials constituting a new result or production in the form of a vendible article not being machinery."

A "manufacture" in Webster's Dictionary, is defined to be, "Anything made from new materials by the hand, by machinery, or by art, as clothes, iron utensils, shoes, machinery, saddlery," etc.

It may be sometimes difficult to determine whether one of these classes does not run into another; whether the invention may be classed as a "machine" or a "manufacture" is not, however, matter of vital importance.

In England the term "manufacture" has a more extended meaning than in the United States or Canada.

In the 6th section of the Statute of Monopolies, 21 James I., c. 3, it was declared that the operation of the statute "shall not extend to Letters Patent and grants of privilege for the term of fourteen years or under hereafter to be made, of the sole working or making of any manner of new manufacture within this realm to the true and first inventor and inventors of such manufactures, which others at the time of making such Letters Patent and grants shall not use," etc.

The term "manufacture" here has been defined to be "something made by the hand of man," and has been held to include the practice of making a thing or of producing a result: *Vide* sec. 5, Curtis; *Boulton* v. *Bull*, 2 Hy. Bl., 492.

By judicial decisions in Great Britain and Ireland, "new manufacture" within this realm, covers all that is defined by the word "invention" under our Act; and by sec. 46 of the British Patent Act of 1883, an invention is defined to mean "any manner of new manufacture the subject of Letters Patent and grants of privilege within the 6th section of the Statute of Monopolies, 21 James I., c. 3."

In *Ralston* v. *Smith*, 13 L. T. N. S., Lord Westbury says the word "manufacture" includes not only productions, but also the means for producing them, therefore in addition to the thing produced, it will comprehend a new machine or a new combination of machinery, it will comprehend a new process as well as an improvement on an old process—by the definition in section 46, the first introducer into the realm may be the first inventor, as was the case before the Act of 1883, and the subject matter of Letters Patent in the United Kingdom is the grant of the privi-

lege relating "to the sole working or making of any new manufacture within the realm."

Composition of Matter.—In section 28, Curtis, "composition of matter" is said to include medicines, compositions used in the arts, and other combinations of substances intended to be sold separately. Generally speaking, a patent for a new composition of matter covers the process, for if the composition itself be new, the process by which it is made must also be new; but if the article be not new, but the patentee has described merely a new mode or process of producing it, then the patent will not be for a "new composition of matter" but for a new "art" of making that particular thing.

The distinction between a "manufacture" and a "composition of matter" is not always easy to define. That which is neither a machine, a manufacture or a composition of matter, may be classed as an "art" or "process," and there are things which do not come under any of the foregoing heads.

Any new and useful improvement in any art, machine, manufacture or composition of matter, may also be the subject of a patent.

By Con. Stat. Can., c. 34 (1859), 22 Vic., the expression "'useful art, machine, manufacture or composition of matter' includes any such thing herein referred to, whether it be made by hand or machinery, or by both of these means."

PART II.

Patent Office and Appointment of Officers.

3. There shall be attached to the Department of Agriculture, as a branch thereof, an office which shall be called the "Patent Office;" and the Minister of Agriculture for the time being shall be the Commissioner of Patents. 35 V., c. 26, s. 1, *part.*

Note.—By the Patent Act of 1869, 32-33 Vic., c. 11, Can., the Patent Office was first established, and the Minister of Agriculture was made the Commissioner of Patents, and his Deputy, the Deputy Commissioner; the latter is now appointed by the Governor in Council: *Vide* section 5, a substituted section.

4. The commissioner shall receive all applications, fees, papers, documents and models for patents, and shall perform and do all acts and things requisite for the granting and issuing of patents of invention: and he shall have the charge and custody of the books, records, papers, models, machines and other things belonging to the Patent Office. 35 V., c. 26, s. 1, *part.*

5. The Governor in Council may appoint a Deputy Commissioner of Patents whose salary shall be two thousand eight hundred dollars per annum, and may, from time to time, appoint such officers and clerks under such Deputy Commissioner as are necessary for the purposes of this Act, and such Deputy Commissioner, officers and clerks shall hold office during pleasure.

2. The Deputy Commissioner of Patents shall, subject to the head of the Department to which the Patent Office may be, at any time, attached, oversee and direct the officers, clerks and employees in the Patent Office and shall have general control of the business thereof, and shall perform such other duties as are assigned to him by the Governor in Council. 35 V., c. 26, s. 4, *part*; The Patent Act (1886), 51 V., c. 18, s. 1.

NOTE.—By 51 Vic., c. 18 (1888), sec. 5, of "The Patent Act," chapter 61, of the Revised Statutes of Canada, was repealed, and the foregoing substituted therefor.

This change of officers gave rise to the rehearing of a patent case under the 37th section of the Act. In February 29th, 1889, Mr. Richard Pope, the Deputy Commissioner of Patents, in the case of the Royal Electric Co. of Canada, Petitioners, and Edison Light Co., Respondents, gave judgment annulling the Edison Patent for non-manufacture and importation; as at that date the Minister of Agriculture or the Deputy of the Minister of Agriculture had jurisdiction under the 37th section of the Act, and doubts were entertained as to the jurisdiction of the Deputy Commissioner of Patents appointed under 51 Vic., c. 18 (1888), the case was reheard by Mr. Carling, the Minister of Agriculture, associated with Sir J. Thompson, the Minister of Justice, when the latter handed in a judgment on the 30th of October, 1889, declaring that the patent was not void, and reversing the finding of Mr. Richard Pope, the Deputy Commissioner of Patents: See note under section 37 for report of case.

6. The commissioner shall cause a seal to be made for the purposes of this Act, and may cause to be sealed therewith every patent and other instrument and copy thereof issuing from the Patent Office. 35 V., c. 26, s. 2, *part.*

NOTE.—This section is new. Under the 50th section of the Patent Act, the seal of the Patent Office shall be received in evi-

dence in every Court, etc., and copies and extracts certified under the seal of the Patent Office shall be receivable in evidence without production of the original. The seal is attached to certified copies of patents, assignments, abstracts, agreements and other documents on file in the Patent Office.

PART III.

APPLICATIONS FOR PATENTS.

7. Any person (*a*) who has invented (*b*) any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement in any art, machine, manufacture or composition of matter (*c*), which was not known or used by any other person before his invention thereof (*d*), and which has not been in public use or on sale with the consent or allowance of the inventor thereof, for more than one year previously to his application for patent therefor in Canada (*e*), may, on a petition to that effect, presented to the commissioner (*f*), and on compliance with the other requirements of this Act (*g*), obtain a patent granting to such person an exclusive property in such invention (*h*) :*

2. No patent shall issue for an invention which has an illicit object in view, or for any mere scientific principle or abstract theorem. 35 V., c. 26, s. 6, *part.*

NOTE.—This section 7 is a rearrangement of section 6 of the Patent Act of 1872, it now reads better. For section 6, Patent Act, 1872, see Form 52, Appendix 2.

This abrogated section 6 of the Act of 1872, has been split up into four portions, and is now covered partly by section 7; that portion relating to the sealing, by section 6; while section 21 directs the formalities of issue, and that part stating what "may not be patented" becomes now sub-section 2 of section 7.

NOTE (*a*) TO SECTION 7.—The practice now is that the patent be sealed with the Patent Office seal, signed by the Commissioner of Patents and countersigned by the Deputy Commissioner; there is no specific direction that the Deputy Commissioner sign the patents in the absence of the Commissioner.

In the United States by the Act of 1888, under the direction of the Secretary of the Interior, one of the Assistant Secretaries may sign Letters Patent.

* NOTE.—While this work is going through the press, it is stated that this section 7 is to be amended this session (1894), to meet points which arose in *The Queen* v. *La Force*, hereafter referred to; if so, the new bill, annotated, will be added in the Appendix.

(*a*) "**Any Person**" includes in Canada, both men and women, and also foreigners of all descriptions. In the Interpretation Act "person" includes "any body corporate and politic," but here the meaning is restricted, for a corporate body could not invent. Patents, however, may be issued in the names of corporations and firms, provided the inventor make the oath or affirmation required in section 10, and assign the alleged invention prior to issue to the corporation or firm who petition for the patent.

Infants.

Infants under twenty-one years, of either sex, may obtain patents through the Patent Office, Canada, without question; there is no express reference to them in our Act, as is the case in England, nor have we judicial decisions as to their status relative to patents. A difficulty might arise with them in Ontario and other Provinces relative to assignments, etc., and contracts relating to patent rights. In *Foley* v. *Canada Permanent Loan & Savings Co.*, 4 Ont. R., 38:—

Held, the rule is now well established that the deed of an infant is not void *ab initio* but voidable on his attaining majority. If he wishes to avoid it, he must expressly repudiate his contract within a reasonable time after coming of age, otherwise his silence will be held to amount to an affirmation of it.

Married Women (Can).

A married woman may be a patentee in Canada; and the property in the invention would be her separate estate in Ontario under R. S. O., c. 132, by this Act she may sue without her husband, and any damages received would be her separate property.

Under the Married Woman's Acts in British Columbia, North-West Territories, Manitoba, Ontario, Nova Scotia and New Brunswick, a married woman may be treated as if she were *femme sole* so far as a patent is concerned, also in Prince Edward Island.

Civil Code—Lower Can. (1866) Art. 177.

A wife, even when not common as to property, cannot give nor accept, alienate or dispose of property *inter vivos*, nor other-

wise enter into contracts or obligations unless her husband becomes a party to the deed or gives his consent in writing.

If, however, she be separate as to property, she may do and make alone all acts and contracts connected with the administration of her property.

So it appears that although a married woman in the Province of Quebec may take out a patent in her own name, yet if she be not separate as to property, she cannot sell, assign or license as patentee, unless her husband becomes a party to the deed or gives his assent in writing.

By Article 180, if the husband be interdicted or absent, the Judge may authorize his wife to contract.

By Article 182, if the wife be a minor, the authorization of the husband, whether he be of age or a minor, is sufficient for those cases only in which an emancipated minor might act alone.

Disability of Minors in Quebec.

Minors, under twenty-one years of age, in the Province of Quebec, although they may take out patents, by Article 986, are incapable of contracting, as are also, those who are insane, imbecile or drunken.

By Article 1008, a person is not relievable from a contract made by him during minority when he has ratified it since attaining the age of majority.

Married Women, Great Britain.

In Great Britain, married women by virtue of the Married Woman's Act are under no disabilities with respect to patents.

Infants in Great Britain.

There does not appear any case in England, which judicially decides, whether, before the Patent Act of 1883, an infant may be a patentee; but, in the case of a grant to two persons, one of whom was an infant, the validity of the patent was not affected: *Vide Chevin* v. *Walker*, L. R. 5 Ch. D., 858.

Under the Patent Act of 1883, section 99, provision is made, for the guardian of an infant to make declaration and to act as substitute, for the purposes of the Act.

Lunatic.

There is no provision in our Act for the grant of Letters Patent in the case of one making an invention and becoming insane before application for or obtaining Letters Patent. In Great Britain this is provided for by section 99 of the Act, 1883, and the Committee of the lunatic can make any declaration or do any act necessary for the purposes of the Act and all Acts done by the substitute, shall be as effectual as if done by the person for whom he is substituted.

Married Women in U. S.

In the States, married women, infants and lunatics are liable for damages on infringement of patents; the only distinction between the liability of lunatics and of sane persons, seems to be, that the former can never be held liable for more than actual damages on an action at law or profits in an action in equity: Cooley on Torts, p. 102; *Avery* v. *Wilson*, 20 Fed. Rep., 857, 1884. Husbands are liable for infringement by their wives, committed in their presence, and for joint infringements: *Vide* Walker, section 402.

A married woman, infant, or one under guardianship, may be assignee, or may assign their inventions: *Vide* Walker, 2nd ed., sec. 275, and a married woman is a competent witness in interference proceedings: *Vide Koen* v. *Quint*, O. G., vol. 23, p. 1331.

A patent may issue in the name of any assignee or assignees, provided the oath or affirmation referred to be made by the inventor, and the invention be duly assigned by him before issue to the petitioner; in the event of their being joint inventors, the oath and assignment should be made by all the inventors; in all cases the patent issues to the petitioner or petitioners.

A patent may also issue in the name of the assignee of a deceased inventor, or to his legal representative, provided the assignee or legal representative comply with the provisions of sub-section 2 of section 10 of the Act.

"Any person" under this section may mean a first and independent inventor; in sections 16, 24 and 32, the term "first inventor" is expressly used, although omitted in Patent Office Forms relating to oaths, 17 to 22, inclusive.

Two or more persons may make joint application for a patent, and the patent may issue in their joint names, whether as joint inventors, or as assignee or assignees and inventor, or as assignees as stated, provided the provisions of section 10 be complied with; indeed, it is a very common practice to issue patents jointly, which involves a somewhat important question as to the respective interests of the parties: *Vide* also sub-section 2, section 20, which specially provides for joint applications.

Joint Patentees.

In Higgins on Patents (1884), p. 9 (Eng.), joint patentees are not in contemplation of law partners, and each may use the invention without accounting to the other: *Mathers* v. *Green*, 1 Chy. App.. 29, and Daniels (1884), p. 118, lays down: "When a patent is granted to two or more partners, any one of them may use the invention without the consent of the others, without accounting to them or any of them for the profits so obtained in the absence of any special agreement to that effect": See *Mathers* v. *Green*, L. R., 1 Chy. App., 29; *Hancock* v. *Bewley*, Johnson, p. 601; *Re Russell*, 2 DeG. & J., 130; *Lees* v. *Jones*, 3 Jur. N. S., 954.

The foregoing is still the law in England; the Patent Act of 1883 and subsequent amendments having made no alteration in that respect.

The question has apparently never been decided in our Canadian Courts, and doubtless, we would follow the law as it is in Great Britain.

Mathers v. *Green*, was decided in 1865, under the Patent Law Amendment Act of 1852, and was an appeal from a judgment of the Master of the Rolls, who found the plaintiff entitled to an equal share in the profits attributable to the invention as well as to an equal share in the royalties arising from a license. Lord Cranworth, L. C., delivering the judgment of the Court, reversed this finding and dismissed plaintiff's bills, holding that the defendants, as joint patentees, were not liable to account, and that where a patent for an invention is granted to two or more persons in the usual form, each one may use the invention without the consent of the other.

Lord Cranworth cites *Re Russell, Patent* 2 DeG. & J., 130,

which had also come before him in 1857, a dispute between rival inventors which was settled by agreement.

In the United States in section 292, Walker on Patents, it is laid down "tenancy in common"; "in a patent right, will arise whenever the sole owner of such a right, in all or in part of the territory of the United States conveys to another an undivided interest in the whole or in part of the right which he owns. Mutual ownership of some sort arises when a plurality of persons are joint inventors of a process or thing for which they obtain a joint patent; also when a plurality of persons obtain, by an assignment or grant the undivided ownership of a patent or the undivided ownership of a patent right in a part of the territory of the United States."

Then it is discussed whether it may not be a "joint tenancy" instead of "a tenancy in common" with a leaning towards "tenancy in common" although never judicially determined in the Supreme Court, U. S.; and to avoid the doctrine of survivorship in "joint tenancy," which would deprive the heirs or devisees of a deceased joint patentee of any interest in the patent, conferring it on the surviving joint patentee or patentees, it is suggested (in section 293 Walker) when joint inventors become joint patentees—that a joint assignment of the patent be made to a third person and a separate re-assignment to the patentees of their respective undivided interest—this would destroy the "unity of title" and turn the holding into a "tenancy in common," and if the separate re-assignments are executed and delivered on different days it also destroys the "unity of time," another of the four unities of a "joint tenancy."

Where a sole inventor sells an undivided interest in his invention or his patent, "joint tenancy" can be avoided by simply assigning that undivided interest to the purchaser; instead of doing the common but unscientific thing of assigning the whole patent to himself and to the purchaser jointly.

When a patentee assigns his patent, or grants a territorial right therein, to a plurality of purchasers "joint tenancy" with its inconvenient circumstances can be avoided by executing and delivering a separate paper to each purchaser for his undivided share—instead of making one document for all. And thus a "tenancy in common" can in all cases be created.

In *Clum* v. *Brewer*, 2 Curtis, C. C., 506 (1855), Curtis, J., says,

"One tenant in common has as good a right to use and to license third persons to use the thing patented as the other tenant has, neither can assert a superior equity unless it has been created by some contract modifying the rights belonging to them as tenants in common."

This is still the law in the United States: *Vide* Walker, 2nd ed., sec. 294.

No recovery of profits or damages can be had against any licensee, at the suit of any co-tenant of a licensor: *Dunham* v. *Railroad Co.*, 7 Bissell, 223 (1876).

It seems to logically follow that no recovery of profits or damages can be had against one co-tenant who, without the consent of the others, has made, used, or sold specimens of the patented thing. That doctrine has been upheld in *Whiting* v. *Graves*, 3 Ban. & Ard. 225 (1878), and in the Supreme Court of Massachusetts in *Vose* v. *Singer*, 4 Allen (Mass.), 232 (1862), and by the Supreme Court of New York in *De Witt* v. *Manufacturing Co.*, 5 Hun., N. Y., 301 (1875).

In Great Britain one of several joint owners of a patent may bring an action in his own name to restrain infringement or for damages without joining his co-owners: *Sheehan* v. *Great Eastern R. W. Co.*, 16 Chy. D., 59; *Dent* v. *Turpin*, 2 J. & H., 139.

One co-owner of a patent is entitled to work it for himself, whether his part ownership was acquired by a joint grant or by assignment from a prior part owner, and is not liable to account for profits, to which as co-owner he was entitled: *Vide Steers* v. *Rogers*, L. R. (1892), 2 Ch. (Ap.), 13; R. P. C., vol. 9, p. 177 (1892).

Co-owners' Rights.

The fact that the assignee of one moiety of a patent happens to be mortgagee of the other moiety, does not alter the general rule that a co-owner of a patent is entitled to work it for his own benefit. Held, therefore, in an action to redeem the mortgaged moiety, that the mortgagee not having received royalties was not obliged to account for the profits made while he was holder of the mortgage: *Steers* v. *Rogers*, C. A. (1892), 2 Ch., 13; affirmed by H. L. (1893), W. N., 76 (1893), A. C., 232, R. P. C., vol. 9 (1892), p. 177.

The decision in *Mathers* v. *Green*, L. R., 1 Ch., 29, approved.

See also *White* v. *City of London Brewery Co.*, 42 Ch. D., 237.

The law appears to be settled in the same way in both England and the United States, and involves a question of some moment. In Canada, however, the practice which should be followed in order to ensure a "tenancy in common" is more honoured in its breach than in its observance, and the rights acquired by joint partners are usually either unknown or totally disregarded until some complication has arisen. In all cases of joint ownership of a patent where it is not intended that each individual should deal separately with the patent without reference or accounting to the other proprietors, a separate document or agreement should be executed by all parties defining their positions, which, being a "document affecting or relating to a patent," may, under the 39th section of the Patent Act, be registered at Ottawa for $2.

Now the utmost latitude is allowed as to who may obtain a patent in Canada.

We have seen that originally under 7 Geo. IV., c. 5 (1826), "Any subject of His Majesty being an inhabitant of Canada" might obtain a patent for fourteen years, this continued to be the case until the Patent Act of 1869, c. 11, Can. 32 & 33 Vic., s. 6, provided that "Any person having been a resident of Canada for at least one year before his application might obtain a patent."

So that the privilege was extended to aliens as well as British subjects, provided they had resided in Canada one year before application.

And by the Patent Act of 1872, the necessity for residence in Canada for any term was struck out, and the conditions then became the same as now.

By section 4 of the British Patent Act of 1883, Any person, whether a British subject or not, may make an application for a patent in Great Britain, but it is doubted whether the sovereign or a beneficed clergyman may take out a patent under provisions of 1 & 2 Vic., c. 106, secs. 28-30, and perhaps also an alien enemy: See Edmunds on Patents, p. 428.

And in the United States, under section 4886 Revised Patent Statutes, matters are in the same position, as here, in that respect.

(*b*) "**Who Has Invented.**"—The U. S. Act, sec. 4,886, R. P. S., adds "or discovered," thus distinguishing between an inven-

tion and a discovery. Our Patent Act of 1869 was worded as the U. S. Act is now, as was also 12 Vic., c. 24 (1849), and the Con. Stat. Can., c. 34 (1859), but "discovered" was dropped out of the Canada Act of 1872.

Discovery and Invention.

Merwin (1883), p. 8: "Sometimes it is said that the difference between discovery and invention is one of degree simply; that a discovery is a great advance in the art, an invention a slight advance; and therefore it is said that a patent for a discovery includes a great deal, but that for an invention very little. For the reason, why a discoverer takes a great step in the arts, and an inventor a slight step, is, that a discovery commonly results in a new process, whereas an invention is commonly but an improvement in some process. Thus, Mr. Justice Grier said, 'A new process is usually the result of a discovery; a machine, of invention.'" *Corning* v. *Burden*, 15 How., 252.

In Canada we have reversed this and invention includes discovery.

Invention.

The question of what constitutes an invention opens up a large field which is very fully discussed in "Merwin on Patentability of Inventions," and as a deduction from the numerous cases on page 39 of Merwin, it is laid down: "If, by a slight change, an improvement is made, that amounts to a decided advance in some art or industry, the Court looks on it with favour, and they find invention in it, if they can, especially is this so if the improvement effect a result which has long been desired. When once the change is made, it seems, indeed, a perfectly obvious one—a natural inference; but, the fact that many minds have been directed to the subject and have not drawn the inference, is strong evidence, at least, that it was not a natural inference—that invention was required to make it."

In *Waterous* v. *Bishop*, 20 U. C. C. P., 29, Hagarty, J. reviews *Russell* v. *Cowley*, 1 C. M. & R., 864; *Spencer* v. *Jack*, 11 L. T. N. S., 242; *Ralston* v. *Smith*, 13 L. T. N. S.; *Steiner* v. *Heald*, 6 Exch., 607; *Harwood* v. *Great Northern R. W. Co.*, 11 H. L., 654; *Penn* v. *Bilby*, L. R. 2 Chy. App., 127; *Booth* v. *Kennard*, 2 H. & N., as bearing on the question of patentability and invention.

On motion for a non-suit: *Held*, that the verdict could not be supported; and, the proper question was, whether the invention was novel and useful.

Hagarty, J., who delivered judgment of the Court, stating, "that the saving of labour and expense, and the production of a new and useful result, cannot, alone, support a patent, there must be some invention"; this

statement is open to serious objection, and it is not clear how it can be arrived at from the cases above quoted; a new and useful result is alone indicative of invention where a mere saving of expense would not be.

A patent must be for a thing invented, as well as new and useful; a process which any skilled mechanic or chemist would suggest when required, or, the result of judgment and skill in the selection and adaptation of materials is no invention; to omit one of the parts of an existing thing, unless such omission causes a new mode of operation of the parts retained, is no invention: *Vide Allen* v. *Reed*, 14 Q. L. R., 126, S. C., 1888.

In *Powell* v. *Begley*, 13 Grant, p. 381 (1867), Vankoughnet, C., states that the simplicity of a device is no reason why a patent therefor shall not be protected.

In *Summers* v. *Abell*, 15 Grant, p. 532 (1869), it was held that the simplicity of a new contrivance was no objection to a party's right to a patent for it.

In *Yates* v. *The Great Western R. W. Co.*, 24 Grant, p. 495 (1877), Spragge, V. C., states: "The great simplicity of an invention is not a ground of objection to a patent therefor. It is rather a recommendation in favour of it."

The correctness of the judgment of the Court of Appeal, 2 Ont. App., p. 240, reversing Spragge, V. C., has been doubted; and, in the case of *Wisner* v. *Coulthard*, in which that Court gave judgment on the 10th May, 1892, Burton, J., states: "I took part in the case of *Yates* v. *The Great Western R. W. Co.*, but that decision has been a good deal questioned, and I am not at all clear if I was now adjudicating on that case I should come to the same conclusion."

In a previous judgment by Boyd, C., in *Carter* v. *Rose*, tried at Toronto, April 30th., 1890, Boyd, C., stated in his judgment: "Courts of Equity are now more liberal in protecting patents than they were in some of the earlier cases in our Courts. *Yates* v. *The Great Western*, if it came up now in the Supreme Court would probably be decided as it was originally by the late Chancellor Spragge, who affirmed the validity of the patent. That was a thing that once you saw it done was so obvious that one would say a child could do it, it was so simple, and yet for twenty years the railway world had been baffled by this very simple thing. The late Chancellor granted the patentee an injunction. The Court of Appeal reversed him, one of the Judges, I believe, dissenting, Mr. Justice Patterson, who is very well skilled in the patent law. However, I advert to that just to show that the Courts now rather lean to uphold the patent, if any reasonable grounds are shown, than to destroy it. They are

not astute in finding out objections either in the phraseology of the specifications, or in the substantial merits of the case, and the better line of English as well as Canadian cases is moving in that direction."

As this decision of *Yates* v. *Great Western R. W. Co.*, in 2 Ont. App. R., 240, has been quoted, and may hereafter be quoted to destroy meritorious inventions—the foregoing extracts from the judgments of Boyd, C., and of Burton, J., who took part in the Appeal Court judgment, are given, as well as the fact that Patterson, J., dissented, in order that it may appear that the judgment has been discredited.

A new method of using existing machinery is patentable, if it produce a new and useful result: *Dowling* v. *Billington*, R. P. C., vol. 7, p. 191 (1890). A steam jacket for keeping an inner chamber hot in which articles were disinfected by steam from a high pressure boiler, and which was prevented from condensing; held a patentable invention: *Lyon* v. *Goddart*, Court of App., June 27th, 1893; Times L. R., vol. 9, p. 546.

Lack of Invention.

The principle of the use of a riding skirt of a seam so stitched as to free the skirt from the pommel in case of accident, had been for some time well-known. The alleged invention consisted in extending the burstable seam up through the waistband of the skirt, so that the lady might tear herself away from the skirt: *Held*, not patentable: See *Nicoll* v. *Swears*, Ch. D., April 25th, 1893; Times L. R., vol. 9, p. 420.

Recently patents have been refused in the United States Patent Office where the patentability depends on the arrangement of the printed matter, such as an application for a transfer car ticket.

And in support of this is cited *Ex parte Gerson*, 11 O. G., 244, decided February 5th, 1877, by the Assistant Commissioner, U. S., in which it was held that "New arrangements of printed matter on tickets, cards, etc., the result of fancy or simple mechanical skill are not proper subjects for patents, however convenient such arrangements may be."

Ex parte Lee, 18 O. G., 624, decided August 31st, 1880, by the Commissioner of Patents, U. S. "The patentable features of a railway or other ticket, like those of any other substantive thing, must depend upon peculiarities of mechanical construction.

"The printed matter upon a ticket is nothing more than an arbitrary direction as to how such ticket is to be used, and can have no bearing upon the patentability of the ticket itself." Also, *Ex parte Bertolzheimer*, C. D. (1870), p. 33; *U. S. Credit System Co.* v. *American Indemnity Co.*, 63 O. G., p. 318.

The following case was decided in the Supreme Court (Can.), and the headnote is as follows: *Wisner* v. *Coulthard*, Legal News (Que.), vol. 16, p. 281, and 22 Sup. Ct. R. (Can.), p. 178 *et seq.*

In an application for a patent the invention claimed was: "In a seeding machine in which independent drag-bars are used a curved spring tooth detachably connected to the drag bar in combination with a locking device arranged to lock the head block to which the spring tooth is attached as and for the purpose specified.

"In an action for infringement of the patent, it was admitted that all the elements were old, but it was claimed that the substitution of a curved spring tooth for a rigid tooth was a new combination, and patentable as such:—

"*Held*, in the Supreme Court, Canada, affirming the decision of the Court of Appeal (Ont.), (Gwynne, J., dissenting), that the mere insertion of one known article in the place of another known article was not a patentable matter. *Smith* v. *Goldie* (9 Can. S. C. R. 46), and *Hunter* v. *Carrick* (11 Can. S. C. R. 300), referred to. Appeal dismissed, with costs."

The bald proposition here enunciated, that you cannot have a patentable combination by the substitution of one known element by another known element, would, *per se*, seal the doom of many a useful invention upheld by the highest courts in various lands —if it were merely the substitution of a known "mechanical equivalent" with no new result produced, then, in such a case, the proposition may be true. As there may, undoubtedly, be a new combination of old elements producing new or improved results which is patentable, as many standard cases show, the certainty of error by applying the foregoing enunciation is obvious —there is danger in relying altogether on headnotes.

It is conceived that the view taken by Mr. Justice Ferguson, who upheld the validity of the claim referred to at the original trial at Toronto, is more in accordance with decided cases and the principles of patent law. On February 7th, 1890, in delivering judgment on the foregoing claim, he states: "I think it sufficiently appears that this combination claimed by the plaintiffs stands on the footing simply of a new combination compound of old elements, and as I have before said, I think the evidence abundant to show that it produced new and useful

results, or the old results in a more useful and beneficial way. It scarcely lies in the mouth of the defendants to deny the utility of it, while they insist upon manufacturing and vending the article.

"I think the great weight of evidence is that the machine with this curved spring tooth, so applied and employed by the plaintiffs, produces, if not a new result, *a known result in a much more useful and beneficial way.*" ("The words of the Lord Chancellor in the case of *Harrison* v. *Anderson Foundry Co.*, L. R. 1 App. Cas. 577, and of many learned Judges in other cases"): and the trial Judge holds the claim valid and that it was infringed.

The majority of the Supreme Court, unfortunately for the appellants, misapprehended the facts in this case; there was nothing in the evidence, the factums, the previous judgments or the arguments of counsel to warrant the facts set out in the judgment of Sedgwick, J. (as reported in 22 Sup. Ct. R., Can., p. 178 *et seq.*), who delivered the judgment of the majority. Gwynne, J., who dissented, gives the facts correctly, as do also Ferguson, J., the trial Judge, and Burton, J., of the Court of Appeal, who upheld plaintiffs' claim.

The premises of Sedgwick, J., being entirely erroneous the conclusions arrived at must also be so; had the facts been as he stated, it would not have been possible to have arrived at any other conclusions than he did.

There was no evidence of a prior similar combination (as stated on p. 184), had this been so, the plaintiffs' case would have failed at the trial; he confounds plaintiffs' device, apparently, with an old cultivator without locking mechanism: the plaintiffs did not claim to have invented "a combined machine," which Sedgwick, J., considered the subject of the controversy, for this was an old and well-known form of machine; nor was there anything to indicate this anywhere.

On p. 188, Sedgwick, J., states that the question "would be altogether different" if "a new or more beneficial result" had been attained; there was, however, a large mass of evidence showing that there was a greatly improved result; on this the trial Judge and dissenting Judges founded their judgments (see extract from judgment, *ante* l. 33, p. 38, to l. 9, p. 39 hereof), and the plaintiffs their case, as appears by their factum.

It is not the result, effect, or purpose to be accomplished which constitutes invention or entitles a party to a patent, but the mechanical means or instrumentalities by which the object sought is attained: *Miller et al.* v. *Eagle Manufacturing Co.*, Sup. Ct. O. G., vol. 66, p. 845. Decided January 8th, 1894.

A New Use or a Double Use.

In what respect a "new use" or a "double use" constitutes invention is a fruitful source of discussion. A "new use," a use referable to inventive genius, a "non-analogous use," is patentable: Merwin, p. 281.

A "double use," a use referable to the skill of the workman, an "analogous use," is not patentable: Merwin, p. 282.

Curtis, section 55 *et seq.*, there is a very material difference in applying a new contrivance to an old object and an old contrivance to a new object; the former may be patentable, the latter cannot be: *Losh* v. *Hague*, p. 300 Merwin, p. 289 Goodeve; also Walker, section 38.

In *Tilghman* v. *Morse*, p. 298, 9 Blatch. 421, the "sandblast" for cutting glass was held patentable, although it had been used on locomotives to drive cows off the track; in one case the sand came in contact with the cow, in the other with the glass: *Held*, a non-analogous use and therefore patentable.

Penn v. *Bibby* (A.D. 1866), L. R. 1 Eq. 548, p. 366 Goodeve. The hardwood bearing for shafts of screw propellers is also an instance of a patentable double use or non-analogous use as referred to in *Smith* v. *Goldie*, 9 Sup. Ct. Rep. (Can.), p. 53, by Ritchie, C. J.; also in *Ball* v. *Crompton*, 13 Sup. Ct. Rep. (Can.), p. 486, by Henry, J.; and in *Smith* v. *Goldie*, 7 App. Rep. (Ont.), 628, by Patterson, J., the principle laid down, there being relied on and approved of.

Patentable Invention and Non-Patentable Discoveries, Defined in Recent English Cases.

In *Lane-Fox* v. *The Kensington Electric Lighting Co.*, 1892, 3 Ch. at p. 429, Lord Justice Lindley states: "A man who discovers that a known machine can produce effects which no one before him knew could be produced by it, may make a great and useful discovery; but if he does no more, his discovery is not a patentable invention. He has added nothing but knowledge to what previously existed. A patentee must do something more; he must make

some addition not only to knowledge, but to previously known inventions, and must so use his knowledge and ingenuity as to produce either a new and useful thing or result, or a new and useful method of producing an old thing or result. On the one hand, the discovery that a known thing—such, for instance, as a Plante battery—can be employed for a useful purpose for which it has never been used before is not alone a patentable invention; but, on the other hand, the discovery how to use such a thing for such a purpose will be a patentable invention, if there is novelty in the mode of using it, as distinguished from novelty of purpose, or if any new modification of the thing, or any new appliance is necessary for using it for its new purpose, and if such mode of user or modification or appliance involves any appreciable merit. It is often extremely difficult to draw the line between patentable *inventions* and non-patentable *discoveries*," etc.

See also same definition reiterated in *Moser* v. *Marsden*, July 17th, 1893. Court of Appeal (Eng.) Times L. R., vol. 9, p. 584.

And in *Gadd* v. *The Mayor of Manchester*, Times L. R. vol. 9, p. 42, November 4th, 1892. The following rules are laid down:

1. A patent for the mere new use of a known contrivance without any additional ingenuity in overcoming fresh difficulties is bad, and cannot be supported. If the new use involves no ingenuity, but is in manner and purpose analogous to the old use, although not quite the same, there is no invention, no manner of new manufacture within the meaning of the statute.

2. A patent for a new use of a known contrivance is good, and can be supported if the new use involves practical difficulties which the patentee has been the first to see and overcome by some ingenuity of his own. An improved thing produced by a new and ingenious application of a known contrivance to an old thing, is a manner of new manufacture within the meaning of the statute.

If practically there are no difficulties to be overcome in adopting an old contrivance to a new purpose, there can be no ingenuity in overcoming them, and there will be no invention. The same rule will apply when the means are so obvious as to be apparent to every one of ordinary intelligence."

Hamilton v. *Heyward*, Griffin's Pat. Cas. 115, a patent for a pavement light, referred to as a case where a patent was upheld, the change being merely the use of one well-known kind of prism for another.

(*c*) **"Any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement in any art, machine, manufacture or composition of matter."**

The foregoing is the definition of the expression "*invention*" in sub-section *c.* of section 2 of the Patent Act, and has been further defined in the note thereto.

The definition occurs in the same words in 7 Geo. IV., c. 5

(1826), the earliest Patent Act in Upper Canada, and was doubtless taken from the U. S. Patent Act of 1793, where it occurs in the same words, except that "on" takes the place of "in" after improvement, and the same definition of an invention is continued through all, previous Canadian Patent Acts down to the present day.

The invention must be "new and useful," and generally speaking any combination which produces a new and useful result is patentable; and provided it be new, when utility is found to exist in any degree, a sufficiency of invention to support the patent must be presumed: *Vide Smith* v. *Goodyear Dental Vulcanite Co.*, 98 U. S. (Sup. Ct.), p. 495; *S. C.*, 11 Brodix, p. 1.

And in *Washburn and Moen Co.* v. *Haish*, 4 Fed. Rep. (1880), the Court remarked: "In the absence of any other test the Courts have seemed to assume, that the fact of the acceptance of a new device or combination by the public, and putting it into extensive use was evidence that it was the product of invention; or as one of the counsel of the plaintiff expressed it 'utility is suggestive of originality.'"

Each element of a combination may be either a new one or an old one, and so long as the combination produces a new and useful result, it is a patentable combination.

In *Emery* v. *Iredale*, and *Emery* v. *Hodge*, 11 U. C. C. P. R. (1861), tried under the provisions of Con. Stat. Can., c. 34 (1859). An action for the infringement of a patent for the manufacture of eave-troughs.

The elements were proved to have been known and used before. The plaintiff had combined these well-known parts, viz.: the spindle to put a bead to the tin, and the block shaped so that by beating the tin or iron plate upon it, the requisite shape was given, and the use of pressure instead of beating to force the plate upon the block.

The patent was upheld, and Rule *nisi* for new trial discharged.

Draper, C. J., states that it does not follow, that because the different parts uncombined had been in use before; that their combination may not be the subject of a valid patent, and quotes Lord C. J. Abbott, in *Brunton* v. *Hawkes*, 4 Ban. & Ard. p. 550, "a patent for a machine, each part of which was in use before, but in which the

combination of the different parts is new, and a new result is produced, is good, because there is novelty in the combinations."

In *Muir* v. *Perry*, 2 L. C. R., p. 305, S. C. (1852), an improvement in fire engines, by a new combination of old parts, whereby greater results were obtained, was held patentable.

In *Patric* v. *Sylvester*, 23 Grant, p. 573 (1876), for infringement of a patent for new and useful improvements in seed drills.

The number of mechanical powers are limited (viz., the inclined plane, the lever, the pulley, the wheel and axle, the wedge and screw), yet their combinations may be very numerous, and a new combination of previously known elements is the proper subject of a patent.

Smith v. *Goldie*, 9 Sup. Ct. Rep. (Can), p. 46, judgment delivered June 19th, 1883, reversing 7 Ont. App. Rep., p. 628, *and not affirming it* as on p. 1549 of the Ontario Digest, 1880-90. Spragge, C., who originally tried the case, dismissed the action, on the ground of importation, after twelve months from the granting of the patent:—

Held, in the Supreme Court, to have been a new combination of old elements, whereby a new and useful result was obtained.

There is nothing to warrant the headnote to Supreme Court case, that it consisted of three elements, A, B, C, each of which was old, and of which A had previously been combined with B in one machine and B and C in another machine, but the united action of which produced a new and useful result.

In a subsequent suit of *Smith* v. *Greey*, tried at Toronto, before Mr. Justice Proudfoot, in 1886—it was shown that the combination of Smith's Middlings Purifier, viz.,—the reciprocating sieve, the fan and air chambers and the upward draft of air through the bolting cloth of the sieve, and the travelling brush or brushes arranged to traverse the under side of the bolt, etc., was a combination which had been in use in the States prior to Smith's alleged invention. In a mill in Ohio, instead of a brush such as Smith's, there had been the same combination, and a fleece of wool had been employed to automatically keep the meshes of the bolting cloth clear of dust.

Although Smith's patent had been upheld in the Supreme Court, Canada (1883), there was no novelty in it; by some fatality the evidence was not adduced, although at that time available, and so the Supreme Court had no evidence before it showing anticipation, etc.

On p. 60, vol. 9, Sup. Ct. Rep. (Can.), it was stated to have been admitted in the Court of Appeal that no one before Smith had used the combination; and again on p. 57, vol. 9, Sup. Ct. Rep. (Can.), it was admitted that Smith was the real inventor of the art or process of purifying middlings, neither of which statements were correct; and in some way Smith was credited in the factum of appellants with having revolutionized the trade of flour manufacture, which was also incorrect.

Although the principle affirmed in the Supreme Court is correct that a new combination of old elements producing a new and useful result is patentable, yet had the evidence been before the Supreme Court it can hardly be doubted the patent would not have been sustained—as it had clearly been anticipated as shown in *Smith* v. *Greey*, in Ontario and in the States.

Harrison v. *Anderson Foundry Co.*, 1 App. Cas., 574, in the Lords, affirms the proposition that there may be a new combination of old elements, producing, if not a new result, a known result, in a much more useful and beneficial way.

And in *Beam* v. *Merner*, 14 O. R., p. 423, where the validity of the patent was unquestioned. Cameron, C. J., says: "The combination was different from that in other machines to accomplish the same purpose, though each of the things was old and in use before the patent."

In *Murray* v. *Clayton*, L. R. 7 Ch., 570, on p. 316, Goodeve, James, L. J., citing *Crane* v. *Price*, 4 M. & G., 580, says: "Neither I, nor, so far as I am aware, any other Judge, has questioned the principles upon which that case was decided and which are thus laid down in the judgment of the Court, delivered by Tindal, C. J. 'We are of opinion that if the result produced by such a combination is either a new article, or a better article, or a cheaper article to the public than that produced before by the old method, such combination is an invention or manufacture, intended by the statute, and may well become the subject of a patent.'"

The same general principle is also sustained in the United States.

In section 119, Merwin lays down the general proposition that

a patentable combination must produce either a new mode of operation, or a new result.

In section 120, Merwin, Mr. Justice Curtis, in *Forbush* v. *Cook*, 2 Fisher 668 (when a combination of machinery was the subject of a patent), says: "It is decisive evidence, though not the only evidence, that a new mode of operation has been introduced, if the practical effect of the new combination, is either a new effect, or a materially better effect, or as good an effect more economically attained, by means of the change made in the combination of the patentee. A new, or improved, or more economical effect, attributable to the change made by the patentee in the mode of operation of existing machinery proves that the change has introduced a new mode of operation, which is the subject matter of a patent; and when this is ascertained, it is not a legitimate subject of enquiry, at what cost to the patentee it was made, nor does the validity of the patent depend upon an opinion formed after the event, respecting the ease or difficulty of attaining it."

New Combination Defined.

Mr. Justice Ferguson, in *Wisner* v. *Coulthard*, tried before him in Toronto, in his judgment (unreported) of 7th February, 1890, relating to a combination in a seeding machine, states: "As I understand the law upon the subject, *a new combination* may be composed entirely of old and well-known elements, though it must be a combination and not a mere juxtaposition of parts or elements. If from an old and well-known combination an element is taken away, and an element which is itself new is introduced in its place, forming a combination with the remaining old elements which in its operation produces new and useful results in a more useful and beneficial way, I suppose this would undeniably be a good combination; and so long as a good new combination may be composed of elements that are all old ones, I fail to see the difference between such a combination and the one claimed by the plaintiffs. Nor do I see the difference between an old element that has been used in a combination, and an old element that has not been so used."

In *Smith* v. *Dental Vulcanite Co.*, 93 U. S. 495, (1876), 11 Brodix, p. 1, it was held that where other facts leave the question of invention in doubt, the fact that the device has gone into general use, and displaced other devices which had previously been employed for analogous purposes, is sufficient to turn the scale in favour of existence of invention.

But in *Fox* v. *Perkins et al.* (decided October 5th, 1892), U. S. C. Ct. of App., Off. Gaz., vol. 62, p. 160, it was held that large sales of a patented machine, while evidence more or less cogent of value and usefulness are not conclusive evidence of patentable novelty, and are of little weight when it appears that

such sales are the result of active and energetic efforts by means of circulars and travelling agents: *McClain* v. *Orimayer*, 57 O. G., 1129; 12 Sup. Ct. Rep., 76; 141 U. S., 427, followed. See also *Duer* v. *Corbin Cabinet Lock Co.* (May 1st, 1893), Sup. Ct. U. S., vol. 63, O. G., p. 1060.

In *Loom Company* v. *Higgins*, 105 U. S., 580 (1881), Merwin, p. 476, as bearing on the question of invention, Mr. Justice Bradley, delivering the opinion of the Supreme Court, says: "It may be laid down as a general rule, though perhaps not an invariable one, that if a new combination and arrangement of known elements produce a new and useful result never attained before, it is evidence of invention."

This case related to improvements in looms, which consisted in combining well-known devices, which defendants claimed were an "aggregation."

Examination as to Novelty, etc.

In the United States there is a very strict examination as to the novelty of the alleged invention, with appeal from the decision of the Primary Examiner to the Board of Examiners, from the decision of the Board to the Commissioner of Patents, and from his decision to the Supreme Court of the District of Columbia.

In Canada there is a preliminary examination as to novelty: *Vide* section 8 of the Patent Act Amendment, 1892, c. 24.

In England the examiners merely ascertain whether the application is in proper form, this investigation does not extend to novelty, and the same is the case as to most foreign patents.

In Canada and the United States the production of the Letters Patent in Court is *primâ facie* evidence of novelty.

Utility.

Utility must exist in some degree, the thing or process must be able to perform its functions and produce a result. Patents are not held void for want of utility because they perform their functions but poorly: *Vance* v. *Campbell*, 1 Fisher, 485 (1859); *Canover* v. *Roach*, 4 Fisher, 16 (1857).

In Britain the invention must have some utility or there is a failure of consideration, though there is no express proviso in the Statute of Monopolies that it must be useful. It is sufficient

to show by experts that the invention would be useful: *Neilson* v. *Harford*, 1 Web. P. C., 202.

A very slight amount of utility is necessary to support a patent: See *Pilpott* v. *Hanbury*, R. P. C., vol. 2. (1885), p. 37.

As to English cases on Utility: See Higgins, p. 143.

A patent is *primâ facie* evidence of utility: *Vance* v. *Campbell*, 1 Fisher, 485 (1859). And doubts relevant thereto should be resolved against infringers: *Whitney* v. *Mowry*, 4 Fisher, 215 (1870).

The invention must come under the heading of "an art, machine, manufacture or a composition of matter," or "any new and useful improvement in an art, machine, manufacture or composition of matter." For if it cannot be classed under any of the headings of subject matter for which a patent may be granted under our Act, the patent may not be upheld.

In the *County of Fond du Lac* (*Plaintiff in Error*) v. *May*, 20 Brodix, p. 500 (1890); 137 U. S. 395, in a patent for an improvement in the construction of prisons, it was held not to be either for an art, a machine, a manufacture, or a composition of matter, and did not come under any of the headings under which a patent might be granted.

In this case, the novel idea set forth in the patent was to interpose a grating between the jailor and the prisoners at every stage of opening or shutting a door.

The mechanism was old in its use to move a door or a gate at a distance, and the mechanical operation was the same, whether there was a grated iron barrier or not.

Cochran v. *Diener*, 94 U. S., 789; 11 Brodix, 396, cited; also *Jacobs* v. *Baker*, 7 Wall., 295; 7 Brodix, 483.

(*d*) **"Which was not known or used by any other person before his invention thereof."**

The Patent Act of 1826 for Upper Canada, required that the invention should not be known or used "before the application," now it is before "his invention thereof."

The U. S. Acts of 1790 and 1793, contained the same wording as our Act of 1826, "not known or used before the application," there was no limit as to place.

In the Patent Act of 1849 (Can.), 12 Vic., c. 24, the invention to be patentable must be one "not known or used in this Province by others before his or their discovery or invention thereof, and not at the time of the application for a patent in public use or on sale in this Province with his consent or allowance as the inventor thereof."

And in the said Act of 1849, the following singular proviso to a section relating to an action for damages was inserted, which subsequently appeared in the Con. Stat. Can., c. 34, 1859, "If the patentee believed himself to be the first inventor, the patent shall not be void on account of the invention or discovery thereof having been known or used in a foreign country, it not appearing that the same or any material or substantial part thereof had been patented or described in any printed publication. This was evidently taken from the 15th section of the U. S. Patent Act of 1836, where it occurs as a proviso, the intention of our Act of 1849, being to make the requirements the same as in the U. S. Act of 1836, in this respect. Our Act of 1849 was more liberal to patentees than the U. S. Act of 1836, in that, in the U. S. Act, there was no limit as to place, as to knowledge, or use, if not within the proviso of said 15th section.

By 5 and 6 Wm. IV. c. 83, the Privy Council, England, on petition, might confirm a patent when the patentee has discovered that he was not the true and first inventor, provided the patentee when he obtained his patent was unaware of that fact and that the invention had not been publicly and generally used before the date of his patent: *Vide* Hindmarch, c. 8, p. 201. This Act is not now in force.

The proviso referred to has disappeared from our statutes since the Patent Act of 1869, repealing the Con. Stat. Can., c. 34, 1859, but is still retained in the United States as section 4923, Rev. Stat. U. S.

In the U. S. Rev. Pat. Stat., sec. 4886, taken from the Act of 1870, the meaning of the Act of 1836 was extended in the interest of patentees, and now reads "not known or used by others in this country and not patented or described in any printed publication before his mention or discovery thereof." These added words, and section 4923 Rev. Pat. Stat. U. S., relating to prior knowledge or use in a foreign country without the knowledge of the patentee, make the United States requirements more liberal to patentees than those in our present Act.

The different changes bearing on the cognate expression "not known or used" etc., in the Statutes of the United States are as follows :—

(1) By section 1 of the *Act of 1793*, the invention must be one "not known or used before the application," as in the Canadian Act of 1826, and the application may only be made by a citizen of the United States.

(2) By section 1 of the *Act of 1800*, the privileges were extended to all aliens who had resided for two years within the United States; and it was provided that the applicant must make oath that the invention "hath not to the best of his or her knowledge or belief, been known or used in this or any foreign country."

(3) By section 6 of the *Act of 1836*, it was provided that the invention must be one "not known or used by others before his or their discovery or invention thereof, and not at the time of his application for a patent, in public use or on sale, with his consent or allowance, as the inventor or discoverer." And the applicant must also make oath, "that he does not know or believe that the same was ever before known or used." There is a proviso, however, in the 15th section as to *bonâ fide* inventors in the States, as to knowledge or use in foreign countries already referred to.

(4) By section 24 of the *Act of 1870*, the invention must be one "not known or used by others in this country, and not patented, or described in any printed publication in this or any foreign country before his invention or discovery thereof, and not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned," may, etc., obtain a patent therefor.

(5) Section 4886 of the Rev. Stat. U. S., contains the same provision as section 24 of the Act of 1870. In referring to United States cases bearing on this question it must be borne in mind that it was not till the Patent Act of 1870, that the knowledge or use was confined to the United States; before the Act of 1870 it might refer to knowledge or use anywhere in the world, subject to the exception in section 15 of the Act of 1836.

Novelty in the States is not negatived by anything which was invented, patented or described prior to the patent sought to be anticipated, nor prior to the application therefor, unless the anticipating event was prior to the date of the invention: *Cochrane* v.

Deiner, 94 U. S. 791 (1876); *Elizabeth* v. *Pavement Co.*, 97 U. S. 130 (1877).

In England, when an invention is known prior to the date of the patent by persons under no obligation as to secrecy, the patent is invalid as well as where it had previously been publicly used: See *Humpherson* v. *Syer*, R. P. C. vol. 4, (1887), p. 407, but a knowledge of an invention privately or confidentially communicated is insufficient: *Morgan* v. *Seaward*, 2 M. & W. 544; *Useful Patents Co.* v. *Rylands*, 2 P. O. R. 355; and American case, *Hall* v. *Bird*, 6 Blatch, p. 439.

When no article had been produced in a number of years from an alleged anticipating specification it is a strong argument against anticipation: *Dowling* v. *Billington*, R. P. C. vol. 7, p. 204 (1890).

A machine complete but not proved to have been used, held not sufficient as an anticipation: *Parkes* v. *Hulme*, 1 Fish. 45.

If a prior patent was an anticipation it does not matter whether the invention in it was used or not: *King* v. *Anglo-American Brush Corporation*, R. P. C. vol. 7, p. 440 (1890).

In Canada we have retrograded from the position taken up by the Act of 1849, where the knowledge, use, or sale, was confined directly to the Province, and the provision as to knowledge and use in foreign countries existed, and in the respect just discussed it is more difficult in Canada to sustain a patent now than in 1849. The addition of the words "in this country" refers the knowledge or use to within the United States, and correspond with the words "in this Province," in our Act of 1849.

A patent granted in England (or elsewhere) before the United States patentee *made his invention* negatives the U. S. Patent: See *Walker*, s. 55. In section 56 Walker, it is suggested that a drawing without descriptive words may be held to be a printed publication. The U. S. Act appears very sweeping as to publication before the U. S. invention, and refers to the States or any foreign country.

First Inventor.

To determine who was the first inventor in the case of rival applicants involves some nice points.

In section 308 Merwin, the right to a patent as between rival inventors depends on three things: (1) Conception of the invention (2) reduction to practice (3) reasonable diligence. And in a race of diligence he who first reduces his invention to a fixed, positive, and practical form, has a priority of right to a patent. *Ellithorpe* v. *Robertson*, 2 Fish., 83 (1859); *Parkhurst* v. *Kinsman*, 1 Blatch. 488 (1849); *Many* v. *Jagger*, 1 Blatch. 372 (1849); *Reed* v. *Story*, 1 Story, 590.

What is required is a practical working machine: *Union Sugar Refining Co.* v. *Mathieson*, 2 Fisher, p. 626.

Merwin, sec. 250: *What is such a reduction to practice as will anticipate a subsequent invention?*

It is well established that an application withdrawn or rejected will not suffice: Corn Planter Pat. 23 Wall. 181 (1874). A drawing will not suffice: *Ellithorpe* v. *Robertson*, 2 Fish. 83 (1859); *Wiman* v. *New York & Harlem R. W. Co.*, 4 Fish. 1; see also English Cases, *Ex parte* Henry L. R. 8 Ch. 170, and *Carpenter* v. *Smith*, 1 W. P. C. p. 534; or even a model: *Cahoon* v. *Ring*, 1 Fish. 397, Walker, sec. 61 (1859); *Johnson* v. *McCullough*, 4 Fish., p. 175 (1870): See also English Cases *Lewis* v. *Marling*, 1 W. P. C. 49.

Drawings, Proof of Conception.

Making drawings and sketches is sufficient evidence as to prior date of conception, section 310, Merwin: *Kneeland* v. *Sheriff*, 2 Fed. Rep. 901, sec. 380, Robinson.

In the absence of other evidence of the dates of invention, the first application must be taken to represent the first invention: *Pennington* v. *King*, 7 Fed. Rep. 462 (1881), sec. 69, Walker.

The foregoing cases bearing on priority of invention between rival inventors and the race of diligency were decided before the U. S. Act of 1870, when knowledge or use is expressly limited to the U. S. A., and in this respect, are similar to our law; but it has to be borne in mind that by the 15th section of U. S. Act of 1836, exception is made in favor of *bonâ fide* inventors in U. S. A. who had no knowledge of similar foreign inventions, etc.

The rules as to priority of invention as between rival inventors in U. S. A. are:

1. He is the first inventor who has first conceived the invention in a definite form capable of reduction to practice, provided he follows it up to reduction to practice with reasonable diligence.

2. He who first conceives, but is not diligent in reducing to practice, will be postponed to another independent inventor who was subsequent to conceive but who first, with due diligence, reduces to practice.

3. Where dates of conception cannot be determined by reason of conflicting testimony, he who first reduces to practice will be adjudged the first inventor.

See *Ransom* v. *New York*, 1 Fish. 252; *Reed* v. *Cutter*, 1 Story 590; *Seymour* v. *Osborne*, 11 Wall. 516.

In *The Queen* v. *La Force*, decided January, 1894, in the Exchequer Court of Canada, Mr. Justice Burbidge, is of opinion that it was not the intention of the Legislature that the construction placed on the U. S. Patent Law bearing on the race of diligence just mentioned should be followed, that in this respect the U. S. Act differed from ours (see extract from judgment, *infra*). He also states therein "It appears to me that the doctrine that he who first conceives an invention is to be preferred to him who first reduces it to practice and gives it the public, leads of necessity to an enquiry as to what men may have done in secret, and opens wide and dangerously a door to perjury and the fabrication of evidence," but Burbidge, J., is of opinion that the one who first makes known the invention to the world should be preferred.

First Applicant in Britain—Inventor.

And in Britain, where two persons independently claim to have invented the same thing, the person who first makes application for the patent is held in default of conclusive evidence to the contrary to be the first inventor: *Vide Dolland's Case*, cited in *Boulton* v. *Bull*, 1 W. P. C. 432, Hy. Bl. 469; *Forsyth* v. *Reviere*, Chit. Prerog. 182.

True and First Inventor (Eng.).

A party is the true and first inventor within the meaning of the Patent Act (1883), whether he invents himself or whether he simply imports a foreign invention. He is none the less the true and first inventor if he both imports a foreign invention and improves it.

See *Moser* v. *Marsden*, Ct. of App., July 17th, 1893; Times L. R., vol. 9, p. 584.

These English cases which recognize the first introducer into the realm as the true and first inventor are not applicable to Canadian cases of the present day.

In case of two grants to different persons for the same invention, the Court is not bound by the dates of the patents or by the fact that the rival patentees had contested their claims to priority of grant before the law officer: *Kurtz* v. *Spence* (No. 3), 57 L. J., Ch. 238.

In Austria-Hungary, the day and hour of application settles the priority of the announced discovery or invention, and, except in the case of imported inventions, the first applicant is the true and lawful owner of the invention, whether he be the inventor or not.

British Patent Act of 1883, sec. 7, sub-sec. 6: Where there are conflicting applications for the same invention, the Comptroller may refuse to seal a patent on the application of the second applicant, subject to appeal to the law officers.

A subsequent patentee is at liberty to prove himself a first and true inventor: *Kurtz* v. *Spence*, R. P. C., vol. 5, 179 (Eng.).

First Inventor.

The date of the application is *primâ facie* the date of the invention: *Vide*, sec. 372, Robinson.

The earliest conceiver, if he acts with reasonable diligence, is entitled to the patent: Section 383, Robinson.

Priority of Invention—Reduction to Practice.

The following U. S. case in the Circuit Court of Appeals, 6th Circuit, decided March 22nd, 1893, bears directly on the question

of the race of diligence: See *Christie* v. *Seybold*, O. G., vol. 64, p. 1,650.

1. The man who first reduces an invention to practice is *primâ facie* the first inventor under the Act of July 4th, 1836 (which Act has the same provision as the present Canadian Patent Act as to knowledge or use, not limiting either to the country, subject, however, in U. S. A. to the proviso in section 15 as to prior knowledge or use in foreign countries, etc.); but the man who first conceives the invention may date it back to such conception if he uses due diligence in reducing it to practice, and he must use such diligence before, as well as after, the second conception of the invention: *Reed* v. *Cutter*, 1 Story, 590, followed.

2. A rough sketch of an invention is not such a reduction to practice as makes its author the original inventor: *S. C.*

The date of the application for a patent, if containing the description, is taken as the date of conception: *Vide Dane* v. *Chicago Manufacturing Co.*, (1872), 6 Fisher, 130; also section 132, Robinson.

Suggestions from Others.

Morse's right to the title of inventor of the telegraph was challenged, and thereof the Supr. Ct. said: "Neither can the enquiries he (Morse) made, nor the information he received from men of science in the course of his researches, impair his right to the character of an inventor": *O'Reilly* v. *Morse*, 15 How., 62.

And again the Supr. Ct. U. S. held: "Where a person has discovered an improved principle in a machine, manufacture or composition of matter, and employs other persons to assist him in carrying out that principle, and they, in the course of experiments, arising from that employment, make valuable discoveries, auxiliary to the plan and preconceived design of the employer, such suggested improvements are, in general, to be regarded as the property of the party who discovered the original improved principle, and may be embodied in his patent, as part of his invention": *Agawam Co.* v. *Jordan*, 7 Wall., 583.

Burden of Proof.

The burden of proof of want of novelty is on him who avers it, and every reasonable doubt should be resolved against him: *Coffin* v. *Ogden*, 18 Wall., 120 (1873), and must be beyond reason-

able doubt: *Cohancey Manufacturing Co.* v. *Wharton*, 28 Fed. Rep. 191 (1886).

In Great Britain the actual inventor or the first introducer or importer of the invention into the realm, is entitled to be the patentee. In European countries, generally, the first introducer of the invention into the country is entitled to take out the patent, except in Norway, Sweden, Switzerland and Italy where the inventor, or his legal representative, is alone entitled to Letters Patent.

Absolute Novelty—First Inventor.

As to the question of absolute novelty the world over being a pre-requisite for a patent in Canada, there is nothing in the judgment in *Smith* v. *Goldie*, 9 Sup. Ct. R. Can., p. 46, to justify that part of the headnote which so states, viz.: "To be entitled to a patent in Canada, the patentee must be the first inventor in Canada or elsewhere. A prior patent to a person who is not the true inventor is no defence against an action by the true inventor under a patent issued to him subsequently, and does not require to be cancelled or repealed by *sci. fa.*, whether it is vested in the defendant or in a person not a party to the suit."

The same headnote appears in the Ontario Digest, 1880-90, p. 1,547, part 1—First Inventor—erroneously referring it to *Smith* v. *Goldie*, 9 Sup. Ct. R., 46. It also forms part of the headnote copied into Cassels' Digest of Supreme Court Decisions, 1875-93, from the headnote of *Smith* v. *Goldie*, 9 Sup. Ct. R. p. 46-47, and is erroneous both as to the reference to the Supreme Court judgment, and also to the description of the invention, there being more than three elements; and it is also erroneous in not having been previously combined, as stated.

The headnote in *Smith* v. *Goldie*, 7 Ont. App. R. 628, describes the invention accurately, as does also the judgment of Patterson J., p. 629.

The statement that a patentee must be the first inventor in Canada or elsewhere, is derived from the remarks of Patterson, J. A., on p. 640-641, 7 Ont. App. R., who compares the language of the 6th section of the Act of 1872, 35 Vic., c. 26, at that time in force, and the corresponding section of the Act of 1869, 32-33 Vic., c. 11, sec. 6, which differs from the Act which had been pre-

viously in force in the Province of Canada. Con. Stat. Can., c. 34, sec. 3 (1859): Patterson, J. A., states:

"The last named Act authorized the granting of a patent to the inventor of a new and useful art, etc. The same not being known or used in this Province by others before his discovery or invention thereof. While that Act was in force no one was entitled to a patent under it, except a subject of Her Majesty.

"The Act of 1869 extended the privilege to any person who had been a resident of Canada for one year before his application, and that of 1872 (not 1875 as on p. 641) removed the restriction as to residence, thus in all respects placing foreigners on the same footing with subjects, but at the same time and as a complement of this extension of the prvilege, required absolute and not merely novelty within the Dominion in the invention. The language is, therefore, more general, as used in the two later statutes, 'the same not being known or used by others before his invention thereof.'"

The reference to the *sci. fa.* proceedings in the headnote of the Supreme Court case appears to be suggested by the statement of counsel on p. 48 of 9 Sup. Ct. R. Can.; there is nothing in the judgment itself bearing on this question.

If the headnote attributed to the Supreme Court case of *Smith* v. *Goldie*, 9 Sup. Ct. R. Can., 46, be the interpretation of our Patent Law by our highest Court, and to be entitled to a patent in Canada the patentee must be the first inventor in Canada or elsewhere, as would appear to be the case from judicial expressions of opinion and from the judgment in *The Queen* v. *La Force*, Exch. Ct. Can. (1894), hereafter mentioned, then the position of a patentee in Canada is more precarious in this respect than that of any other patentee in any other country in the world. In no other country is there such a sweeping provision by statute; in all other countries, so long as the invention be not "known or used" in the country in which the patent is sought to be obtained, it suffices.

In most European countries, the "inventor" is taken to be the first introducer into the country.

Suggested Amendments to our Act.

The words "in this country" should be again inserted after "not known or used by any other person," as it is in section 4886 of the R. S. U. S., and there should also be restored the clause of C. S. C., c. 34 (1859), before referred to, viz.: "If the patentee believed himself to be the first inventor the patent shall not be void on account of the invention or

discovery having been known or used in a foreign country, it not appearing that the same or any material or substantial part thereof had been patented or described in any printed publication," which is the provision now of section 4923, R. S. U. S. It should also be expressly provided that the printed patent or publication referred to in our Consolidated Act (1859) should be shown to have reached and been accessible to the public in Canada before the Canadian invention had been put in practical working form.

The fact that the words "in this Province" of the Patent Act of 1849, as well as that the whole of the last quoted section had been expressly dropped out of our Patent Act of 1869, affords ground for arguing the harsh proposition that a Canadian invention, to be patentable in Canada, must have absolute novelty both as to Canada and the rest of the world.

In *Smith* v. *Goldie*, 7 Ont. App. Rep., it would appear that Smith's Canadian and U. S. patents were later in point of date to the Canadian patents of Lacroix and Sherman, yet Smith's patent cut theirs out, as he was a prior inventor in U. S. A. (See p. 634.)

The Queen v. La Force, Reported in Can. L. T., vol. 14, p. 27. To be reported in full in 4 Ex. Ct. R. Can.

In *The Queen* v. *La Force*, decided in the Exchequer Court of Canada, by Mr. Justice Burbidge, 9th January, 1894, he opened by stating, that "the main question in this case is, whether under the Patent Law of Canada, a prior foreign invention, of which the public had no means of knowledge, is sufficient to defeat a patent issued to an independent Canadian inventor. The question arises upon issues joined in a proceeding, wherein Thomas B. Jeffery, of the city of Chicago, U. S. A., cycle manufacturer, has sued out a writ of *scire facias* to repeal Letters Patent No. 37,890, for an improvement in pneumatic tires, granted to the defendant."

In a very elaborate judgment he finds in favour of the defendant on all the issues.

As this is the first Canadian judgment which bears directly on the meaning of the words in section 7 of the Patent Act "Which was not known or used by any other person before his invention thereof," and involves matters of great moment; extracts from this judgment, which covers 100 folios, appears to be called for.

The effect of the judgment is, that the knowledge or use referred to in section 7 is a knowledge or use *by the public*, and

not a secret knowledge or use, such as a communication to one's own partner or to a patent solicitor employed by the inventor.

The invention in dispute was a pneumatic tire.

Date of La Force's Invention.

La Force struck on the idea in the latter part of April, 1891, and during the week preceding the 25th May, following, he communicated his invention to his brother. On that day, with the latter's assistance, he made, as an experiment, a section of such a rim or tire, and within two weeks thereafter, a rim and tire complete. In July he consulted Mr. Ridout, his patent solicitor, who, on or about the 3rd of August, applied for a patent, which was granted on the 2nd of December, 1891.

Date of Jeffery's Invention.

About the 9th of March, 1891, Jeffery made some cloth and tin models, and on the 15th of the same month, a drawing, showing three ways, one of which was the same as shown in the patent in suit. This drawing was shown to his partner, Mr. Gormally, on the same day, and the models to his patent solicitor a few days after.

About the last of March, 1891, Jeffery made a model of a section of a tire, such as La Force's, now in question; on the 4th of July he made a sketch and description which he explained to his patent solicitor on the 13th of July, who, on the 27th of July, 1891, applied for a patent in the Patent Office (U. S.), which was granted 12th January, 1892; on the 5th February, 1892, Jeffery applied for a Canadian patent, and obtained a Canadian patent, 1st June, 1892, or six months after La Force, in Canada.

It was a contest between rival independent inventors.

The Judge states: "The simple question is, must La Force's patent be set aside in favour of Jeffery's because the latter, an American citizen, residing at Chicago, had two months earlier than La Force invented and disclosed in confidence to his partner and to his patent solicitor the improvement for which the patent issued, although his application for a Canadian patent was not made until after La Force's had been granted."

The Meaning of "Known or Used" Defined.

He then refers to the 7th and 10th sections of the Act and shows that La Force was in a position to make the oath required

in the 10th section:—As stated in the judgment, "Prior to his application, the invention had not been 'in public use or on sale' in Canada, or for that matter, elsewhere; and prior to his invention, which, regarded as a conception, may be taken to have been complete as early as the last of May, 1891, it was not known or used by any other person, within the true meaning of these words, which have reference not to a secret use or the knowledge of an earlier inventor, or of those to whom in confidence he may have disclosed it, but to such a publication or use as affords the public the means of information or knowledge of the invention. The improvement had not been used in public, had not, in fact, been used at all, and any knowledge there was of it, was not in any way open or accessible to the public. Jeffery knew of it, of course, for he had in March preceding invented it, and he had communicated his knowledge to Gormally and Burton, both of whom, however, stood in a confidential relation to him and were interested, the one as a partner and the other as a solicitor, in keeping such knowledge from the public."

He then deals as he puts it, "with the contention on which the prosecutor mainly relies, that under the Patent Act of Canada, he, who the world over, first invents anything, is entitled to a patent therefor, and to have set aside in his favour any Letters Patent for the same thing that may, prior to his application have been granted to a subsequent independent inventor."

That this contention rests on the provisions of the Patent Act as set out in the 7th, 16th, 24th (disclaimer) and 32nd sections. Burbidge, J., states: "And it is said that the words of the 7th section 'any person who has invented' read with the other sections in which the term 'first inventor' occurs, mean absolutely and without qualification the person who anywhere has first invented a new and useful thing."

He then points out that the law of England and that of the United States of America is different on the question as to who is "the first inventor" and gives reasons why English rather than United States precedents should govern; that under the Statutes of Monopolies (21 Jac. 1, c. 3) one may be a first and true inventor, though he has, in fact, invented nothing, it suffices if he is the first introducer into the realm, and quotes *Househill Co.* v. *Neilson* (1 Web. P. C. 719), where Lord Lyndhurst states that "the first person who discloses that invention to the public is considered as the inventor"; also *ex parte Henry* (L. R. 8, Ch. 167) Lord Selborne says: "If such applicant were the true inventor, the circumstance of something having taken place somewhere else which was not disclosed to the world, and as to which no prior application had been made, would be no answer to him."

That in the patent laws of the United States the words "original and first inventor" do not mean absolutely the person who first invents, for no prior invention in a foreign country stands in

the way of an independent inventor within the United States of America unless the result of the foreign invention had been published in a patent or printed book. (See sec. 4,886-4,923 U. S. Rev. Stat.) If the foreign inventor of something which has not been so patented or published goes to the United States or entrusts his secret to an agent, the date of his arrival there or that of his agent will be taken as the date of his conception. (See Robinson on Patents, sec. 382).

And as between two independent inventors in the United States of America, he who was the second to invent will become the original and first inventor, if he is the first to reduce the invention to practical form by embodying it in a machine capable of useful operation, and if the first inventor fails to use reasonable diligence, in reducing the invention to practice. (Robinson on Patents, sec. 370.)

And that one may by the laws of the United States be the first inventor of a lost art. (Robinson on Patents, secs. 322, 323.)

As to Publication.

Burbidge, J., says:—"What the applicant for a patent of invention offers to the public for the grant thereof, is the knowledge of his invention; but the public may have no means of knowledge until he publishes or discloses the invention, and publication forms an essential part of the consideration." And the learned Judge considers that when La Force filed his application in the Patent Office at Ottawa, it was open to the inspection of the world. (R. S. C., c. 61, sec. 47.)

[NOTE BY EDITOR.—"Although this section on its face indicates this, yet the specifications therein referred to are the specifications on file after patent granted. It is not the practice in the Canada Patent Office, nor that of the United States, nor of the United Kingdom (before acceptance) to throw pending applications open to the public, and Rule 15 Patent Office Can. (see App. 1) shows this to be the case; so merely filing an application for a patent can hardly be a publication." *Ex parte Wyckoff*, 60 O. G., 1104.]

On the other hand, Mr. Justice Burbidge points out, that when, on the 5th February, 1892, Jeffery applied for a Canadian patent,

he had nothing to offer to the public, for on the previous 2nd of December, 1891, La Force's previous patent for the same invention had already been granted and the invention disclosed.

He could merely affirm that in a foreign country he knew of the thing two months before La Force knew of it, and that he had not in the interval, anywhere, given the invention to the public.

As to the Public Knowledge or use in a Foreign Country.

Mr. Justice Burbidge states:—"One can understand how the Parliament of Canada, going further, it is true, in that direction than the Parliament of the United Kingdom, or the Congress of the United States has yet gone, has, in what was deemed to be the interests of the general public of the Dominion, made prior public knowledge or use of an invention anywhere, a bar to a Canadian patent therefor. But one fails, I think, to apprehend why it should in favour of a foreigner, on the ground only of his earlier conception of the invention, make void a patent issued for good cause and consideration to an independent Canadian inventor, for an invention that prior thereto had not been used in public anywhere, and of which the public in no part of the world had any means of knowledge."

Burbidge J., then argues that the words "inventor" and "first inventor" used in our patent laws have not always meant absolutely and without qualification the person who, the world over, first invented some new thing—and with infinite trouble investigates nearly all the Acts relating to the various Provinces mentioned in the first chapter of this work, commencing at 4 Geo. IV., c. 25, 1823 for L. C. to the present time.

Burbidge, J., refers to the American origin of our earliest Patent Acts in Upper and Lower Canada (taken from the U. S. Act of 1793) and of other Provincial Acts derived from the same source, which leads to the inference that where English and American decisions do not run on the same lines, as in controversies between rival inventors they do not, the latter and not the former should in the construction of Canadian patent law be followed, but in his careful review of pre-confederation statutes, he makes out the contrary, and cites incidents which, as he puts it, "tend to show that it was the intention of the legislatures of the several Provinces of Canada, while adopting in a general way the language of the Patent Laws of the United States, to adhere, in respect of this question, to the principles and doctrines of the English law."

The Race of Diligence as between Rival Inventors.

Burbidge, J., states: "There is nothing in our statutes to give us a suggestion or hint as to whether, in the case of rival inventors within the Province, the one who first clearly conceives the invention, or the one who reduces it to practice and communicates it to the public was to be preferred, but having obtained the patent, it was certainly good against any knowledge or use of the invention outside of the Province, and not accessible or open to the public, as well as against knowledge or use of a rival inventor within the Province.

"There is, however, one important clause of the 15th section of the Act of 1836 (U. S.) which has never found a place in any Act of any Province of Canada. Dealing with the subject of defences to actions for infringement, it was there provided '*inter alia*' that the defendant might set up as a defence and prove that the plaintiff had surreptitiously or unjustly obtained the patent for that which was in fact invented or discovered by another who was using reasonable diligence in adapting and perfecting the same. Here we have what has been thought to be a distinct recognition of the doctrine that a patent issued to one who was an independent inventor might be defeated by a prior undisclosed invention by another who was using reasonable diligence in adapting and perfecting the same.

"The corresponding defence, as described in the statutes of the Province of Canada, was that the patent should be void if the patentee had surreptitiously obtained it for the invention or discovery of another person."

From this he concludes that the legislatures of the several Provinces did not intend to incorporate in such Acts the construction as to rival inventors which the Courts of the United States had placed thereon.

And on reviewing the various Patent Acts of Canada up to 1869, and of the Provinces of Nova Scotia, New Brunswick, or Prince Edward Island, he finds that they did not demand that the patentee be absolutely the "first inventor," but that he should be a true inventor; and, that the invention should be one that had not been in use or described in some public work prior to his invention; and, that the term "first inventor" in these sections, means now (referring to the present Patent Act), as in the pre-confederation statutes, the person, who, being a true inventor of some useful thing, first discloses his invention to the public.

And referring to the Canadian Patent Act of 1872, when foreigners were admitted to the privilege of the Patent Laws of Canada, he can find "no indication of any intention, on the part of Parliament, to confer upon them any special privileges."

[NOTE BY EDITOR.—It is the law in England, that where two persons, independently, claim to have invented the same thing, the person who first makes an application for the patent, is held, in default of conclusive evidence to the contrary, to be the first inventor; and, though the patent may be granted to both, if the examiner does not notice the coincidence, and no opposition be made to the second, yet, the owner of the patent of earlier date has the sole right to the new matter claimed, and the second cannot use it without the permission of the first.]

Finding.

He concludes: "In the result, I am of opinion, that under the Patent Law of Canada, a prior foreign invention, of which the public had no knowledge, or means of knowledge, is not sufficient to defeat a patent issued to an independent Canadian inventor. Whether the same rule should apply in the case of conflicting applications for patents, is another question. In the present case, the patent having been issued, the Crown's power or authority in respect thereof is exhausted. If the patent be good, if there be no ground of impeachment, it must stand, and the second patent is waste paper"; and he finds, on all the issues raised, in favour of the defendant and judgment with costs.

Note in the Queen v. La Force.

The foregoing judgment is a very important one and a step in the right direction, as liberalizing the Canadian Patent Law, and although Mr. Justice Burbidge holds that under our Patent Act a public knowledge or use, anywhere, of an invention, prior to the invention of an independent Canadian inventor, may avail to defeat his patent, it is to be hoped that, some day, we may have legislation to assimilate our Patent Law, in this respect, to that of the United States, already referred to. See U. S. R. S., 4886, 4923. Even if an application filed in the Patent Office, in Canada, is not open to the inspection of the world, it was undoubtedly the case that La Force was the first to publish the invention, for he obtained his Canadian patent 2nd December, 1891, whereas, Jeffery obtained his earliest or United States patent on the 12th January, 1892, and Burbidge, J., points out that an application filed in U. S. Patent Office is not a publication, so the basis on which Burbidge, J., rests his judgment still holds good.

Still the difficulty remains, *what constitutes a public know-*

ledge or use? The learned Judge clearly states that a prior public knowledge or use, anywhere, suffices to defeat a Canadian patented invention; would a prior public knowledge or use in, for instance, the Sandwich Islands, Madagascar or Persia suffice? or is it confined to the United States, the United Kingdom, France or Germany, etc.? Where are we to draw the line? The whole difficulty could be got over by amending the section so as to make it read (as formerly was the case) "not known or used by any other person in this country before his invention thereof," and putting us on the same footing as to knowledge or use as the United States, the United Kingdom and other principal countries of the world.

The words "known or used" in our Act are in the disjunctive, so if the invention be publicly known, even though not publicly used, this may suffice to defeat a Canadian patent.

The American interpretation of the words "known or used" which first appear in the U. S. Act of 1793, and are retained to the present day, mean "known or used by the public." See *Pennock* v. *Dialogue*, 2 Peters, p. 17 (A.D. 1829), and *Shaw* v. *Cooper*, 7 Peters 318, 319 (A.D. 1833), strongly support the view taken by Mr. Justice Burbidge in his exhaustive judgment; for the old U. S. statutes, under which these old cases were decided, run on the same lines as our present Canadian section, which was derived therefrom, and were before the U. S. Act of 1836, which diverges from our present Act, as already pointed out.

It is also to be noticed that Burbidge, J., is of opinion that the legislatures of the several Provinces did not intend that the construction which the Courts of U. S. A. had placed on their Patent Acts in the matter of the race of diligence between rival inventors, should be adopted, but that as between two independent inventors in Canada, the one who first applied for and obtained his patent and discloses the invention to the world should be preferred.

(*e*) **"And which has not been in public use or on sale with the consent or allowance of the inventor thereof, for more than one year previously to his application for a patent therefor in Canada."**

The meaning of this portion has been materially changed for the worse so far as patentees are concerned by the removal of the comma in the Revised Patent Act in front of "in Canada," thus making it read "application in Canada," instead of as formerly held "public use or on sale in Canada"; the invention would now appear to be one which has not been in public use or on sale anywhere in the world with the consent or allowance of the inventor for more than one year previous to his application. This exposes a Canadian patent to still another danger since the revision, rendering it still more attackable than formerly.

In *Smith* v. *Goldie*, 7 App. Rep. (Ont.), p. 641-642, counsel endeavoured to refer the words "in Canada" to the application, as is now the case, although the comma was at that time, before the words "in Canada," so as to make it appear that there must not be public use or sale, anywhere, more than one year before the application in Canada, and thus fix the plaintiff Smith with public use, or having the invention on sale in the United States so as to invalidate his patent, but the Court of Appeal, *per* Patterson, J., held that the "public use" or "on sale," referred to in the Act, was use or on sale within Canada, and that the policy of the Act of 1872 was the same as that of the Act of 1869, which expressly mentioned use or on sale in any of the Provinces of the Dominion.

As an inventor has in the United States two years within which his device may be in public use or on sale before his application for a patent, an inventor might procure a patent under section 8, and still his patent may be voided by more than one year's prior use or being on sale in the United States.

Prior use or offering for sale for more than one year in any foreign country may invalidate a Canadian patent, but it is more likely to occur with reference to the United States than elsewhere. In the United States they are in the same position as here; for a public use or sale after invention, but more than two years before application occurring in any foreign country, has the same effect as occurring in the States: See Walker, sec. 101; *Root* v. *Third Avenue R. W. Co.*, Sup. Ct., U. S. (November, 1892); 61 O. G., U. S., p. 1947.

Such public use or being on sale must be "with the consent or allowance of the inventor," anything done in fraud of his right, and without his knowledge, could not tell against him.

The time is limited in Canada to one year before the application, and was first introduced in the Patent Act of 1872—in analogy to the U. S. Act which limits the time to two years—and was a step in the right direction.

Public Use.—As to the meaning of "public use": *Vide* Walker, sec. 94.

In *Egbert* v. *Lippman*, 104 U. S., 333, the Supreme Court held that, "If an inventor, having made his device, gives or sells it to another, to be used by the donee or vendee, without limitation or restriction, or injunction of secrecy, and it is so used, such use is public, even though the use and knowledge of the use may be confined to one person."

Prior User.—Unless the prior use be in public, or in a way accessible to the public, it is not an invalidating prior use: *Cahoon* v. *Ring*, 1 Cliff., 592; *Haselden* v. *Ogden*, 3 Fish., P. C., 378.

Prior Use Calls for Strong Proof.

In *Cluett* v. *Claflin*, 30 Fed. Rep., 921, the Supreme Court, U. S., has said: "The burden of proof is on the defendant to establish this defence. For the grant of Letters Patent is *primâ facie* evidence that the patentee is the first inventor of the device described in the Letters Patent and of its novelty. Not only is the burden of proof to make good this defence upon the party setting it up, but it has been held that 'every reasonable doubt should be resolved against him.'" A Circuit Court has said: "This defence (of prior use) must be established by proof as explicit and convincing as that required to convict a person charged with crime, proof which preponderates the complainants testimony not only, but which satisfies the mind beyond a reasonable doubt": See also *Cantrell* v. *Wallick*, 117 U. S., 689.

If a genuine prior use has occurred, and is fully proved, a subsequent disuse thereof will not prevent it from being an invalidating prior use: *Waterman* v. *Thomson*, 2 Fish., 461; *Sharp* v. *Henrici*, 2 Ban. & Ard., 249.

Prior use is not proved by a prior patent: *Weston* v. *White*, 13 Blatch., 364; nor by incomplete and imperfect experiments made by others at an earlier date: *American Wood Paper Co.* v. *Fibre Disintegrating Co.*, 23 Wall., 566; and it means a prior use by another prior to the patentee's invention: *Klein* v.

Russell, 19 Wall., 433; nor is it proved by a prior conception, although it proceed to a patent prior in point of date to that in suit: *Tyler* v. *Crane*, 7 Fed. Rep., 775.

An invalidating public use in the U. S. A. for two years prior to the application, may be by the inventor or another and may be with or without the inventor's consent: See *Andrews* v. *Hovey*, 8 U. S. Rep., 676.

If the inventor allows his invention to be used by other persons generally, either with or without compensation, then it will be in public use within the meaning of the statute: *Elizabeth* v. *Pavement Co.*, 97 U. S., 135 (1877); *Andrews* v. *Hovey*, 16 Fed. Rep., 393 (1883); *Root* v. *3rd Avenue R. W. Co.*, Sup. Ct., 61 O. G., p. 1947; Walker, sec. 94.

If the inventor uses his invention for profit and not by way of experiment, that is also a public use: *Elizabeth* v. *Pavement Co.*, (*supra*); *In re Adamson's Patent*, 25 L. J. Ch., 456, and other cases on p. 147 Higgins on Patents (1884); *The Household Co.* v. *Neilson*, p. 265 Goodeve.

As to public use and not an experimental use voiding a patent: *Vide Hessin* v. *Coppin*, 17 Grant, 629.

Experimental use is never a public use: *Vide* Walker, sec. 95; and *Summers* v. *Abell*, 15 Grant, p. 532 (1869).

In Great Britain a patent is not destroyed by prior experimental user: *Vide Galloway* v. *Bleaden* (1839), 1 Web. P. C. 521, Goodeve p. 207; *Bentley* v. *Fleming*, Goodeve 42.

User of a pirated article for the purpose of experiment and instruction to pupils of an English electrician is a user for advantage and is an infringement of the patent: *United Telephone Co.* v. *Sharples*, 29 Ch. D., 164.

A public use of an invention means a use of the invention *in public* not *by the public*: *Betts* v. *Neilson*, L. R. 3 Ch., 429.

A trifling use not long continued will be treated as experimental: See *Cornish* v. *Keene*, 1 Web. P. C., p. 511.

On Sale.—Walker, sec. 96, defines the meaning of "on sale" within the meaning of the statute.

A single instance of sale of one specimen constitutes putting the invention on sale: *Consolidated Fruit Jar Co.* v. *Wright*, 94

U. S., 94 (1876). And a device will be on sale within the meaning of the Act if offered for sale, whether any specimen be sold or not: *Plimpton* v. *Winslow*, 14 Fed. Rep., 921 (1883).

A sale for crucial experiment is not obnoxious to the law: *Vide Graham* v. *Manufacturing Co.*, 11 Fed. Rep., 142 (1880); *Graham* v. *McCormack*, 5 Ban. & Ard., 244.

The term "on sale" means an offering or exposing for sale.

A Sale for Profit not Always a Public Use.

A *bonâ fide* experimental use beyond the statutory limit is allowable. As a rule such use for profit is a fatal one: *Draper* v. *Wattles*, 3 Ban. & Ard., 618; but in *Manufacturing Co.* v. *Sprague*, 8 Sup. Ct. Rep., U. S., 122, held that this rule is not invariable, for if the main motive of this use be test, trial or experiment, the incidental taking of profit is not necessarily fatal; but where the use is mainly for the purposes of trade and profit, and the experiment is merely incidental to that, the principle and not the incident must give character to its use: See also to same effect the English case *Jones* v. *Pearce*, 1 Web. P. C., 124.

But in *Smith & Davis Manufacturing Co.* v. *Mellon*, decided October 30th, 1893, 66 O. G., p. 173: Where a manufacturer places an article on the market in the usual and accustomed line of business, and sold a considerable number over a lengthened period, more than two years before applying for a patent, to see what his customers think of it, it cannot be said to be an experiment within the meaning of the statute: "*It is a trader's, not an inventor's experiment.*" The experiment was not a testing for the purpose of discovering defects and perfecting the invention, but a testing of the market.

Egbert v. *Lippman*, 104 U. S., 333, was referred to, the Supreme Court, U. S., said: "We observe, in the first place, that to constitute the public use of an invention it is not necessary that more than one of the patented inventions should be publicly used."

The proof on the part of the patentee as to the use being an experimental use should be full, unequivocal and convincing: See *Smith Manufacturing Co.* v. *Sprague*, 123 U. S., 249.

"With the consent or allowance of the inventor."

This consent clause has since 1870 been dropped out of the U. S. Act, although still retained in Canada, before that date in the United States the consent of the inventor was a necessary element of the facts upon which the old law raised a constructive abandonment: *Wyeth* v. *Stone*, 1 Story, 281, and other cases mentioned in section 102, Walker. That consent need not be given in writing or even in words. Acquiescence suffices to prove it. *Sisson* v. *Gilbert*, 9 Blatch., 188 (1871).

This consent clause has formed a portion of our Act since 12 Vic., ch. 24 (1849).

No patent right covers any use or sale of any specimen of the thing patented, which was purchased of the inventor or made by another with his knowledge or consent before his application for a patent therefor: *Wade* v. *Medcalf*, 16 Fed. Rep., 130 (1883). This is specially provided for in section 4899 Rev. Stat. U. S.

Where another than the inventor, surreptitiously obtains knowledge of an invention, and without the consent of the inventor, makes a specimen of the invented thing before the patent thereon is applied for, that specimen is covered by a patent for that invention as truly and fully as it would be by an infringer after the date of that patent: See *Walker*, sec. 158.

The reference throughout is to a completed invention.

"For more than one year," means "earlier than one year": *Vide Consolidated Fruit Jar Co.* v. *Wright*, 94 U. S. 94 (1876).

As to Public Use in Great Britain.

A patent is invalidated in Great Britain if, prior to the grant, the article is offered for sale although no sale is actually effected: *Oxley* v. *Holden*, 8 C. B. N. S., 666; *Morgan* v. *Seaward*, 1 Web. P. C., 194; *Heath* v. *Smith*, 3 El. & Bl., 256.

Patent for locks invalidated by prior manufacture in England of seven and a-half dozen of the locks for exportation to America: *Carpenter* v. *Smith*, 1 Web. P. C., 530.

The publicly making and selling an article to one individual, though there was no demand or use for it by the public, held to have invalidated a subsequent patent: *Losh* v. *Hague*, 1 Web. P. C., 205.

A patent may be invalidated in England by the prior deposit of the patented article in a warehouse for sale, although no sale has taken place: *Mallins* v. *Hart*, 3 Car. and Kir., 297.

Prior "public user" in a British Colony does not invalidate a patent in Great Britain, provided the thing be a new invention within the realm: *Vide Rolls* v. *Isaac* (1881) L. R. 19 Ch. D. 268, Goodeve, p. 404.

(*f*) **"May on petition to that effect presented to the Commissioner."**

NOTE.—The form of petition referred to is 1 to 5 in the annexed Appendix No. 1 of Forms, still in use in the Patent Office, Ottawa, and recites the wording of the old Act of 1872, "not known or used by others (in the present Act it is by 'any other person') before his invention thereof and not being ('now, which has not been') in public use or on sale with his consent or allowance as such inventor ('now, with the consent or allowance of the inventor thereof') for more than one year previous (now, previously) to his application for a patent therefor in Canada."

A petition following the wording of the Revised Act would now be more in form, the foregoing portions in the brackets show the portions substituted in the Revised Act.

(*g*) **"And on compliance with the other requirements of this Act."**

NOTE.—The 8th, 9th, 10th, 12th, 13th and 14th sections of this Act are more specifically referred to, and the subject matter must not come under any of the disabilities referred to in the 16th section of the Act.

(*h*) **"Obtain a patent granting to such person an exclusive property in such invention."**

A Patent Prima Facie Evidence of Validity.

In the United States where a preliminary examination is made, Letters Patent are *primâ facie* evidence of their own validity: *Vide* Walker, sec. 491.

But in *Allen* v. *Reed*, 14 Q. L. R. 126, S. C., the Court held in Quebec that there was no presumption in law in favour of the validity of a patent, which is opposed to the practice in Ontario, where the production of the Letters Patent is *primâ facie* evidence of novelty and validity, the onus is on the opposing party to show the contrary.

The term "exclusive" property has a somewhat misleading application here, for under the 37th section of this Act, the patentee has only for two years strictly an exclusive property in his invention; after that period he must carry on in Canada the manufacture in such a manner that any person desiring to use it may obtain it or cause it to be made for him at a reasonable price, etc., as commented on under that section.

In the United States there is no such provision, as in our section 37, and a patentee may be said to have an exclusive property; he is under no obligation to manufacture his patent at all, as is the case with us, as well as in France, Germany, Austria, and some other foreign countries, where manufacture is imperative.

In Great Britain under section 22 of the Patent Act of 1883, licenses are compulsory.

Note to Sub-sec. 2 of Sec. 7.

Very many machines, articles and compounds can be put to both a lawful and unlawful or illicit use; for instance, a burglar's tools may be very good and useful tools in the hands of an honest workman; no person need set out the illicit object he has in view when he is obtaining a patent; so a burglar now may obtain a patent for his "jemmy."

A "scientific principle" or abstract theorem *per se* cannot be patented. The "hot air blast" for furnaces may be taken as illustrative; it was found that heated air blown on to the fire in a smelting furnace instead of cold air, by interposing a receptacle between the blowing apparatus and the furnace, produced a much better article. While the patentee could not obtain a patent for the "principle," he could for the means of carrying that principle into effect, and being a pioneer patent, the first in the field, the means covered all other means of carrying the principle

into effect: *Vide Neilson* v. *Harford*, 1 Web. Pat. Cas., 273-373; this case went to the House of Lords and is discussed in secs. 135, 138, and elsewhere in Curtis.

Baron Alderson in *Jupe* v. *Pratt*, 1 Web. Pat. Cas., 146, lays down, as now recognized, "You cannot take out a patent for a principle; you may take out a patent for a principle coupled with the mode of carrying the principle into effect, provided you have not only discovered the principle, but invented some mode of carrying it into effect; if you have done that, then you are entitled to protect yourself from all other modes of carrying the same principle into effect, that being treated by the jury as piracy of your original invention."

Of the same nature were the telephone patents. Bell had a broad claim for the "electric transmission of speech" by means of certain defined instrumentalities, he could not claim "the principle" by itself, but having a pioneer patent, he made all modes of carrying the principle into effect tributary to his.

The *principle* of raising water from wells for animals by means of their own weight not patentable: *Merrill* v. *Cousins*, 26 U. C. Q. B. R., p. 49.

The Patent Act of 1849, 12 Vic., made a principle patentable, through some mistake; this was repealed by 14 and 15 Vic., c. 79, expressly.

In the electric telegraph patent, Morse claimed not only the machinery as a new invention but also by the 8th claim the principle of using the motive power of the electro magnetic fluid for the purpose generally, the majority of the Judges of the Supreme Court, U. S., held that the 8th claim was void, because it was too comprehensive; it was virtually a claim for an abstraction: See *O'Reilly* v. *Morse*, 15 How., 52.

In *Boulton* v. *Bull*, 2 Hy. Bl., 463 (referred to in p. 62, *Smith* v. *Goldie*, 9 S. C. R., by Henry, J.), it is stated:

"A mere principle is an abstract discovery incapable of answering the term 'manufacture,' but a principle so far embodied and connected with corporeal substances as to be in a condition to act and produce effects in any art, trade or manual occupation, becomes the practical manner of doing a particular thing and is no longer a 'principle,' but a 'process.'"

An abstract theorem would cover Newton's discovery of the law of universal gravitation—or Kepler's Laws.

Abandoned Applications.

U. S. Ex. rel Fowler et al. v. *Commissioner of Patents*, decided June 23rd, 1890, 62 O. G., 1968.

On petition for a mandamus to inspect "the abandoned cases in the U. S. Patent Office." *Held*, that no such broad right exists to the public, and the writ refused: U. S. *Ex. rel U. S. Electric Lighting Co.* v. *Commissioner of Patents*, C. D. (1891), 271; 54 O. G., 267, cited.

If, however, the petitioners shall make request for certified copies of one or more abandoned applications, accompanied by a reasonable suggestion of their necessity for the purpose of evidence, the request will be granted under authority conferred upon Commissioner by Rule 179.

The request for such copies must be presented in the form of a petition properly verified, as appears by Form 52, U. S. Patent Office.

When defendant wishes to make out that the plaintiff is relying on a patent, as to which there had been an abandoned application, which had not been prosecuted for the past two years and upwards, and that a suit was pending against the petitioner based on said patent, and that to enable the petitioner to prepare and conduct his defence, it is material that he be allowed access to and copies of files of such abandoned case, he may obtain copies as indicated.

It may often be material in a Canadian suit to obtain copies relating to an abandoned application in the U. S. Patent Office.

8. Any inventor who elects to obtain a patent for his invention in a foreign country before obtaining a patent for the same invention in Canada (*a*), may obtain a patent in Canada, if the same be applied for within one year from the date of the issue of the first foreign patent for such invention (*b*); and, if within three months after the date of the issue of a foreign patent, the inventor gives notice to the commissioner of his intention to apply for a patent in Canada for such invention, then no other person having commenced to manufacture the same device in Canada during such period of one year, shall be entitled to continue the manufacture of the same after the inventor has obtained a patent therefor in Canada, without the consent or allowance of the inventor (*c*); and under any circumstances, if a foreign patent exists, the Canadian patent shall expire at the earliest date on which any foreign patent for the same invention expires (*d*). 35 V., c. 26, s. 7, The Patent Act (1886); 55 and 56 V., c. 24, s. 1 (1892).

NOTE.—The foregoing was substituted by 55 and 56 Vic., c. 24, s. 1 (1892), for sec. 8 of the Patent Act, ch. 61, Revised

Statutes, which was repealed, and aimed at getting over a difficulty and danger to patentees experienced in the former enactment, whereby any one who had commenced to manufacture in Canada an invention between the date of a patent in any other country for such invention, and the application for a patent therefor in Canada, such person would continue to have the right to manufacture and sell the invention, notwithstanding the issue of the subsequent Canadian patent; now by giving notice as stated in the new section 8, a provision is made.

This section only relates to patents issued after the 9th July, 1892.

Inventor and Suggested Improvement.

(*a*) The term "inventor" in this section 8 is too restricted, for we have seen, under section 7, that an assignee, a firm or corporation may petition for and obtain a patent; also that an assignee or a legal representative of a deceased inventor may also obtain a patent, provided the oath be made as required under section 10. The same term "inventor" was, in the Act of 1872, and in the Revised Statutes, it certainly does not cover an assignee or a firm or a corporate body, or an assignee or a legal representative of a deceased inventor, it is suggested that "any person entitled to obtain a patent in Canada" be substituted.

Again, the section relates only to a patent in a "foreign country" which excludes Great Britain and Ireland and British Colonies and possessions, so that a British or an Australian or an Indian patentee, etc., would not, it appears, be embraced in this section; but query whether he should not notify the Commissioner in order to obtain the protection of the section with reference to any other person manufacturing his invention in Canada; both the Revised Statute and the Act of 1872 state that an inventor shall not be entitled to a patent for his invention "if a patent therefor *in any other country* shall have been in existence in such country more than twelve months prior to the application for such patent in Canada," which, of course, covered all countries outside of Canada, including Great Britain, etc.; now there is no restriction as to Great Britain, the Colonies, etc. The change from "in any other country to" in a foreign country is express.

(*b*) The year is, of course, a calendar year, and the date of the issue of a foreign patent is in France, Austria, Hungary, Italy, Spain, Norway and Sweden, and in some other foreign countries, the date of filing the application, though not invariably so. In Germany the term commences the day following the day of application. In the United States patents are generally dated and issued after allowance, on the third Tuesday after the applicant pays the final Patent Office fee.

In the United States, if the invention be previously patented to another in any foreign country under section 4886, it cannot be lawfully patented in the States. In *Smith* v. *Goodyear D. V. Co.*, 11 Brodix, 1, the prior filing of a provisional specification did not invalidate the U. S. patent, though the filing of the completed specification would. But contra, if U. S. invention were prior to the foreign invention: *Vide Cochrane* v. *Diener*, 94 U. S., 791; *Elizabeth* v. *Pavement Co.*, 97 U. S., 130.

Under the Canada Patent Act of 1869, application might be made within six months of the date of the foreign patent; since the Canada Patent Act of 1872 the time has been extended to one year.

When does this year expire? For instance, if a U. S. patent were dated May 20th, 1892, would it be in time to make the application in Canada on May 20th, 1893? It would appear from the following English and U. S. authorities that the day of the date of the U. S. patent must be reckoned inclusively.

In *Russell* v. *Ledsam*, 14 M. & W., 647, it was held that when the original Letters Patent were dated on the 26th February, 1825, and renewed Letters Patent were dated 26th February, 1839, the day of the date must be reckoned inclusively, and that the former term expired 25th February, 1839: See Wallace on Patents (1884), p. 36.

On 15th June, 1844, a patent was issued to Charles Goodyear for India rubber fabric, reissued December 25th, 1849, and extended by the Commissioner of Patents as reissued June 15th, 1858, and again reissued to defendant's executor November 20th, 1860. The extension sought to be vacated expired June 14th, 1865: See U. S. *Ex rel. Bourne* v. *Goodyear*, 8 Brodix, p. 209, April 23rd, 1870.

This suit was commenced June 15th, 1865. Defendant demurred because the extension having expired before the bill was filed, there was no equity to support the bill. The Court below sustained the demurrer affirmed by the Supreme Court. A present interest commenced June 15th, 1858, and, therefore, June 15th, 1865, when this suit was commenced, was excluded from the term of seven years: *Pearpoint* v. *Graham*, cited, 4 Wash. (C. C.) 232.

(*c*) The "three months" referred to in section 8 are calendar months under the Interpretation Act; and the "foreign patent" is one to the same inventor. The notice to be given the Commissioner of Patents is not stated to be a written notice, so it is open to the contention that the notice may be either verbal or written; the onus would be on the inventor to prove that he had given the requisite notice, which, in the usual course of business, should be a written communication. The notice affects every person manufacturing, of whatever nationality. Rule 18, Can. Pat. Office (see Appx. 1); provides that all business with the Patent Office should be transacted in writing.

As the section now reads, it is only inferentially and by reference to the repealed section, that we understand that failure to give the required notice within three months of the issue of a foreign patent, entitles an unauthorized person, who has commenced to manufacture in Canada the article so patented abroad, within the date of the foreign patent and of the application for a patent therefor in Canada, to continue to have the right to manufacture and sell such article notwithstanding the issue of a Canadian patent therefor.

Although this, no doubt, is the intent of the new section, it is open to question how far that intent has been carried into effect.

It may be also noticed that the new section refers only to a right to "continue the manufacture," without conferring a right also "to sell" as was the case in the old section, although it might be argued, that, here the right to continue the manufacture implied also the right to sell, otherwise the right would be nugatory. The old wording "shall continue to have the right to manufacture and sell such article" is much better and should have been retained.

In the absence of express enactment, as in the repealed section,

it is difficult to see how this new section clothes an authorized person with any right; the specific articles manufactured prior to the issue of the Canadian patent would be covered by section 46.

The consent or allowance of the inventor referred to as entitling to continue the manufacture after the issue of the Canadian patent, should be a written consent or license, and should have been so expressed, for section 29 enacts that every person, who, without the consent, in writing, of a patentee, "makes, constructs or puts in practice any invention," etc., shall be liable in an action of damages.

The specific articles manufactured during the year prior to the issue of the Canadian patent would be covered by section 46, which enacts that: "Every person who, before the issuing of a patent, has purchased, constructed or acquired any invention for which a patent is afterwards obtained under this Act, shall have the right of using and vending to others the specific article, machine, manufacture or composition of matter patented and so purchased, constructed or acquired before the issue of the patent therefor, without being liable to the patentee, etc., for so doing," unless the invention had become public property within the meaning of the section.

In France and her colonies, a patent cannot extinguish rights already existing at the date of the patent, consequently, if any person be in possession of the patented invention, and using it at the date of the patent, though such use will not invalidate the patent, he can continue to use it during the entire period of the patent in defiance of the patentee.

Prior Issue of a Foreign Patent.

(*d*) The effect of a prior issue of a foreign patent, may have an important bearing on the life of the Canadian patent, and the provisions of this section are more in the interests of foreign patentees than of Canadian patentees, for the latter, now that the life of a Canadian patent has been extended by section 22 to eighteen years, would generally obtain their patents in Canada first; otherwise, for instance, as an United States patent has seventeen years to run from the date of issue, a Canadian patent might be so applied for, subsequently, as to shorten its life from eighteen years to less than sixteen years.

The same shortening process of the life of the Canadian patent

may also take place with respect to patents for the same invention first issued in (among others) the foreign countries mentioned in Form 50 Appendix 2, except Belgium and possibly Spain; the expression, "if a foreign patent exists" in this section indicates that reference is made to a prior foreign patent, and not one subsequently issued.

There is a danger always to be borne in mind in taking out with Canadian, a batch of foreign patents, viz.: that in Britain and France and most other countries, notably in Germany, there are very strict conditions as to publication; in Germany, prior to application there the invention must not appear in any printed work in any country in such a manner that it may be constructed or made therefrom; so that a German patent cannot be legally obtained if applied for after the issue of an United States patent or the printing and publication of the English final specification.

For fees payable when notice is given under section 8, see note to section 39.

The International Convention.

Belgium, Brazil, France, Great Britain, Guatemala, Italy, Holland, Norway, Portugal, Servia, Spain, Sweden, Switzerland, Tunis, the United States, and the Colony of Queensland, have formed themselves into a union for the protection of industrial property, "with power to add to their number." Of these, Holland, San Domingo, Servia and Tunis have as yet no patent laws; they are more concerned in trade marks.

An international office is maintained at Berne at the expense of the Union.

Patentees can import their patented articles from one country of the Union into any other country of the Union, and publish them there without forfeiture of patent rights during the six or seven months hereinafter mentioned; and the application for a patent for an invention in any country of the Union by subjects of that country gives provisional protection in all the others for six months, or seven months in the case of countries beyond the ocean. In England, the time begins to run from the date of application for the foreign patent.

The Convention of Berne was concluded at Paris, 20th March, 1883, approved of by Lord Lyons, 17th March, 1884, with express understanding that power is reserved to Her Britannic Majesty to accede to this Convention on behalf of the Isle of Man and the Channel Islands and any of Her Majesty's possessions, on due notice given through Her Majesty's Government.

There is an important provision in section 103 of the British Act of 1883, which by Order-in-Council (see section 104), may be made applicable to "any British possession." The only British possessions that have come within the provisions of said section 103 by British Order-in-Council are New Zealand and Queensland; Canada has not yet become a party to the International Convention at Berne to which section 103 relates; through apathy or neglect an Order-in-Council has never been sought.

In Mann's Patent, 7 P. O. R., p. 13 (1890), Webster, A. G., held that an applicant was entitled to have his English patent antedated, although his foreign application was made before the country in which it was made had come under section 103: See Edmunds, p. 517.

In order to antedate an application in England (see Form A[2] British Patent Rules), a certified copy of the original specification must be obtained from the Patent Office of origin and the British patent dates from the date of application in the foreign country.

A person to whom an invention has been communicated from abroad cannot claim, under said section 103 of the British Act, rights under the International Convention, as a patent can only be granted to the person who has made the foreign application.

In the case of designs and trade marks, application must be made within four months of the date of applying for protection in the foreign state.

The Effect of Expiry of a Foreign Patent.

In Canada we have no judicial decisions as to the effect of allowing a prior foreign patent for the same invention to lapse by non-payment of fees, or not working or manufacturing in the foreign country, but in the United States, under a similar pro-

vision in *Pohl* v. *Anchor Brewing Co.* (Sup. Ct.), 20 Brodix, p. 186 (October, 1889); 134 U. S., 385: *Held*, that there is nothing in the statute (Rev. Stat., sec. 4887), which admits of the view that the duration of the U. S. patent is to be limited by anything but the duration of the legal term of the foreign patent in force at the time of the issuing of the U. S. patent, or that it is to be limited by any lapsing or forfeiture of any portion of the term of such foreign patent by means of the operation of the condition subsequent according to the foreign statute.

Bate Refrigerating Co. v. *Hammond*, 129 U. S., 151 (19 Brodix, 231), decided January 21st, 1889, where a Canadian patent was held not to have expired in five years; the extension for fifteen years being entirely of right and at the option of the patentee on payment of a fee, the U. S. patent does not expire before the end of the fifteen years of the Canadian patent, and it does not affect the validity of a U. S. patent if the limitation due to the foreign patent does not appear on its face.

And a repeal of a foreign patent, which might otherwise limit the life of a U. S. patent, restores it to its full term of seventeen years: *Bate Refrigerating Co.* v. *Gillett*, 20 Fed. Rep., 192 (1884).

In *Huber et al.* v. *N. O. Nelson Manufacturing Co.*, 63 O. G. (U. S.), p. 311 (decided March 27th, 1893), Sup. Ct., U. S.

A United States patent applied for and granted after the expiration of a foreign patent for the same invention never had any force or validity. The delay in applying for the U. S. patent until after the foreign patent expired amounted to an abandonment of the right to a U. S. patent. This decision destroyed Edison's quadruplex telegraph patent and his microphone patents.

Bate Refrigerating Co. v. *Hammond, supra*, was cited, and, although not exactly in point, for the Canada patent was in force when the U. S. patent was granted; yet it was held in the Court below, as a logical conclusion from this decision, that a U. S. patent which was issued subject to the provisions of section 4887 of the Revised Statutes, whereby it remained in force no longer than the foreign patent having the shortest term, that this section

4887 took effect upon it, and if the previous foreign patent had been allowed to expire before the application, that section 4887 caused it to expire the same instant in which it was created, and that the patent was strangled in its birth.

Pohl v. *Anchor Brewing Co., supra*, was also cited, but in this case the foreign patent was also in force when the U. S. patent was granted.

How the expiry of a foreign patent, which is relied on to curtail the patent in suit, is to be proved, suggests a difficulty. In Ontario it is a usual practice for solicitors to mutually agree to admit as evidence uncertified copies of printed British and foreign patents, so as to save the expense of certification at so much per folio of printed matter; and little or nothing is usually said as to proof of publication in Canada. Although the seals of Patent Offices are not cognizable in our Courts in the same manner as seals of foreign Courts of Record, certified copies have continually been admitted as evidence; at any rate, for the purposes of the trial they would doubtless be admitted, and any further proof, that might be deemed necessary, could be secured after the trial, if insisted on.

Expert evidence would be admissible in Ontario to show that the foreign patent is for the same invention as the Canadian. Such is the practice in the States: *Bischoff* v. *Wethered*, 9 Wallace, 812 (1869); if no evidence is offered it is the practice in the United States for the Court to determine the matter by inspection of the documents: *de Florez* v. *Raynolds*, 17 Blatch., 439 (1880).

A British patent is dated and sealed as of the day of application (see sec. 13, Pat. Act, 1883), and has fourteen years to run except in the case of incomplete description, when the Comptroller may post date the application as of the day the corrected specification was received at the Patent Office; while in India, New Zealand, Australasia, Ceylon, Cape of Good Hope, British Guiana and Honduras, the term is also fourteen years, and the law is based on the British law.

In Great Britain, by section 25 of the Patent Act of 1852, Letters Patent obtained in the United Kingdom for patented

foreign inventions were not to continue in force after the expiration of the foreign patent. This section was dropped out of the Act of 1883, and now no British patent becomes invalid by the expiry of a foreign patent.

If there be previous foreign patents, an American patent expires at the same time as the one having the shortest term, in the same manner as in Canada.

To determine whether a prior foreign patent exists, the comparison should be instituted between the domestic patent as it was issued, and not with the domestic patent as it may afterwards exist after being cut down by disclaimer and limited by the state of the art. If a patent, when granted, covers an invention which has been previously covered by a foreign patent, it expires with the foreign patent, notwithstanding the fact that it has subsequently been pared down to cover only one method of practising the invention or restricted to a single claim: See *Electrical Accumulator Co.* v. *Julien Electric Co. et al.*, U. S. Circ. Ct., 5th Dist., New York, decided July 18th, 1893; 64 O. G., p. 559.

Though the domestic patent claims the product and the foreign patent claims the process, still where the process makes the product and the product can only be made by the process, the product and the process constitute one discovery, and the patents are for the same invention: *Electrical Accumulator Co.* v. *Julien Electric Co., supra*; *Mosler* v. *Mosler*, 127 U. S., 354; *Plummer* v. *Sargent*, 120 U. S., 442.

Where in comparison of an American with an English patent, they described the same thing in all essential particulars, the English specification being more detailed and its drawings more minute and full, and having but one claim sufficient under the English to entitle patentees to their entire invention and at least as broad and comprehensive as all four of the American patent claims, and the American patent contained improvements not exhibited in the English patent, they were held identical within the purview of Acts of 1861, section 16, and 1839, section 6, limiting the term of a domestic patent to that of the prior foreign patent of the same invention: *Siemens* v. *Sellers*, 17 Brodix, p. 284, U. S. Sup. Ct., November, 1887.

In the foregoing case, the difference between the American and English systems of making claims is noted.

The tests of identity for the purposes of section 4887 U. S. Statute collated from *Siemens* v. *Sellers*, *supra*, and *Commercial Manufacturing Co.* v. *Fairbank Canning Co.*, 135 U. S., 176, are: (1) Is the principal invention of the domestic patent found in the foreign patent? (2) Is the subject matter of the one the same in all essential particulars as that of the other? (3) Would a structure made pursuant to the foreign patent infringe the domestic patent? (4) Could both patents have been granted in this country. A domestic patent for a product and foreign patent for the process may be for the same inventions: *Mosler* v. *Mosler*, 127 U. S., 354; *Plummer* v. *Sargent*, 120 U. S., 442.

9. Any person who has invented any improvement on any patented invention, may obtain a patent for such improvement; but he shall not thereby obtain the right of vending or using the original invention, nor shall the patent for the original invention confer the right of vending or using the patented improvement. 35 V., c. 26, s. 9.

NOTE.—This provision was in the first Upper Canada Patent Act of 1826, which was copied from section 9 of the U. S. Patent Act of 1793, also in section 4 of the Patent Act of 1851-52, continuing to the present date. The original provision contained the addition that "simply changing the form or proportion of any machine or composition in any way, shall not be deemed a discovery."

Additions of improvements might be made to existing patents without taking out a new patent by section 19 Con. Stat. Can., c. 34 (1859), the original patentee filing a duplicate model and drawing; this provision, disappeared in the Act of 1869.

We have discussed, under section 7, that "a new combination of old elements producing a new result, or a known result in a much more useful and beneficial way," is patentable: *Harrison* v. *Anderson Foundry Co.*, L. R., 1 App. Cas. 577, was quoted by Ferguson, J., in an Ontario suit of *Wisner* v. *Coulthard*, in his judgment of February 7th, 1890, as being one of a number of authorities in this respect, which English case was also discussed and approved of in *Yates* v. *Great Western R. W. Co.*, 2 App. Rep. (Ont.), p. 226, and by

Ritchie, C. J., in the Supreme Court judgment of *Smith* v. *Goldie*, 9 Sup. Ct. Rep., p. 51, as well as by Hagarty, C. J., in *Hunter* v. *Carrick*, 10 App. Rep. (Ont.), 449.

Indeed, a new arrangement of old parts may be patentable, and Hagarty, C. J. (Ont.), in his judgment of 10th May, 1892, in *Wisner* v. *Coulthard*, in the Court of Appeal (Ont.), quotes Lord Hatherly in *Harrison* v. *Anderson Foundry Co.*, as to claiming a new combination, that the inventor may say: "I take all these well-known parts and I adjust them in a manner totally different from that in which they have ever before been adjusted—I have found out just what it is that made these parts—though they may have been used in machinery, fail to produce their proper effect, and it is this, that they have not been properly arranged. I have, therefore, reconsidered the whole matter and put all these several parts together in a mode in which they never before were arranged, and have produced an improved effect by so doing. I apprehend it is competent to that man so to do and that it would be perfectly impossible for him to say what is new and what is old, because *ex concessis* it is all old, nobody ever before used it in the manner in which he has used it."

The foregoing quotation was also cited in approval by Henry, J., in *Smith* v. *Goldie*, 9 Sup. Ct. R., p. 67.

And in *Smith* v. *Goldie*, 7 App. R., 628, Patterson, J., discussing *Murray* v. *Clayton*, L. R., 7 Chy. 570, says: "I am willing to accept the doctrine that a new process, carried on by known implements or elements acting upon known substances and producing some other known substance in a cheaper or more expeditious manner, or of a better or more useful kind, is patentable; but the process or combination must be new."

The difficulty of this section is, that the invention of an improvement on a patented device may change the result and the whole mode of operation, when the improver would not be subject to the original inventor; but one cannot conceive how the proprietor of the prior invention could legally appropriate to himself the improvement, without the consent or remuneration of the improver.

Any addition to or substraction from any known machine or process causing the old machine or process to accomplish an object in a more speedy, perfect or economical manner, is evidently the subject of a patent: Terrell on Patents, 1st ed., p. 27; *Lister* v. *Leather*, 8 El. & Bl., p. 1017; *Hornblower* v. *Boulton*, 8 T. Rep., 104.

In *Allen* v. *Reed*, 14 Q. L. R., 126, S. C. (1888), the Court

held that it is no invention to omit one of the parts of an existing thing unless such omission caused a new mode of operation of the parts retained: *Vide* also, Supreme Court, U. S. (decided April 3rd., 1893): *The National Hat Pouncing Machine Co.* v. *Hedden et al.*, 63 O. G., p. 466.

But the fact that a machine is capable of doing more work and at a less expense than prior devices, while persuasive, is by no means decisive, and is only available to turn the scale in cases of grave doubt respecting the validity of the invention: *S. C.*

In the case, for instance, of a new folding device on a patented printing press, the inventor of the new folding device would not, by attaching his device to the printing press, obtain the right to vend and use the press without being subject to the patentee of the press, nor would the patentee of the press have the right to discard his old folding apparatus and adopt the improved one, without reference to the inventor of the improvement. This would be a case to which the section is applicable, but it is so obvious that it hardly required a special section to impress it. In *Fox* v. *Dellestable*, 15 W. R., p. 195, "no doubt a man may make an invention which is partly covered by an existing patent, but he cannot use it without the license of the patentee." Malins, V. C.

It does not detract from the validity of a patent that the inventions of others are made use of in carrying out the patented invention. One invention may include within it many others, and patents for each and all be valid at the same time, but in such case, each inventor would be precluded from using the inventions made and patented prior to his own, except by license from the owners thereof: *Cochrane* v. *Deiner*, 11 Brodix, p. 289, Sup. Ct. U. S. (March 19th, 1877).

Mr. Justice Swayne, of Supreme Court, U. S., in *Smith* v. *Nicholls*, 21 Wall., 118, states:

"A new idea may be engrafted in upon an old invention, be distinct from the conception which preceded it and be an improvement. In such case, it is patentable. The prior patentee cannot use it without the consent of the improver, and the latter cannot use the original invention without the consent of the former. But the mere carrying forward or new or more extended application of the original thought, a change only in form, proportions or degree, the substitution of equivalents doing substantially the same thing in the same way, by substantially the same means with better results, is not such invention as will sustain a patent.

These Rules apply alike, whether what preceded was covered by a patent or rested only in public knowledge and use.

The foregoing was quoted by Ritchie, C. J., in *Ball* v. *Crompton Corset Co.*, 13 Sup. Ct. Rep. (Can.), p. 477.

10. Every inventor shall, before a patent can be obtained, make oath, or, when entitled by law to make an affirmation instead of an oath, shall make an affirmation, that he verily believes that he is the inventor of the invention for which the patent is asked, and that the several allegations in the petition contained are respectively true and correct: 35 V., c. 26, s. 11.

2. In the event of the inventor being dead, such oath or affirmation shall be made by the applicant, and shall state that he verily believes that the person whose assignee or legal representative he is, was the inventor of the invention for which the patent is solicited, and that the several allegations in the petition contained are respectively true and correct: 35 V., c. 26, s. 11.

3. Such oath or affirmation may be made before a minister plenipotentiary, *chargé d'affaires*, consul, vice-consul or consular agent, a judge of any court, a notary public, a justice of the peace, or the mayor of any city, borough or town, or a commissioner for taking affidavits, having authority or jurisdiction within the place where the oath may be administered. 35 V., c. 26, s. 11; 36 V., c. 44, s. 3; the Patent Act (1886), 55-56 V., c. 24, s. 2 (1892).

Informalities.

NOTE.—We have no judicial decisions as to what effect informalities as to the oath may have on a patent in Canada; but in the United States the oath is but a prerequisite to the granting of the patent, and is in no way essential to its validity. It is not a condition precedent without which the patent fails: *Crompton* v. *Belknap Mills*, 3 Fisher, 536: *Vide* also Curtis, sec. 274*a*. An irregularity in the form of oath will be cured by the issuing of the patent, and it seems that a patent would be valid when issued, although the oath might not be taken at all: *Vide* Curtis, 4th ed., sec. 274.

A direct recital in the patent that the oath was taken before the same was granted, in the absence of fraud, is conclusive evidence that the necessary oaths were so taken: *Seymour* v. *Osborne*, 3 Fisher, 555, and 11 Wall., 516.

The omission of the date in the "jurat" does not affect the validity of the patent: *French* v. *Rogers*, 1 Fisher, 133, and other cases on p. 156, Bump.

In the United States a suplemental oath is required if foreign patents have been issued since the original application or as to added patentable matter if omitted in the original application.

Letters Patent in the United States with the oath duly taken are *primâ facie* evidence that the patentee was the first inventor of the thing patented: *Philadelphia and Trenton R. W. Co.* v. *Stimpson*, 14 Peters, 458.

In Great Britain, since the Patent Act of 1883, sec. 5, an application must contain a declaration to the effect that the applicant is in possession of an invention whereof he claims to be the true and first inventor, etc.

Patents of Communication.

This raises the important question as to whether "patents of communication" have been abolished by the Act. "Patents of communication" were, and still are, obtained by agents and persons residing in Great Britain and Ireland, in their own names, for inventions communicated to them from abroad.

Before this Act of 1883, and many years ago, the first introducer into the realm was always held to be the true inventor within the meaning of the Statute of Monopolies, 21 James I.: *Vide Edgeberry* v. *Stephens*, 2 Salk., 447; *Carpenter* v. *Smith*, 9 M. & W. 300; 1 Wels. Pat. Cas. 7, 535; but *Milligan* v. *Marsh*, 2 Jur. N. S. 1083, pointed the other way.

Since the declaration required in the British Act of 1883, there have been no judicial decisions, but Form A[1]. provides for an application for inventions communicated from abroad, and the practice is still for the Patent Office in England to issue such patents.

The matter is fully discussed in Note to section 5 Daniel on Patents. It is contended that one of several joint inventors suffices to make the declaration in Great Britain.

Letters Patent taken out in the name of agents as communications from abroad, are open to this objection; that if allowed to remain in the agent's name, insolvency or death may complicate matters, for in the absence of assignment or documentary evidence, the foreign inventor, who really was entitled to the

patent, may have difficulty in proving title. It is always better for the foreign inventor or patentee to take the patent out in his own name (Form A), and merely authorize the English agent to act for him.

The several allegations in the Canadian petition are, that the alleged invention was not known or used by others before his invention thereof, and was not in public use or on sale with his consent or allowance for more than one year previous to his application in Canada.

The applicant is not required in Canada to make oath that he is the first inventor, but that *he believes himself to be the first inventor.*

In the United States, the oath is also on belief as to being the "original, first and sole (or joint) inventor," etc., a subsequent section of the U. S. Patent Statute provides for a case in which the patent shall be valid if issued to an applicant who believed himself to be the first inventor or discoverer, although he was not so in point of fact, where the invention had been previously known or used in a foreign country, but had not been patented or described in any foreign work, and the patentee was ignorant of that fact: *Vide* section 4923 R. S., this first appeared in section 15 of the U. S. Act of 1836. In Canada, we have no such legislation at present; a similar provision was in our Con. Stat. Can., c. 34 (1857), but was dropped out in the Patent Act of 1869.

A patent which is not supported by the oath of the inventor, but collusively by that of another person who applies for same, is unauthorized by law and void: *Vide Kennedy* v. *Hazleton*, 19 Brodix, p. 124.

This section provides for an affirmation as well as an oath. Under the Interpretation Act, the expression "oath" includes a "solemn affirmation or declaration."

NOTE.—Form 5, Appx., shows the form of petition to be made by an executor or administrator, which will do also for an assignee; in the Patent Office forms (Canada) there is no form of oath for the assignee or a legal representative, nor any form of petition for the assignee referred to in the 10th section, but it may be

made following the wording of the Act and Form 5, under Rule 6. Form 16 shows the form of Letters Patent taken out by a legal representative or an assignee, *mutatis mutandis*.

Probate of will or letters of administration should be obtained before applying for Letters Patent under this clause and filed in the Patent Office. Any assignment should also be there filed.

In United States no Provision for Assignee.

In United States, sec. 4896 Rev. Stat. provides for an issue of Letters Patent to the executor or administrator of a deceased inventor, but nothing is said about an assignee, as in Canada, which defect in the U. S. Act is mentioned in Walker, sec. 171, and commented on, and where the assignee may obtain it through the legal representative who holds in trust for the heirs or devisees, and they in turn in trust for the assignee.

If the patent be issued to the personal representative of a deceased inventor he would hold it in trust for the heirs, or the devisees under a will. In the United States a patent may issue to a "legal representative" without any declaration that he holds it in his representative capacity: *Vide Stimpson* v. *Rogers*, 4 Blatch., 336 (1859); *North-West Fire Extinguishing Co.* v. *Philadelphia Extinguishing Co.*, 1 Ban. & Ard., 177 (1874).

In Great Britain.

In Great Britain, by section 34 of the Act of 1883, a patent may be granted to the legal representative of a deceased inventor, but application must be made within six months of the death and contain a declaration that such person was the true and first inventor.

No provision is made for the "assignee" of a deceased inventor. This is a new provision in Great Britain; before this no patent was obtainable in the event of death: *Vide Marsden* v. *Saville Street Foundry*, 3 Ex., 203.

In sub-section *d* of section 2 of this Act, "legal representative" includes an "assignee," but both are expressly mentioned in sub-section 2 of section 10, when referring to a deceased inventor. The provision for a legal representative in Canada obtaining a

patent for the invention of a deceased inventor first appears in 12 Vic., c. 24 (1849).

Practice in United States in Event of Death.

In the States, when an inventor dies, his executor or administrator files a new application for the same invention, and the new application may be given the same status in the order of examination as the original by order of the Commissioner: *Vide* Rule 63.

In the event of a Canadian inventor dying after having made application in the States, and filed the oath, etc., no new oath is requisite; but letters of administration are procured for the purpose of obtaining the U. S. patent preferably in the name of a U. S. agent, or probate of the will would have to be filed in the U. S. Patent Office, and the proceedings go on in the name of the executor.

Practice in Canada in Event of Death.

In Canada in the event of the death of an inventor after application, no new oath would be requisite, but probate of will would have to be filed, or letters of administration obtained and filed, and proceedings would then go on in the name of the legal representative on his application.

The third sub-section of section 10 of the Patent Act was repealed, and sub-section 3, section 10, of the Act of 1892, substituted.

NOTE.—Before this, the only person who could take the oath in Canada was a justice of the peace, which was very inconvenient; this oath before a justice of the peace was handed down without change from 14 and 15 Vic., c. 79, sec. 5 (1851); now it is usually taken by a commissioner, but may be taken by a notary public and all the others, mentioned in sub-section 3 of section 10.

If the applicant be not in Canada, the oath is presumably to be taken before a Minister Plenipotentiary, *Chargé d'Affaires*, Consul, etc., though no special provision is made as to the mode of taking the oath when applicant is abroad. The old section has been jumbled; it could hardly be the intention, that the oath in a foreign country should be taken before a justice of the

peace or a commissioner. The oath may now be taken before a Judge of any Court; before this, it was "any Court of Record" by the Act of 1873; the seal of the Court over which the Judge presides must be affixed under the rules of the Patent Office.

11. The applicant for a patent shall, for the purposes of this Act, elect his domicile at some known and specified place in Canada and shall mention the same in his petition for a patent. 35 V., c. 26, s. 12.

NOTE.—This provision is inserted, so that in the event of British or foreign patentees, a post office address may be available for address of letters, etc. The place of domicile appears on the face of every patent.

"Domicile" (Black's Law Dict.), is a man's legal residence, as distinguished from his temporary place of abode; or his home, as distinguished from a place to which business or pleasure may temporarily call him: 29 Conn., 74.

"Domicile" and "residence" are not synonomous. The domicile is the home, the fixed place of habitation; while residence is a transient place of dwelling: 5 Sand., 44.

12. The applicant shall, in his petition for a patent, insert the title or name of the invention, and shall, with the petition, send in a specification in duplicate of the invention and an additional or third copy of the claim or claims: 35 V., c. 26, s. 13, The Patent Act (1886); 56 V., c. 34, s. 1.

NOTE.—By the Patent Act Amendment (1893), sec. 12 of the Patent Act was repealed, and the foregoing substituted, the words "and an additional or third copy of the claim or claims" being added to the old section.

This requirement of an extra copy of the claim or claims has been in vogue since 1891, and is intended for use for the Patent Office Gazette, which is issued monthly by the Patent Office.

The application should be by petition following the Revised Act: "not known or used by any other person before his invention thereof, and which has not been in public use or on sale with the consent or allowance of the inventor thereof for more than one year previously to his application therefor in Canada."

And the oath shall be made as provided for in section 10, and following some of the forms in the Appendix. And when forms are not provided, a form conformable to the letter and spirit of the law may be accepted: *Vide* Rule 6.

And when the patent is to be taken out by a solicitor, the power of attorney (Form 11, Appx. I.) should be used. Correspondence will only be carried on with one person, the applicant or his agent, and will be conveyed through the Canadian mails free of charge: *Vide* Rule 3, Appx. I.

All documents must be legibly and neatly written or printed on foolscap paper (13 inches long and 8 inches wide) with an inner margin of one inch and a half wide: *Vide* Rule 4, Appx. I.

All communications are to be addressed "To the Commissioner of Patents, Ottawa, Canada."

Papers forwarded to the office should be accompanied by a letter, and a separate letter should be written on every subject: *Vide* Rule 5, Appendix I.

The specifications are to be in duplicate, and drawings in duplicate are to be attached to the duplicate specification when capable of illustration.

The Commissioner may dispense with the duplicate specification and drawing under sub-section 6 of section 13.

The fees should accompany the application, as set out in section 39—usually $20 is paid for the first six years—but the fees for the twelve or eighteen years' term, $40 and $60 respectively, may be paid if so desired.

Application to be Perfected within Two Years (Can.)

An application must be proceeded with and perfected within two years after the lodging of the petition, or it may be deemed abandoned and the fees paid with respect thereto forfeited: *Vide* Rule 9, Appendix I.

It would, therefore, be desirable to pay only the $20 fee instead of the $40 or $60 fee.

Under section 43, when petition is rejected, the invention not being patentable, or when the petition is withdrawn, the fee may be returned, less $10.

Applications in U. S., when to be Complete.

All applications in U. S. are to be completed and ready for examination within two years of filing the application.

Applications are deemed abandoned if two years are allowed to lapse by applicant after notification of an action in the Patent Office, U. S., without prosecuting his application, unless the Commissioner be satisfied that the delay was unavoidable: *Vide* U. S. R. S., sec. 4894.

Actual abandonment may not follow from the withdrawal of the application; if the intention is to file a new application, and the applicant does so without being guilty of laches: *Vide Howes* v. *McNeal*, 3 Ban. & Ard., 376 (1878).

Nor does an abandonment follow after a rejection by the Patent Office (U. S.) and the application lie dormant. If a new application for the same invention be made and a patent issue thereon, the two applications are considered continuous. The applicant first applied for a patent in 1855, which was granted in 1864, delay caused by ill-health and poverty held to be no abandonment: *Vide Smith* v. *Goodyear Dental V. Co.*, 11 Brodix, p. 1.

The final fee in U. S. must be paid within *six months* after the patent is allowed and notice sent, or the patent is withheld.

Months are Lunar.

The months are "lunar" months, not calendar "months," which is important to observe so as to avoid the issuing in U. S. A. of a patent, voidable for want of jurisdiction: *Vide* Walker, 2nd ed., sec. 125, but recent U. S. cases hold them to be "calendar months": *Vide infra.* In Canada, by the Interpretation Act, they are calendar.

Two Inventions in One Application.

Two or more separate inventions shall not be claimed in one application, nor included in one patent. But if separate matters are represented as so dependent on and connected with each other as to be necessarily taken together, to obtain the end sought for by the inventor, the Commissioner of Patents shall be the judge whether or not the pretensions of the applicant in such respect can be entertained: Rule 10, Appendix I.

This Rule appears to give the Commissioner discretionary power; it is a question more relating to revenue than anything

else. In the Canada Patent Office one invention is usually only allowed in a patent, although "a machine," "the product," and "the process" is sometimes included in one patent: *Vide* Canada Patent, 30646, "Improvements in twine and devices for making the same."

After the Canada Patent has been issued it would hardly be competent to hold that the patent was void as including more than one invention.

If several inventions, claimed in a single application, be of such a nature that a single patent may not be issued to cover them, the inventor will be required to limit the description, drawing, and claim of the pending application to which ever invention he may elect. The other inventions may be made the subjects of separate applications, which must conform to the rules applicable to original applications.

If the independence of the inventions be clear, such limitation will be made before any action on the merits; otherwise it may be made at any time before final action thereon, in the discretion of the examiner.

The foregoing is Rule 42 in U. S. Patent Office, and it is in effect the practice of the Canada Patent Office, under Rule 20.

In England Only One Invention to Each Patent.

In the English Patent Act of 1883, sec. 33, there is a new section: "Every patent, etc., shall be granted for one invention only, but may contain more than one claim; but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention."

Owing to the foregoing proviso in the English Act, the practice is very common of combining two or more inventions in one patent; if the British Patent Office passes it, the patent is all right.

Four Classes of Inventions.

The Canadian Act as well as the U. S. Act speak of "an art," "a machine," "a manufacture" or "a composition of matter," disjunctively separating inventions into four classes.

We have some decisions of the Commissioner of Patents in the

States, and dicta in the U. S. Courts bearing on the subject which are contradictory.

In *Ex parte Blythe*, 30 O. G. (U. S.), p. 1321. An application for a patent for a machine process and product. The Commissioner of Patents states: "Suppose there be invented something in an art, or as it is in ordinary called 'a process,' or method, also a machine for carrying out the process, and also the manufacture or article produced in the operation of the process by the machine—there can be no doubt the statute calls for three patents. I am compelled to hold the plain provisions of the statute as well as the weight of judicial authority, and the dictates of what seems to me common sense, the application should be made the subject of separate independent patents."

In *McKay* v. *Dilbert*, 19 O. G. (U. S.), p. 1351, it is held that patents for machine, process and product represent distinct inventions, which live or die without regard, each to the other. Each patent must, therefore, be for a complete invention.

In *Barrett* v. *Hall*, 1 Mason, 447, Story, J., says a patent under the Act cannot embrace various distinct improvements or inventions, but, in such case the parties must take out separate patents.

In *Hogg* v. *Emerson*, 11 Howard, 587, it is stated there are said to be numerous dicta—that a patent embracing more than one invention would be void.

In *Ex parte* Heer, C. D. 105, 41 O. G. (U. S.), p. 463. "It must be regarded as settled by the highest authority that 'an apparatus' and 'process' are separate and distinct inventions, claim for a machine or apparatus and a claim for a process should be prosecuted in separate applications."

And *Ex parte* Atwood, July 12th, 1888, 44 O. G. (U. S.), 341. The relation between "process" and "apparatus" is not that of genius and species, but of independent inventions.

While in "*Ex parte Lilley*" (decided by Commissioner of Patents, December 6th, 1890), 53 O. G., p. 2041, the opposite view is taken; where the application, as filed, discloses an apparatus and also a patentable process, and the relation between them is such that they could be joined in one application, and the apparatus only is embraced in the statement of invention or claims as originally "invented," there is no reason why claims for the *process* may not be incorporated, if seasonably presented and supported by supplemental oath.

When a process can produce no other product, and the

product can be produced by no other process, the process and product are parts of one invention, and division should not be required: *Ex parte Demeny*, decided September 13th, 1893, 64 O. G., p. 1649.

A division between process and product is not required, both may be made in one application: See *Ex parte Thomson*, decided January 19th, 1894, 66 O. G., p. 653, and the office will not concern itself whether the process will necessarily result in the particular product or not, this enquiry being no guide.

The Title or Name.

The title or name of the invention is in England of much more vital importance than it is in Canada or the States. In the States, the specification controls the generality of the terms of patent of which it forms part, and the specifications may enlarge the recitals of the invention: *Vide Hogg* v. *Emerson*, 6 How., 437, 479. And in Canada (as well as in the U. S.), under section 13, the specification and drawings are annexed to and form an essential part of the patent and are explanatory of the title. In Canada, the title appears on the petition, power of attorney and specification, but not on the drawings.

In Great Britain, the title summarizes the invention and must correspond with it; as the title has to be advertised before granting the application, some ingenuity has to be evinced in order not to inform rival inventors before protection has been obtained.

The following are some cases in England where the titles have been held defective and the patents bad:

"An improved method of lighting cities, towns and villages," it was in reality an improved street lamp: *Lord Cochrane* v. *Smithhurst*, 1 Stark. R., 205.

"A new or improved method of drying and preparing malt," it was really for colouring beer: *Rex* v. *Wheeler*, 2 Ban. & Ard. 345.

In Canada and U. S., this would not void a patent, so we must apply English cases on this branch with some care.

In *Wandby* v. *Hewitt*, 27 U. C. C. P., 571 (1877), there was

an agreement to sell and use "the New Dominion Stove Pipe Collar" without defendant's concurrence; it was described in the patent as "Wanby's Improved Stove Pipe Stone."

Defendant refused to carry out the purchase. Hagarty, J., quoting section 13 of the Act of 1872, from which this section 12 was taken: *Held*, plea good, for the name was a material part of the contract; citing Hindmarch, 46, 159, 160; *Rex* v. *Wheeler*, 2 Ban. & Ard., 345; and Higgins Digest P. C., 148, *et seq.*; Webster L. P. of Inv., 333, 678. The change of name must be considered a matter of substance.

Powers of Attorney.

There are no special rules in Canada as to powers of attorney, except the form, and Rule 3, which provides that correspondence may be carried on with the applicant or his agent, but only with one person. The usual practice is to name one of a firm setting out the individual names of the members of the firm, although the names of all the members of the firm may be inserted as attorneys.

In the United States a power of attorney purporting to have been given to a firm or co-partnership will not be recognized, either in favour of the firm or of any of its members, unless all its members shall be named in the power of attorney.

In the United States, substitution or association may be made by an attorney upon the written authorization of his principal, but such authorization will not empower the second agent to appoint a third: it is not the practice in Canada to insert a substitution clause in a power, though on filing such a power, probably the same rule would prevail as in the States, although by Rule 3 correspondence is to be with only one person.

Powers of attorney may be revoked at any stage in the proceedings of a case upon application to and approval by the commissioner, and when so revoked, the office will communicate directly with the applicant or any such other attorney as he may appoint. An attorney would be notified of the revocation of his power of attorney.

In the United States the assignment of an undivided interest

will not operate as a revocation of the power previously given; but the assignee of the entire interest may be represented by an attorney of his own selection. It is conceived the same rule would apply in Canada in so far as Rule 3 will permit.

13. The specification shall correctly and fully describe the mode or modes of operating the invention, as contemplated by the inventor; and shall state clearly and distinctly the contrivances and things which he claims as new and for the use of which he claims an exclusive property and privilege: (*a*)

2. Such specification shall bear the name of the place where, and the date when it is made, and shall be signed by the inventor, if he is alive, and if not, by the applicant, and by two witnesses to such signature of the inventor or applicant: (*b*)

3. In the case of a machine, the specification shall fully explain the principle and the several modes in which it is intended to apply and work out the same: (*c*)

4. In the case of a machine, or in any other case in which the invention admits of illustration by means of drawings, the applicant shall also, with his application, send in drawings in duplicate, showing clearly all parts of the invention; and each drawing shall bear the signature of the inventor, if he is alive, and if not of the applicant, or of the attorney of such inventor or applicant, and shall have written references corresponding with the specification; but the commissioner may require further drawing or dispense with any of them, as he sees fit: (*d*)

5. One duplicate of the specification and of the drawings, if there are drawings, shall be annexed to the patent, of which it shall form an essential part, and the other duplicate shall remain deposited in the patent office: (*e*)

6. The commissioner may, in his discretion, dispense with the duplicate specification and drawing, and in lieu thereof cause copies of the specification and drawing, in print or otherwise, to be attached to the patent, of which they shall form an essential part. (*f*) 35 V. c. 26, s. 14—36 V. c. 44, s. 4.

Specification.

(*a*) The term "specification," wherever it is used, without the word claim, covers both the "claim" and the description; and, whenever it is used with the word claim it covers the description only.

The specification consists of (1) a preamble, giving the name and residence of applicant, the title of the invention; (2) a statement of the nature and object of the invention; (3) a description of the drawings, if any, and what each view represents; (4) a

detailed description of the invention, explaining its construction and mode of operation, if it is a thing, and the *modus operandi* if it is a process; (5) the claim or claims; (6) the signature of the inventor, or if dead, his assignee or legal representatives; (7) the signature of two witnesses.

Claims.

The claims are the most difficult part of the whole to draw properly, and require the skill and experience of years to do in an artistic manner. The broadest possible claim, or claims, consistent with the nature of the invention, must be aimed at by the draftsman, and the thought, ever present, must be, how it will stand the test of a lawsuit—all redundancy and surperfluous elements should be carefully eliminated—though in a well-drawn claim the function of the combination may be judiciously interwoven.

Functional Claim.

Claims which literally purport to cover a result, rather than a process or thing, are construed to cover only the process or thing which produces that result, otherwise such claims would be void: *Fuller* v. *Yantzer*, 94 U. S., 288 (1876); *Coes* v. *Collins Co.*, 9 Fed. Rep., 905 (1882); *Palmer* v. *Gatling Gun Co.*, 8 Fed. Rep., 513 (1881): *Vide* also Curtis, 4th ed., sec. 242*a*. *But see contra:* A functional claim is not always a nullity, the Court construing and treating the claim as being for the device or compound, instead of the function thereof: *Manufacturing Co.* v. *Ladd*, 2 Ban. & Ard., 488.

Words, rather than reference letters to the drawings should be employed, for language is more elastic, while reference letters to the drawings, are calculated to confine you to the exact illustration which may unduly limit your claim.

One should study carefully how the claim is apt to be avoided, and should provide accordingly; an intimate knowledge of the patent law and of litigation relating to inventions, and experience in the Courts is an absolute necessity to ensure the best class of work. It is always easier to criticise and pick holes in the work of another than to do a thing in a perfect manner yourself—indeed, criticism which tells in our Courts of law often does not

call for much knowledge or experience on the part of the critic. A patent solicitor should have a universal knowledge of art, science and mechanics; should have learnt to make drawings himself, and should also be trained as a lawyer and to practice in the Courts. In the United States there is a distinct class of specially trained lawyers who make a specialty of patents of invention and patent litigation.

The invention should be claimed broadly from as many standpoints as possible, and all subordinate parts should be separately claimed: *Vide Railway Co.* v. *Dubois*, 12 Wallace, 47 (1870). Some of the latter may be preferably claimed with reference to the letters on the drawings. In cases where the description sets forth a manufacture, there ought to be a claim for each of its patentable features; for if there is but one claim, and if all those features are carried by it, then those persons who manage to dispense with even the least of them, incur no liability by making, using or selling, articles which possess all the others: *Vide* Walker, sec. 118, and *Prouty* v. *Ruggles*, 16 Peters, 336 (1842).

The applicant may, if he will, apply for and receive a patent for each of the combinations and sub-combinations—each claim representing a patentable feature—Corn Planter Patent 23, Wall., 234 (1874).

In *Smith & Griggs Manufacturing Co.* v. *Sprague*, 17 Brodix, p. 243, Oct., 1887. In a patent claiming combinations and sub-combinations of old elements, the defence of public use for more than two years prior to the date of filing the application may be made to a single one or more of the claims as separate and distinct inventions, and that the two years' limitation will run against such claim or claims irrespective of the fact that other claims joined in the same patent were not affected.

In construing claims, the state of the art to which the invention belongs must be considered; those which are "primary inventions" are entitled to have a broader interpretation of the claims than those which are of a "secondary" nature: *Vide* sec. 184 Walker, and U. S. Sup. Ct. cases there referred to; and

vide Brush Electric Light Co. v. *Electric Importation Co., of St. Jose*, decided Oct. 3rd, 1892, 62 O. G., p. 1651, and *Morton* v. *Jensen*, 49 Fed. Rep., 859.

While a claim should not be so construed as to expand it, on the other hand it should not be given a narrow interpretation which would defeat the patent unless absolutely required by the state of the art: See *Sayre* v. *Scott*, U. S. Cir. Ct. of App., 3rd C., May 23rd, 1893, 63 O. G., p. 1818.

Patents for invention are to receive a liberal construction and under the fair application of the rule, "*ut res magis valeat quam pereat*" are, if practicable, to be so interpreted as to uphold and not destroy the right of the inventor: *Turrill* v. *Railroad Co.*, 1 Wall., 491 (1863).

In *Hinks* v. *Safety Lighting Co.*, 4 Ch. D., 607, Jessel, M. R., states: "I am anxious, as I believe every Judge is, who knows anything of the patent law, to support honest, *bonâ fide* inventors who have actually invented something novel and useful, and to prevent their patents being overturned on mere technical objections, or on mere cavillings with the language of the specification so as to deprive the inventor of the benefit of his invention."

And in *Hullitt* v. *Hague*, 2 Ban. & Ard., 370, and p. 269, Goodeve, Lord Tenterden said: "I cannot forbear saying that I think a great deal too much critical acumen has been applied to the construction of patents, as if the object was to defeat and not to sustain them."

And in *Plimpton* v. *Spiller*, L. R. 6 Chy. D., 422: "The Judge is not to be astute to find flaws in small matters in a specification with a view to overthrow it": *Vide* also Walker on Patents, sec. 185, and *Klein* v. *Rogers*, 9 Brodix, p. 244.

These remarks might be borne in mind by some of our Ontario Courts, the tendency of the legal mind is to destroy rather than to sustain.

The draftsman of a specification fills a much more difficult position than a solicitor of the Courts who draws pleadings; the latter has the utmost latitude as to amendments, which can be made at any stage of the suit at a trifling expense, and even at the trial on terms imposed by the Courts; while a mistake or omission by the former has the most serious consequences, and can only be remedied by the slow and expensive process of a

reissue of the patent, and not even then, if the omitted parts do not appear in the body of the specification or drawing; if there be no formal claim, or if the claim be fatally defective, as is often the case, infringement cannot be maintained.

Letters Patent, to Whom Addressed.

Letters Patent of invention are addressed to those skilled in the art to which it appertains, it is not necessary that the description should be intelligible to every intelligent, or to every skilled mechanic: *Vide* Walker, sec. 174; *Loom Co.* v. *Higgins*, 105 U. S., 278. They are addressed to people who know something about the invention, and who could supplement a defective description: *Plimpton* v. *Malcolmson*, 3 Ch. D., 568; Terrell on Patents, 1st ed., pp. 74–5.

In *Powell* v. *Begley*, 13 Grant, 381 (1867), relating to a wooden force pump, "the chair-backed pump," it was contended that the specifications were not sufficient to describe the invention. Vankoughnet, C., in holding the Letters Patent sufficient, says: "They are not very artificially prepared, and the language is somewhat obscure and vague; but, probably not so much so to mechanics and farmers as to those accustomed to more choice and accurate expressions."

In *Smith et al.* v. *Ball*, 21 U. C. Q. B. R., p. 122 (1862), the invention was claimed to be, the direct application of steam power or water power by a connecting rod or shaft to drive a circular saw. The novelty consisted in dispensing with one shaft and one pulley. At the trial, Draper, J., thought the specifications and drawings did not sufficiently describe the invention, *although the witnesses had no doubt as to what was intended by the description.* On a motion for a new trial, Robinson, C. J., delivered the judgment of the Court and held that the plan and specifications annexed must be taken together, and that they sufficiently described the invention which appeared by the evidence to be one.

The above specification was also held sufficient in *Smith* v. *Mutchmore*, 11 U. C. C. P., 458, and *Waterous* v. *Bishop*, 20 U. C. C. P., 89.

A description is not fatally defective merely because it omits

to mention something which constitutes only to the degree of benefit, provided, the invention will work beneficially without it: *Sewall* v. *Jones*, 91 U. S., 185 (1875).

But the omission of anything absolutely material to the utility is fatal, unless that omission would naturally be supplied by any person skilled in the art: *Vide* Walker, sec. 175; *Carr* v. *Rice*; 1 Fisher, 204 (1856).

A specification is not fatally defective, if one skilled in the art to which it pertains, could supply an apparent insufficiency of description: See *Lalance and Grosjean Manufacturing Co.* v. *Mosheim*, U. S. Cir. Ct. of App., 2nd Circuit (April 18th, 1893), 63 O. G. (U. S.), p. 1816.

In *Hessin* v. *Coppin*, 19 Grant (Ont.), p. 629, Blake, V. C., states "The full and ample disclosure is not found in the specification, there is nothing said about putting the starch boxes in contact with the aprons and working the rollers at different rates of speed, which Damant says are valuable and important parts of his invention." And refers to *Simpson* v. *Halliday*, L. R. 1 E. & I. App., 315; *Parker* v. *Stevens*, L. R. 6 Ch. App., 36, as to requirements of specifications.

As to Drawings and Specifications Interpreting Claim.

In construing a patent, the Courts, in the first place, generally look to the claim, which, by law is required to be a summing up of the particulars of the invention for which the applicant desires a patent. If that claim is vague and uncertain, then reference is made to the specification and drawings, together with such other exhibits as may aid in giving construction to the patent: *Haselden* v. *Ogden*, 3 Fish., 378, and other cases on p. 40, Bump., 2nd ed.

In order to determine what the patentee claims as his invention, the Court must look to the *specification* annexed to the patent. In referring to the construction of the claim, it is proper that the Court should refer to the whole specification and consider the whole of it in connection: *New York* v. *Ransom*, 23 How., p. 487, and 25 other cases on p. 40, 2nd ed., Bump.

The patent, the specification and the drawings may be

referred to in ascertaining the extent of the patentees claims. While it is true the Court looks to the summing up to discover what parts of the machine he claims to have invented, still if anything is needed to enable it to determine the proper meaning of the expression used in the claims, it must refer to the previous portion of the specification for such explanations as may be necessary to understand the office and purpose of that which is claimed as new: See *Ingels* v. *Mast*, 2 Ban. & Ard., p. 24; Bump. 2nd Ed. p. 40.

The drawings are to be deemed a part of the specification, and may be referred to for the purpose of adding anything to the specifications or claim not specially contained therein: *Washburn* v. *Goold*, 2 Story, 122.

In *The Queen* v. *La Force*, decided in the Exchequer Court (Can.), January, 1894, Mr. Justice Burbidge, states: "There can, I think, be no doubt that the drawings may be looked on as explaining and illustrating the specification," and he quotes the remarks of Robinson, C. J., in *Smith* v. *Ball*, 21 U. C. Q. B., 122, where they may be made to satisfy a deficiency in the wording of the specification.

It has been settled that the drawing constituted a part of the specification when annexed thereto, and may be used to explain or help out the otherwise imperfect description in the specification. So that it is not necessary that the description should be wholly in writing, but it may be partly in writing and partly in drawing, and if by comparison of the words and drawings the one will explain the other sufficiently to enable a skilful mechanic to perform the work and to show what is the invention claimed, the specification will be sufficient: *Bloxam* v. *Elsie*, 1 Car. & Payne, 558; *Brunton* v. *Hawks*, 4 Ban. & Ard., 540; *Swift* v. *Whesen*, 3 Fisher's Patent Cases, p. 343; also *vide* pp. 315–16; Curtis, 4th ed., sec. 262, p. 315.

Abandonment through Failure to Claim in a Patent.

An invention disclosed but not claimed in a patent cannot be covered by a new application for an original patent, or for a reissue filed long after the issue of the patent, which discloses without claiming.

"When a patent fully describes an invention which could be claimed therein, and makes no reservation and gives no warning to the public, a second patent granted on an application filed months afterwards, which claims simply and solely the invention thus made public, is invalid." See *Holmes Electric Co.* v. *Burglar Alarm Co.*, 33 Fed. Rep., 254.

One Claim may Cover a Machine and Process.

That which is in form a single claim may cover a machine and also the process it makes use of, and, on principle, any tangible and patentable product thereof.

The most important claim of Bell's telephone covers both a process and a machine, and has been upheld by the Supreme Court. It reads: "The method of, and apparatus for, transmitting vocal or other sounds telegraphically, as herein described, by causing electrical undulations similar in form to the vibrations of the air accompanying the said vocal or other sounds substantially as set forth." See *Dolbear* v. *Telephone Co.*, 8 Sup. Ct. R., (U. S.) 778.

A Specification must not be Ambiguous.

For instance, if it be stated that a whole class of substances may be used to produce an effect, when in fact, only one is capable of being so used successfully, an ambiguity is at once produced: *Bickford* v. *Skewes*, Wels. Pat. Cas., 218.

A specification which casts on the public the expense and labour of trial and experiment is undoubtedly bad: *Rex* v. *Wheeler*, 2 Ban. & Ard., 345; *Macnamara* v. *Hulse*, Car. & M., 471.

When the specification of a patent for a chemical process applies equally to several isomeric substances and but one would produce a useful result, and it can only be ascertained by experiment which that is, the patent is invalid: See *Badische Anilin and Soda Fabrik* v. *Levinsken*, 29 Ch. D., 366.

In *Simpson* v. *Holliday*, 1 H. L. 315, p. 429, there was described two processes in obtaining a dye, one of which, without the agency of heat, produced no practical result; it was held in the House of Lords that the patent was void, although a skilful workman might know that one could not be acted on.

Specification Sufficient.

A specification is sufficient if the invention is described in language clear and intelligible to educated men conversant with

the subject and capable of giving directions to workmen: *King* v. *Anglo-American Brush Corp.*, R. P. C., vol. 7, p. 443 (1890).

A specification held sufficient though it did not state that (as was the fact) at one stage the apparatus required to be assisted by the hand of the workman: *Miller* v. *The Clyde Bridge Steel Co.*, R. P. C. vol. 8 (1891), p. 201.

The specification must contain the best information within the knowledge of the patentee: *Walton* v. *Bateman*, p. 490, Goodeve and other cases there referred to.

Clerical Errors.

A mere mistake of one word for another in writing or printing or a mistake in lettering if explained by other parts of the patent and specification has been held immaterial in the Ontario Court on an appeal from a judgment of Ferguson, J., to the Ch. Div. Ct., in an unreported suit of *Riech* v. *Hoerr* (1889), relating to pianos: *Vide* also *Kneas* v. *The Schuylkill Bank*, 4 Wash., 9.

Not Necessary to Describe the Whole.

In describing the improvement of a machine, it is not necessary to state in detail the structure as a whole, but merely the improvement by showing the parts of which it consists and the effects which it produces, and its relation and connection with the whole machine: *Vide* Curtis, 4th ed., sec. 241.

When the description is silent as to the philosophical principles which cause the invention to produce the improved annealing: *Held*, that the description was sufficient, and that the patentee ought not to lose the statutory benefits of his invention because he was not perhaps aware to what the improvements effected by his device were due: See *Dixon Woods Co.* v. *Pfeifer* (decided April 18th, 1893), U. S. Circ. Ct. of App., 2nd Circ., 64 O. G., p. 156.

The specification should be so described as to enable the public to practice it from the specification alone: *Vide* section 252, Curtis, 4th ed.

Description Insufficient.

A patent is void if the specifications are insufficient to enable an electrician of ordinary skill and competence to carry it out without further invention and experiments: *Fox* v. *Kensington Electric Lighting Co.*, L. R. (1892), 3 Ch., p. 424; *Electric Light Co.* v. *Holland*, R. P. C., vol. 5., 459 (1888).

Where the machine constructed, according to the specification, is incapable of accomplishing the purpose specified, the patent is void: *Easterbrook* v. *Great Western R. W. Co.*, R. P. C., vol. 2 (1885), p. 210.

An omission or ambiguity in the specification of such a nature as an ordinary shipbuilder could, without much difficulty, supply or obviate for himself: *Held*, not to invalidate a patent: *Lifeboat Co.* v. *Chambers*, R. P. C., vol. 8 (1891), p. 421.

How to Attack Defective Description.

If a specification is to be attacked in a suit, it should be pleaded that the specification was defective, and witnesses should be called to show that workmen engaged in the business to which the invention pertains, could not make the article from the description in the specification.

Whether a patent does so fail on account of a defective description, is a question of evidence, and not of construction, and should be specially pleaded: *Loom Co.* v. *Higgins*, 105 U. S., 580. The evidence must be that of persons skilled in the art to which the invention pertains: *Vide* Walker, sec. 519, S. C. Also *British Dynamite Co.* v. *Krebs*, in the House of Lords, per Earl Cairns, Goodeve on Patents, p. 91-94: "I find no workman, skilled or unskilled, produced on the part of respondents, who states that he has been, or would be misled by the specification, or unable to make dynamite by following the directions."

"I therefore come to the conclusion, there is no insufficiency in the specification." *Vide* p. 93, l. 13, *et seq.*, Goodeve.

In *Smith* v. *Mutchmore*, 11 U. C. C. P. R. (1862), p. 459, relating to the direct application of steam or water power by the connecting rod or shaft to drive a circular saw; on a motion to set aside a non-suit by Draper, C. J., who thought the invention not new and not sufficiently described; Richards, J., says: "If the jury find that the actual improvement is novel and useful, then it appears to me that the defendant not having attacked the specification cannot successfully contend that it is insufficiently described," etc.

Claims. (Eng.)

In Great Britain since the Patent Act of 1883, there should be a distinct statement of the invention claimed. But in *Vickers* v. *Siddell*, 15 App. Cas., 496, 63 L. T., 590, it was held that the enact-

ment in section 5, sub-section 5 of Act of 1883, that a complete specification must end with a distinct statement of the invention claimed, is directory only, and non-compliance with it does not invalidate a patent.

The requirement in section 5 of the Patent Act, 1883, that the complete specification should end in a distinct claim is one of form merely and non-compliance does not vitiate the patent: *Siddell* v. *Vickers*, R. P. C., vol. 7, p. 292; *Kelly* v. *Heathman*, R. P. C., vol. 7, p. 343.

The insertion in the provisional specification should be the same as in a complete specification: *Vickers* v. *Siddell*, *supra*.

Difference between English and American Claims Noted.

See *Siemens* v. *Sellers*, 17 Brodix, p. 284, U. S. Sup. Ct., Nov. 14th, 1887. In patents for the same invention, one claim of the English patent was stated to be as broad and comprehensive as all four of the American patent claims, and the difference between the English and American system of claiming an invention is noted.

Patents in Great Britain to be Construed Liberally.

In British Letters Patent it is expressly stated that, "These our Letters Patent shall be construed in the most beneficial sense for the advantage of the said patentee." This is an express direction to the Courts to be liberal in their construction of British Letters Patent.

(*b*) The signature of the applicant should have the Christian name in full, as should also be those of the witnesses; and all must be written legibly.

The witnesses should not sign before the applicant, as they attest the signature and not the specification: the document may be void if the witnesses sign first: Wharton on Evidence, sec. 888.

The term "applicant" here may mean the assignee of a deceased inventor or his legal representative: *Vide* sub-section 2, section 10.

The way this is worded in the case of joint inventors, it would require two witnesses to each signature. The same two

witnesses may attest all the signatures, but it would be irregular for one witness to attest the signature of one joint inventor and another to attest the signature of the other of two joint inventors.

(*c*) This does not necessarily mean, that all the alternate modes of operation are to be illustrated and described, for there might be many; the best method of applying and working out the principle of the machine is the one to be described. Sometimes an additional and alternative way is illustrated and described, but the one would necessarily include the other, otherwise it would be the subject of another application.

The words "with or without" a certain element are sometimes admissible in claims.

NOTE.—The letters *a*, *b*, *c*, *d* refer to sub-sections of section 13.

(*d*) Drawings.

The drawings for a Canadian patent must be made in duplicate, with India ink, on tracing linen, eight inches by thirteen inches over all, nothing is said about a marginal line, though one is generally put on, and an extra drawing must be supplied to be photo-lithographed for the Patent Office Record, on a sheet of Bristol board, eight inches by thirteen inches, without any writing on its face, merely the usual lettering, no title certificate or signatures: when there are several figures, that one which gives the best general idea of the invention will suffice for the cardboard drawing.

The general directions, as to the drawings and shade lines, must be adhered to: *Vide* Rule 13, Appx. I.

The drawings are usually perspective drawings, as they are better adapted for illustration than elevation and plan drawings; and sectional elevations, partly broken away, in order to expose to view a material part, is a favourite mode of representation: the drawings need not be drawn to scale.

In Austria-Hungary there is an objection to the reception of perspective drawings.

When a Canadian invention is to be patented in foreign countries the drawings are usually lithographed.

Interlineations or erasures in the specifications should be carefully initialed by the witnesses, and if, in the oath by the commissioner or notary public, who attests the oath. On the tracings is written "Certified to be the drawings referred to in the specification hereunto annexed," the place and date are in the centre at the bottom, and the signature of the inventor or his attorney in the lower right-hand corner, and of the witness in the lower left-hand corner.

When the invention consists of an improvement on an old machine, the drawing should exhibit in one or more views, the invention itself disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

The light always is supposed to come from the upper left-hand corner, and shade lines should be as few as possible. Sectional shading should be made by oblique parallel lines not less than $\frac{1}{20}$th of an inch apart.

The plane on which a sectional view is taken should be indicated on the general view by a broken or dotted line.

The different views should be consecutively numbered. Reference letters should be one-eighth of an inch in height, and should not cross or mingle with the lines; where grouped, they should be placed at a little distance and connected to the part to which they refer with short broken lines. They must not appear on shaded surfaces, and when this cannot be avoided, a blank space must be left in the shading where the letter occurs. Numerals are preferable to letters, particularly in complicated drawings.

When views are longer than the width of the sheet, the sheet should be turned on its side, the signatures, etc., will be on the left, occupying the same space as in the upright views.

Additional views are often called for, especially in the States, if the Patent Office considers them necessary.

No title or name is put upon the duplicate drawings attached to the applications.

In the U. S., the drawing must be on cardboard, 10 inches by 13 inches, with 1 inch margin; the drawing must not come within $1\frac{1}{4}$ inch of the top marginal line, so as to leave room for

title, date and number of patent; if the cardboard show a pinkish tint when held up to the light, the drawings would be rejected in the U. S. Patent Office as not suitable for the process of photo-lithography. Since January 25th, 1894, it is necessary to furnish with the originals a blue print or other photographic copy of all drawings forming part of an application.

The same general rules prevail as in Canada as to the manner of executing drawings.

No title is put on the drawings by the applicant, but it is inserted in the Patent Office, below the top marginal line.

Powers of Attorney for the Canadian Applicants in the following Countries:

For France and Colonies there is a power of attorney in French merely signed by applicant, no legalization.

Germany.—There is a power of attorney in German, signed by the applicant, no legalization.

*Austria.—Power of attorney in German, signed by applicant, and legalized by the Austrian Consul.

Belgium and Luxembourg.—Power of Attorney in French, signed by applicant, no legalization.

Denmark.—Power of attorney in French, signed by applicant, no legalization, there are no annual taxes. Patent from three to ten years.

Finland.—Power of attorney in French, signed by applicant, legalized by Russian Consul. No annual taxes.

*Hungary.—Power of attorney in Magyar, signed by applicant and legalized by Austro-Hungarian Consul.

Italy, Sicily and Sardinia.—Power of attorney in French, signed by applicant and legalized by Italian Consul.

Norway.—Power of attorney in Norwegian, signed by applicant and legalized by Norwegian or Swedish Consul.

Portugal.—Power of attorney in French signed by applicant, and legalized by Portuguese Consul. No annual taxes.

Russia.—Power of attorney in French, signed by applicant, no legalization, no annual taxes.

Spain and Colonies.—Power of attorney in Spanish, signed by applicant, no legalization.

* Since 1st January, 1894, Austria and Hungary have each separate patent laws, and a separate application is now necessary in each country.

Sweden.—Power of attorney, in Swedish, legalized by Swedish Consul.

Switzerland.—Power of attorney in French, signed by applicant, no legalization.

Turkey.—Power of attorney in French, signed by applicant, legalized by Turkish Consul.

For the United States only one copy of the specifications need be executed and filed. The oath is usually taken before a notary public, under his official seal, and the specification is accompanied by a petition which usually includes a power of attorney to the solicitor of patents.

For the Colonies of Australasia, the specifications are executed in duplicate, declarations, etc., taken before a notary public. If specifications be type-written, they must be first or ribbon copies.

For the United Kingdom, one copy of the specification is sent to England, to an agent with an authorization to take out the Letters Patent as a communication from abroad; or may be executed by applicant who must declare that he is the true and first inventor, and that the same is not in use by any other person or persons to the best of his knowledge and belief. The complete specification should be in duplicate upon wide ruled foolscap paper thirteen inches by eight inches (on one side only) with a margin of two inches on left-hand of paper. Or there may be a "provisional specification" which is not a protection against infringement but enables the inventor without detriment to use and publish the same. Care must be taken that the complete specification correspond with the provisional.

For Austria, a power of attorney in German must be executed by the Canadian applicant and witnessed by a notary public, under seal, and legalized by the Austrian Consul at Montreal. For Hungary the power of attorney is in Magyar, similarly executed and legalized.

The same mode applies to a Norwegian power of attorney, the Norwegian Consul has to legalize the signature of the Canadian notary public, who signs and seals the document.

For other foreign countries the powers of attorney are executed by the applicant without special formalities.

These foreign forms of powers of attorney in the foreign lan-

guage, are usually kept by solicitors of patents, and are filled up and completed in the countries to which they are sent, after having been signed in blank, by the Canadian applicant.

A full copy of the Canadian specification is sent to the foreign countries, when it is translated into the foreign language of the country in which the patent is required, and where it is taken out by the agent, usually, in duplicate; triplicate copies of the specifications are required in Italy and Luxembourg and five in India, further details may be obtained in special works on the subject, or on applying to solicitors of patents, the foregoing is a bare outline.

The foreign countries enumerated are those in which patents are usually obtained by Canadians. Of course there are a number of other countries which have patent laws, and where patents are obtainable, information as to which is also obtainable through patent solicitors.

As to Publication of Patent Record (Can.), Abroad.

It should also be borne in mind, in the event of applying for foreign patents (especially as Canada is not yet a party to the International Convention, relating to the protection of industrial property, referred to), that copies of "The Canadian Patent Office Record," are mailed to the free libraries of the British Isles and other European countries within two or three days after the regular subscribers are supplied. This may have an important bearing on the question of publication abroad, as the receipt of this "Canadian Record" (should the claims and the photo-lithograph copy of the drawing afford sufficient information to describe the invention), might invalidate a patent granted in Great Britain or foreign countries, it is, therefore, often advisable to withhold the issue of the Canadian patent until the United States application is allowed.

Applications.

(*e*) This would read as if the specification only formed an esential part, it should rather be "of which they shall form, etc.," the drawings is as we have seen in note (*a*), a part of the specifica-

tion, they are merely a method, other than words, of conveying thought.

(*f*) This clause has been law since 1873, but has never been acted on; it would be very desirable if the drawings and specifications, in Canada, were photo-lithographed and printed as in the States.

NOTE.—The letters (*e*) and (*f*) refer to sub.-secs. of sec. 13.

In the United States single numbers of Letters Patent can now be obtained for ten cents, and books containing fifty coupons are issued with which to obtain copies of patents and gazettes. Three several editions of patent drawings are printed and published, of the size attached to patents, six inches by nine and a half inches; another of half that size, four to a page, to illustrate the volumes distributed to the Courts, and one reduction for the Official Gazette.

In Canada it costs $4 to obtain a copy of a specification, and twenty-five cents for each sheet of drawings in blue print.

In England the price of blue books (copies of patents), has this year been reduced to a uniform price of fourpence, no matter what the length.

14. In all cases in which the invention admits of representation by model, the applicant, if required by the commissioner, shall furnish a model of convenient size, exhibiting its several parts in due proportion; and when the invention is a composition of matter, the applicant, if required by the commissioner, shall furnish specimens of the ingredients, and of the composition, sufficient in quantity for the purpose of experiment. If such ingredients or composition be of an explosive or dangerous character, they shall be furnished with such precautions as are prescribed in the requisition therefor. 35 V., c. 26, s. 15, The Patent Act; 55–56 V., c. 24, s. 3.

NOTE.—Section 14 of the Patent Act was repealed, and the foregoing substituted therefor by sec. 3, 55–56 Vic., c. 24.

The present substituted section follows the wording of sections 4891 and 4890 of the R. P. S. And as to explosive or dangerous materials, the wording is an adaptation of the latter part of the old repealed section.

The repealed section was imperative, viz.: "The applicant shall deliver to the commissioner, unless the same is specially dispensed with for some

good reason, a neat working model, etc.," and gave rise to litigation both in Ontario and Quebec.

Regina v. *Smith*, 7 Ont. R., p. 440, was a "*sci. fa.*" action to declare a patent void, on the ground that defendant had not furnished a model prior to the issue of his patent. The patent was dated 13th October, 1879, but was not received till the 30th April, 1880, having been withheld by the Patent Office till the model was furnished.

Held, by Rose J., 23rd Jan., 1885, that the statute (1872) does not require the delivery of a model prior to the issue of the patent; the delivery of the model unless dispensed with is imperative, and the time of delivery is left to the discretion of the Commissioner.

In Quebec, on the contrary, on the merits of an information by the Attorney-General of Canada, demanding the issue of a writ of "*sci. fa*": *Held* (under Act of 1872), that the omission to file a model of an invention for which Letters Patent are applied for without a dispensation from the Commissioner, is fatal to the validity of the patent: *Vide Attorney-General and Bate*, 6 L. N. 227, S. C. (1883).

While again, on the contrary, in Quebec, in *Campbell and Bate*, 15 R. L., 467, S. C. (1886), it was held (under Act of 1872), that the omission to deposit the working model of an invention in the Patent Office before the issue of the patent is not, even if proved, an essential invalidity annulling *ipso facto* such patent.

It does seem a hardship, that an inventor should have been liable to be deprived of his patent because the Patent Office did not demand a model. Now the foregoing contradictory decisions are settled by the new section, and no model or composition of matter is required to be furnished unless asked for by the Commissioner.

When the Patent Office Examiner finds it impossible to properly make out the alleged invention by means of the specification and drawings, a working model, to aid him, may be called for; in this respect the practice is the same as in the States.

The model room in the Patent Office shows a mass of models not worth preserving; and when it is considered that, in the

United States, in the year ending June, 1893, 39,539 patents were applied for, and 23,471 issued; and, that in Canada, in the year 1892, 3,416 patents were issued, the law dispensing with models, unless required by the Commissioner, is a wise one; in the States it was found impossible to house them; 87,000 models were destroyed in the Patent Office fire at Washington, in 1877.

Models, only when Required.

In Canada, models, when required by the Commissioner, must be neat and substantial working ones, not exceeding twelve inches on the largest side, unless specially permitted; if the machine be complicated a larger model would be permitted.

Ingredients required must be in glass bottles, but dangerous and explosive substances must not be sent, unless as directed in the requisition therefor from the Patent Office.

Models and bottles must bear the name of inventor, title and date of application: Rule 7, Appx. 1.

Models should preferably be made of metal, if made of wood should be painted or varnished; glue should not be used to connect the parts, and they should be so connected as to resist the action of heat and moisture.

Models in United States are the same sizes as in Canada, but may be larger than a cubic foot where the machine is complicated.

On abandoned or rejected applications models in United States may be returned to the applicant, the same rule would, doubtless, apply in Canada. Models, exhibits in suits, may be returned to applicant.

The production of a model does not negative the newness required under section 7 of this Act, according to U. S. decisions: *Cahoon* v. *Ring*, 1 Cliff., 593 (1861); *Johnson* v. *McCullough*, 4 Fish., 170 (1870); section 61, Walker; for to use a model or a drawing, is not to use the machine or manufacture which it represents; to hold that a mere model negatived novelty would afford a strong temptation to perjury.

In the case of a reissue, where the matter sought to be introduced and claimed does not appear in the original specification or drawings, a model filed in the Patent Office, showing the new matter, would not justify a reissue.

The rule in *Parker and Whipple Co.* v. *Yale Clock Co.*, 123 U. S. (1887), 17 Brodix, 194, affirmed that the Patent Office model alone is not to be considered the basis for a reissue in which a change of the invention of the original patent is sought: *Flower* v. *City of Detroit*, 18 Brodix, p. 621 (October, 1887).

But an applicant may amend his specification on reference to the model filed relating thereto. No new matter should be admitted not shown in the original specification, drawings or model.

Models are rarely required to be filed in foreign countries. In *Germany*, models are required when they relate to skates or fire-arms, and two models, one of which must be sectional, if for spools, spindles or shuttles. Samples are required for chemicals or dyes.

In Switzerland, filing a model is obligatory when the invention is for watch movements or fire-arms, and samples, when the combination of substances is difficult to determine.

15. No application for a patent shall be withdrawn without the consent in writing of each and every registered assignee of such patent or any part thereof : 35 V., c. 26, s. 38, *part*. The Patent Act, 55 and 56 V., c. 24, s. 4.

NOTE.—The foregoing was substituted in 1892, for the old section 15 of the Patent Act, which provides that in the case of withdrawal of any application, a fresh application would be necessary to revive the claim.

We have seen, under section 7, that, provided the inventor make the oath, sign the specification and duly assign before issue, the assignee can petition for and obtain the patent: Form 3, Appx. I., provides for exactly such a case as this.

In the event then of there being a sole assignee, no one but the sole assignee would have the right to withdraw the application.

In the event of a series of mesne assignees, which is unusual in Canada, the whole interest being in the last assignee, the last assignee would also alone have the right to withdraw.

This section then is alone applicable when a number of interests are extant, either by the inventor assigning to several

parties each an undivided interest in the invention with a direction to the Commissioner to issue the patent jointly to the inventor and assignees, or when the inventor assigns his whole interest to several assignees (Form 24, Appx. I.), or when the latter, or some of them, again assign partial interests to several assignees.

Under Note (*a*), section 7, we have seen that each of several joint patentees may use and deal with the invention in the absence of special agreement, without accounting to the others or any of them and without their consent; in the same way, joint assignees have each separate and distinct interests, and if they are registered, the Patent Office takes official notice of them.

In the United States, where there has been an assignment of an undivided part of an invention, amendments and other actions in the Patent Office requiring the signature of the inventor must also receive the written assent of the assignee, though this rule is not strictly adhered to in the States; but official letters will only be sent to the inventor, unless he shall otherwise direct. The assignee of an entire interest can correspond with the Patent Office to the exclusion of the inventor. When an attorney shall have filed a power of attorney duly executed by those interested in the invention, the correspondence will be with him; a double correspondence is not generally allowable.

When a Canadian application is withdrawn, ten dollars of the fee is retained, by virtue of section 43, and a fresh application would be necessary to revive the case.

PART IV.

Refusal to Grant Patents.

16. The commissioner may object to grant a patent in any of the following cases:—

(*a*) When he is of opinion that the alleged invention is not patentable in law;

(*b*) When it appears to him that the invention is already in the possession of the public, with the consent or allowance of the inventor;

(*c*) When it appears to him that there is no novelty in the invention;

(*d*) When it appears to him that the invention has been described in a book or other printed publication before the date of the application, or is otherwise in the possession of the public;

(*e*) When it appears to him that the invention has already been patented in Canada or elsewhere, if the case is one within the eighth section of this Act, unless the commissioner has doubts as to whether the patentee or the applicant is the first inventor. 35 V., c. 26, s. 40.

(1) Should the Commissioner object to grant a patent for any of the causes covered by this section of the Act, his decision may be appealed from to the Governor-in-Council as provided in the 18th section.

In order to sustain a patent, there must be invention as well as novelty and utility, under the meaning of section 7 of our Patent Act, which is in effect the same as that of the U. S. section, after which ours is framed: *Vide Allen* v. *Reid*, 14 Q. L. R. 126; *S. C.* (1888): *Held*, a patent must be for a thing invented as well as new and useful. The evidence showed that the processes and composition claimed by plaintiff were known and in use before the issue of his patent.

Dompierre v. *Basil*, 18 R. L. 597, Q. B. (1889): When an alleged invention does not constitute either a new process, or a new combination producing a result unknown before, it cannot be the subject of a patent: *Vide* also *Thompson* v. *Boisselier*, 114 U. S., 11 (1884); *Gardner* v. *Hertz*, 118 U. S., 191 (1885).

If a device is clearly inoperative, it is not the proper subject for a patent.

In *Gandy et al.* v. *Main Belting Co.*, 59 O. G., p. 1106, Sup. Ct. U. S., March 7th, 1892: One who has adopted and used in the manufacture of an article some feature covered by a patent is estopped from afterwards denying the utility of the invention. Public favor is held sufficient evidence of novelty and utility: *Vide Magowan* v. *Packing Co.*, 141 U. S. 332.

Dederick v. *Gardner*, U. S. Circuit Ct. N. D. New York, 59 O. G., p. 790 (April 19th, 1892): The fact that a device has gone into extensive public use is entitled to great weight in determining the question of patentable novelty.

NOTE (*a*) **"An alleged invention is not patentable in law if it be the mere application of a known machine process or material thing to an analogous purpose without novelty in the application thus constituting a double use."**

In *Harwood* v. *Great Northern Railway*, 11 H. L. Ca., 682; Goodeve, p. 225: The subject of suit was fish-plates for connecting rails, grooved or channelled so as to prevent the nuts of the bolts from turning, the same grooved plates having been previously used as a fish plate for the timbers of a bridge. *Held*, to be a mere analogous use and not patentable. This English case was reviewed by Henry, J., in *Smith* v. *Goldie*, 9 Sup. Ct. R. Can., p. 67, also by Gwynne J., S. C., p. 70, and by Henry, J., again in *Ball* v. *Crompton*, 13 Sup. Ct. R. Can., p. 486, and the principle approved of. See also *Hazlehurst* v. *Rylands*, R. P. C., vol. 9 (1892), p. 1; *Baker* v. *Kennell*, R. P. C., vol. 9, p. 441.

Non-analogous Use.

An invention is not the same thing as a discovery, and if a man does nothing more than discover that a known machine can produce effects which no one before him knew could be produced by it, his discovery, however great and useful, is not a patentable invention.

But the discovery how to use such a thing for such a purpose will be a patentable invention, if there is novelty in the mode of using it, as distinguished from novelty of purpose, if such mode of user involves any appreciable merit: *Fox* v. *Kensington Electric Light Co.*, L. R., 3 Ch. (App.) 1892, p. 424.

Application of old material to new use with a new result, held patentable: *Lister* v. *Norton*, R. P. C., vol. 3 (1886), p. 199: The question is, if an analogous use, it is not patentable, if not analogous, it is.

It is not a patentable invention to apply old and well-known devices and processes to new uses in other and analogous arts. A "better result" or "a wider range of use" does not confer patentability: *Vide Lovell Manufacturing Co. (Ltd.)* v. *Cary*, Sup. Ct. U. S. (decided March 6th, 1893), 62 O. G., p. 1821. An improve-

ment in the mode of tempering springs, in subjecting the springs to a temperature of 600°: *Held*, in view of the prior development of the same principle in the manufacture of wire bells for clocks, and of hair balance springs, to be invalid on the ground of "double use": Blatchford, J., delivered the opinion of the Court. *Ansonia Co.* v. *Electrical Supply Co.*, 58 O. G., 1692—144, U. S., p. 11, was specially referred to. In the opinion in that case the cases were reviewed which establish: (1) that the application of an old process or machine to a similar or analogous subject, with no change in the manner of application, and no result substantially distinct in its nature, will not sustain a patent, even if the new form of result had not before been contemplated; and (2) that on the other hand, if an old device or process be put to a new use, which is not analogous to the old one, and the adaptation of the old process to the new one is of such a character as to require the exercise of the inventive faculty to produce it, such new use will not be denied the merit of patentability: See also *Blake* v. *San Francisco*, 113 U. S., 682; *Pennsylvania Railway Co.* v. *Locomotive Truck Co.*, 110 U. S., 490.

"**An Analogous Use**" means a use between which and that alleged to anticipate there is a logical connection of such a character that the second use is fairly to be referred from the first by one familiar with it.

In *Brian* v. *Piper*, *vide* p. 319, Merwin, the Supreme Court (U.S.), says of an analogous use "The thing was within the circle of what was well-known before, and belonged to the public."

A plurality of patents cannot be granted for different uses of the same invention: *McComb* v. *Wood*, 1 Woods, 153; also Walker, section 180.

An old and well-known contrivance applied to an analogous purpose is not patentable; this suit related to an improved gearing for driving the cylinder of thrashing machines, but it appearing that the same gearing had been previously used for other machines, though no one had before applied it to thrashing machines, it was held that the novelty was not sufficient under the statute to sustain the patent: *Vide Abel* v. *McPherson*, 17 Grant, p. 23 (1870), affirmed on appeal, 18 Grant, p. 437 (1871).

Pollock, C. B., in *Bush* v. *Fox*, 9 Ex. R., 651, relating to improvements in the means of and in the apparatus for building and working under water, and the same device having been employed for sinking shafts on land, says in directing the jury: "Now, if the construction of this caisson is to be looked upon as old, and the object of the patent is for applying it to a new purpose, that is not a manufacture.

"I think if one man invents a new mode of looking at the moon, somebody else cannot take out a patent for using the same mode to look at the sun, nor any mere application of it for a different purpose. If a man were to take out a patent for a telescope, to be used for making observations on land, I do not think anyone could say 'I will take out another patent for that telescope, to be used for making observations on the sea.'"

Held, to be not patentable, being merely a "double use."

This ruling was affirmed in the Exchequer Chamber and in the House of Lords.

In *Boulton* v. *Bull*, 2 Hy. Bl., 487, Buller, J., said: "Suppose the world were better informed than it now is, how to prepare Dr. James' fever powder, and an ingenious physician were to find that it was a specific cure for a consumption, if given in particular quantities. Could he have a patent for the sole use of James' powders in consumptions, to be given in particular quantities? I think it must be conceded that such a patent would be void."

Vide also a large number of cases under section 38, Walker.

In *Losh* v. *Hague*, 1 Webs. Pat. Cases 207, Lord Abinger, C., said: "It would be a very extraordinary thing to say that, because all mankind have been accustomed to eat soup with a spoon, that a man could take out a patent because he says you might eat peas with a spoon. The law on the subject is this, that you cannot have a patent for applying a well known thing which might be applied to 50,000 different purposes, for applying it to an operation which is exactly analogous to what was done before."

See Brett's Commentaries, Laws of England (1890), vol. 1, p. 282; *Slazenger* v. *Feltham*, R. P. C., vol. 6, p. 232, in Ct. of Appeal, in which roughening the handle and making a knob at end of a lawn tennis bat, was held not patentable.

Wn. Electric Co. v. *La Rue* (April, 1891), Sup. Ct. U. S., 55 O. G., p. 571: the adaptation of a device to a similar sphere, where it performs substantially the same function, is a double use and not invention.

Steiner Fire Extinguishing Co. v. *City of Adrian*, 62 O. G., p. 1065, October, 1892, relates to chemical fire engine—application of old device to new use held not patentable.

If there are no difficulties to be overcome in adapting an old contrivance to a new purpose, there will be no invention, or where the so-called difficulties are so obvious as to present no difficulties: *Gadd & Mason* v. *Mayor of Manchester*, 9 R. P. C., 524; *vide Lane Fox* v. *Kensington Electric Light Co.*, 9 R. P. C., 413.

In *Hamilton* v. *Hayward*, Griffin's Patent Cases, p. 115, however, in which all that was done was to use one well-known form of prism instead of another, the result being an improved pavement light—the patent was upheld.

Pierrie v. *York Street Flax Spinning Co.*, 31 L. R. Ir., 3; 10 R. P. C., 34 (1893): *Held*, that the introduction of thin paper tubes into wet spinning was an application of a principle well-known in the process of dry spinning to the achievement of a result not previously attained in wet spinning, viz., the adhesion of the yarn, during the process of drying, to that on which it had been wound, and that the use of paper tubes in dry spinning *was not so analogous* to the use of them in wet spinning as to deprive the plaintiff's invention of the merit of novelty.

The invention consisted of a thin flexible paper tube outside of a rigid tube, in substitution for rigid tubes of various kinds previously used.

If an invention is injurious to the health, morals or good order of society, it is not patentable: *Bedford* v. *Hunt*, 1 Mason, 301.

In Great Britain, a grant of a patent altogether useless is void: *Morgan* v. *Seaward*, 2 M. & W., 562.

By section 6, 21 James I., c. 3, "The Statute of Monopolies," *that which is contrary to the law or mischievous to the State, by raising prices of commodities at home, or hurt of trade, or generally inconvenient*, does not come within the proviso of the Act, and is not patentable.

See also note to sub-section 2, of section 7, *ante*.

Mechanical Equivalency.

If an alleged improvement be merely the substitution of a mechanical or chemical equivalent in the place of part of the

old combination, it is not patentable: *Vide* cases collected in Wallace, on p. 46.

In *Wisner* v. *Coulthard*, H. C. J., Q. B. D., tried at Toronto, Ont., in December, 1889 (unreported), Mr. Justice Ferguson thus defines a "mechanical equivalent": "When one man has an invention and another man says he has invented the same thing or got the same object in another way, if it turns out that the second man has accomplished the same thing without invention, but merely taken one mechanical equivalent for another, and operating for the same purpose, the second is not invention, he is simply employing a known mechanical equivalent, and it has to be so known as to be generally known according to some authorities; the employment of that to operate what has been invented before will not be an invention, but will be an infringement. It is for mechanics to say or skilled men to say whether the particular thing is a mechanical equivalent."

Vide also, *Carter* v. *Baker*, 4 Fish., p. 409, for definition.

The question of mechanical equivalency is very fully discussed in Walker, 2nd ed., secs. 352, 353, 354, *et seq.*, with numerous cases. Mr. Justice Clifford, of the U. S. Sup. Ct., in *Machine Co.* v. *Murphy*, 97 U. S., 125 (1877), formulated this definition of an equivalent: "Authorities concur that the substantial equivalent of a thing in the sense of the patent law is the same as the thing itself; so that if two devices do the same work in substantially the same way and accomplish substantially the same result, they are the same, even though they differ in name, form or shape."

One thing may be an equivalent for another if it performs the same function in substantially the same way, producing substantially the same result.

One mechanic may furnish the power by means of a lever and another by means of a screw, yet the lever may be an equivalent for the screw, though they are different elementary mechanical powers: *Turrell* v. *Spaeth*, 3 Ban. & Ard., 458 (1878).

Springs and weights are equivalents if they perform the same functions in substantially the same way: See *Imheuser* v. *Buerk*, 101 U. S., 656 (1879).

A spring was held to be a "mechanical equivalent for a lever": See *Wenby* v. *The Manchester Steam Tramway's Co.*, R. P. C., vol. 8 (1891), p. 67.

The elementary mechanical powers are **"the inclined plane," "the lever"** and **"the pulley"**; "the wheel and

axle," "the wedge" and "the screw," being modifications thereof, and out of these, with connections and springs, all known forms of machines become evolved.

The elementary mechanical powers are all to be found in the animal frame; man creates nothing, he only invents.

There are two tests of equivalency: (1) identity of function; (2) substantial identity of performing that function: *Vide* Walker, sec. 362.

One thing may be an equivalent for another, though it does more than that other, but it cannot be such an equivalent if it does less: See Walker, sec. 352.

In *Atlantic Giant Powder Co.* v. *Goodyear*, 3 Ban. & Ard., 161 (1877), Judge Shepley held a certain gunpowder to be the equivalent of infusional earth, because it performed every function of the latter substance (a matrix for the nitroglycerine), though it also performed the additional function at the time of the explosion of the compound of co-operating with the nitroglycerine in rending the rock, instead of remaining like infusional earth, an inert substance.

The doctrine, that one ingredient is an equivalent of another, if it performs the same function, even though it also perform another function which that other is wholly incompetent to accomplish, approved of: See also U. S. Cir. Ct. of App., 9th Dist.; *Norton* v. *Gensen*, 60 O. G., p. 1326 (March, 1892).

Bliss v. *Haight*, 3 Fisher, 626 (1869), an iron hose coupling patent in dispute. The roller in the plaintiff's performed two functions, one to make a light joint, and the other to provide a swivel: *Held*, not infringed by a coupling having a pin with a conical face which performed the first function, but not the second: See also Cawood Patent, 94 U. S., 706 (1876).

And on p. 109 of Goodeve, we have *Cannington* v. *Nuttall*, in the House of Lords, in which Lord Hatherley indicates the same doctrine: "But we all very well know that if you are obliged to adopt a combination of machinery which originally is directed to one purpose, before you can make it minister to another and additional purpose, the user of it for this additional purpose is an infringement of the patent which first introduced that combination."

In the Ontario Courts, in the important suit of *Wisner* v. *Coulthard* (unreported), relating to "*combined seeding machines*," Mr. Justice Ferguson, in his judgment of 7th February, 1890, unanimously approved of by the Court of Appeal (Ont.), 12th May, 1892: *Held*, that two quadrant plates and a lower bolt connecting them were a "*mechanical equivalent*" for a strap, for the purpose of holding a notched projection on a drill hoe against a pivot pin on the drag bar, although the quadrant plates and bolt performed the additional function of affording means of adjusting the angle of the drill hoe or tooth, and of affording a place of attachment for the braces of the locking device.

In *Patric* v. *Sylvester*, 23 Grant, 573 (1876), Proudfoot, V. C., in a suit relating to seed drills: *Held*, that the difference was only one of mechanical arrangement or a mere substitution of "*mechanical equivalents*," and not a difference in principle; in the plaintiffs there was a lever of the first class, the point of attachment was below the junction of the draw bar with the hoes and operated by tension, while the defendant attached his above, the power operating by compression and the lever being one of the third class.

In *Ball* v. *Compton*, 9 Ont. R., p. 229 (1884), it was held, that in a corset, the substitution of continuous coiled wire springs for India rubber springs, as previously used, the coiled wire springs were a mere *mechanical equivalent* for the India rubber. This was affirmed in the Court of Appeal (Ont.), and again in the Sup. Ct., 13 S. C. R., 469 (1886). The U. S. patent in this case was also set aside in *Florsheim* v. *Schilling*, Sup. Ct., 53 O. G. (U. S.), p. 1737, November, 1890, affirming 26 Fed. R., 256: *Vide* for further illustrations note (*a*), sec. 16, "Aggregation and Change of Material."

In *Woodward* v. *Clement*, 10 Ont. R., p. 348, November 11th, 1885, an action against master and servant for infringement of "Arnold's improved automatic boiler," Proudfoot, J., granted an injunction against both, but the servant was not held liable in damages: *Delano* v. *Scott*, 1 Gilpin, 489, was cited.

The supply reservoir of defendants was narrower than that of plaintiffs, but had a sloping rim to receive the drippings from con-

denser and return them to the reservoir at an opening; while plaintiffs supply reservoir was wider than the condenser, so that condensed steam fell from condenser into the reservoir at every point of its circumference: *Held*, to be a mere variation of arrangement or a *mechanical equivalent* of a corresponding portion of plaintiff's device; containing no element of invention, but effecting the same purpose in a slightly different method.

In *Wisner* v. *Coulthard*, Ferguson, J., took the testimony of experts as to "mechanical equivalency": "Whether a thing is a mechanical equivalent, is a testimony of fact, depending on the testimony of experts": *Vide Foss* v. *Herbert*, 2 Fisher, 31, and in *Seed* v. *Higgins*, 8 H. L. Cas., 550, Lord Wensleydale states: "If scientific evidence is necessary, fully to elucidate the case on either side, it is, no doubt, admissible."

In all cases of "*mechanical equivalency*," and they are very numerous, for it is the usual way of infringing a patent for machinery, and in all cases of "*chemical equivalency*," an important consideration is, whether the device infringed is a *primary* or a *secondary* invention.

Primary Invention.

A "primary invention" is one which performs a function never performed by any earlier invention, such as the "hot air blast" or the telephone.

Secondary Invention.

A "secondary invention" is one which performs a function previously performed by some earlier invention, but which performs that function in a substantially different way.

"Primary" inventions are entitled to a somewhat looser application of the definition of an equivalent, and it is easier to make out equivalency than in the case of a "secondary" invention; while in "secondary" inventions the inventor of an improvement cannot invoke the doctrine of equivalents to suppress all other improvements, which are not mere colourable invasions of his: *Vide* Walker, s. 359. Nearly all inventions are "secondary" inventions, improvements on that which has existed before.

Primary Invention.

A patent which discloses an idea, and shows a method by which it can be carried out, is infringed by any apparatus,

which, by different mechanical means, carries out the same idea: *Easterbrook* v. *Great Western R. W. Co.*, R. P. C., vol. 2 (1885), p. 207.

A patent for a new process, for a new result, is infringed by a different process for the same result: *Badische Anilin, etc.* v. *Levinstein, supra.*

In *The Automatic Weighing Machine Co.* v. *Fearly*: *Held,* to be the substitution of a "mechanical equivalent" for a weighted lever of plaintiff's, and judgment was given for an injunction and costs: Times L. R., vol. 10, p. 22, October 31st, 1893.

In a recent Sup. Ct. case U. S., *Morley Co.* v. *Lancaster*, 19 Brodix, p. 263, the question of "mechanical equivalency" as bearing on "primary" and "secondary" inventions is very fully discussed, and the leading American and English cases are reviewed: *Vide* pp. 334–344.

Morley being a pioneer in the invention of an automatic machine for sewing buttons on fabrics, was held entitled to a liberal construction of the claims of his patent.

Held "Where an invention is one of a primary character, and the mechanical function performed by the machines, are, as a whole, entirely new, all subsequent machines which employ substantially the same means to accomplish the same results, are infringements, although the subsequent machines may contain improvements on the separate mechanisms which go to make up the machine (p. 333). *Vide* also as to construction of claim in primary patent: *National Cash Register* v. *American Cash Register Co.*, U. S. Cir. Ct. of App. (December, 1892), 62 O. G., p. 450; *vide* also as to equivalency, Bump., 2nd ed., p. 285.

Chemical Equivalents.

As an instance of "chemical equivalency," *Stevens* v. *Keating*, 2 Web. P. C. 181, for the manufacture of cement, in which borate of soda (borax), treated with gypsum (sulphate of lime), forming a double salt, was substituted for pearl-ash and sulphuric acid, also forming a double salt, and resulting in setting.

Any person may use, without infringement, chemical equivalents not taken to be such at the date of the patent: *Badische Anilin, etc.* v. *Levinstein*, R. P. C., vol. 2 (1885), pp. 92–93, but the use of "chemical equivalents" known to be such at the date of patent is an infringement: *S. C.*

Chemical equivalents, see *Hancock* v. *Moulton*, for an infringement of "vulcanized caoutchouc," a mixture of caoutchouc and sulphur, subjected to heat, infringed by a mixture of caoutchouc and hyposulphate of lead, subjected to heat: Edmunds on Patents, p. 243; see also *Heath* v. *Unwin* (1850), 5 H. L. C., 545; Goodeve, 233; *Morewood* v. *Tupper* (1855), 3 C. L. R., 717; *Muntz* v. *Foster* (1844), 2 Web. P. C., 95; also *Woodward* v. *Morrison*, 1 Holmes, 124.

The inventor of a novel combination of old elements is entitled to all the mechanical equivalents of his several elements, known at the time of his invention: *Vide Wicke* v. *Ostrum* (1881), 13 Brodix, p. 114; 103 U. S., 461.

Equivalents should be well-known at the date of patent, to be such: *Vide Wicke* v. *Ostrum* (1881), 13 Brodix, 114; 103 U. S., 461; *Rowell* v. *Lindsay* (1885), 15 Brodix, 441; 113 U. S., p. 97; but nearly all the Circuit Courts have uniformly ignored the element of age, when enquiring about equivalents. The Sup. Ct., U. S., has made age an element: See Walker, sec. 356.

The Sup. Ct., U. S. A., said: "This term, *equivalent*, when speaking of machines, has a certain definite meaning, but when used with regard to the chemical action of such fluids as can be discovered only by experiment, means *equally good*": *Tyler* v. *Boston*, 7 Wall., 327.

Mechanical Equivalency: See *Hartshorn* v. *Saginaw Barrel Co.* (1887), 16 Brodix, p. 530; 119 U. S., 664.

Two things are the same in the sense of the patent law, when they perform the same function, in substantially the same way, and accomplish the same result: See *Sayre* v. *Scott*, U. S. Cir. Ct. of Appeals, 3rd Cir. (May 23rd, 1893), 63 O. G., p. 1818; concrete pavement in detatched blocks: See *Hurlbut* v. *Schillinger* (1889), 19 Brodix, p. 542, 130 U. S., p. 456; U. S. Cir. Ct. of Appeals, 3rd Cir.; *National Cash Register Co.* v. *American Cash Register Co.* (December, 1892), 62 O. G., p. 450, a primary patent.

When "primary patent" is of low order, it will not receive a broad construction: *Vide* U. S. Cir. Ct. of App., *Dederick* v. *Seigmund* (July, 1892), 60 O. G., p. 1193.

Tamping oil wells with benzine, instead of with water, consti-

tuted an infringement of the Roberts' torpedo patent: *Roberts* v. *Roper*, 5 Fisher, 296 (1872).

English cases on "mechanical equivalency": See *Thomson* v. *Moore*, 6 R. P. C. (1889), p. 426: *Automatic Weighing Co.* v. *International Hygienic Co.*, 6 R. P. C. (1889), p. 475.

Aggregation.

(*a*) An "aggregation" is not patentable.

This doctrine first came prominently into notice in the U. S. suit of *Hailes* v. *Von Wormer*, 20 Wall., 353 (1873), where sundry features of self-feeding coal stoves had been assembled, making a superior stove, but the elements did not perform any joint function, but each did only what it had formerly done in other stoves.

This case has been continually relied on and promiscuously applied in Ontario Courts to destroy patents, and calls for notice. It first appears in one of the judgments in *Yates* v. *Great Western R. W. Co.*, 2 App. R., Ont., 226 (1887), relating to a railway chair for joining the ends of rails and preventing the nuts or bolts from turning; and was also the basis of the judgments setting aside the patent in *Hunter* v. *Carrick*, 10 App. R. Ont., p. 449 (1884) (relating to a baker's oven), and 11 Sup. Ct. (Can.), 300, 1885.

In *Wisner* v. *Coulthard* (an unreported case, Ont.), relating to a piece of mechanism in a seeding machine; the combination of (1) an independent drag bar, (2) a locking device, (3) a curved spring tooth, and (4) means of detachably connecting the tooth to the drag bar, *Hailes* v. *Von Wormer* formed the ground of the judgment of the 2nd February, 1891, setting aside the patent by the Div. Ct. Q. B. and reversing the judgment of the trial Judge; and was also the ground of the judgment (10th May, 1892), of the Court of Appeal, Ont. The doctrine of "aggregation" was apparently misapplied by these Courts, as there was a true combination and no aggregation.

However applicable this doctrine may in some cases possibly be with respect to a stove or other inert matter, such as a piece of furniture, it certainly is not applicable to a machine or piece of *operative mechanism*, and probably was never so intended by the U. S. Circuit Court Judge who propounded the doctrine,

which was afterwards endorsed and apparently misapplied by the Sup. Ct., U. S., in *Hailes* v. *Von Wormer*.

Hailes v. *Von Wormer* as reported in 7 Blatchford 443, was tried before Woodruff, J., Cir. Ct., N. Dis. N. Y., U. S.; after finding want of novelty and non-infringement as to all claims, propounds the "aggregation" dictum as to claim 1: "The combination of the *illuminated openings*, flame expansion chamber, coal supply reservoir, fire pot, descending flue, and draft flue, substantially," etc., and finds "the mere addition of an old device producing a specified result to another old device producing its own result in such a manner that their combination produces the same two results and no other, is not invention."

The *illuminated mica* openings contributed nothing towards the combustion or perfecting it, and this finding was possibly correct.

In the U. S. Sup.. Ct, in giving judgment on the five claims of the reissued patent, four claims were decided on non-infringement, and one, the second claim, on "*aggregation*" (p. 383 Brodix, vol. 9), this might have been non-infringement also, as stated by the Court; but as to this claim, which is "for contracting the discharge end of a coal supply reservoir, expanding the firepot, and extending the flame passage downward for united operation in a base burning coal supply reservoir stove or furnace," the Supreme Court have apparently misapplied Judge Woodruff's "aggregation" dictum where "the illuminated mica openings" came in, and may have erred; for the foregoing might well be a good combination, *if the result or effect thereof was shown to be novel*, and a better and more economical combustion and greater heat attained than was before possible, thus forming a new combination of old elements producing new and useful results, or the old results in a more useful and beneficial way.

In Merwin on Patentability, p. 398, sec. 118—the author, commenting on *Hailes* v. *Von Wormer*—states, when speaking of "*aggregation*": "the difficulty of bringing all these cases under one head at the same time excluding all non-patentable combinations is obvious. The Courts, however, and the Supreme Court especially, have proceeded as if this difficulty did not exist. Devising a rule to fit the same case before them, they go on to state it as one of universal application."

In sec. 129, p. 402, Merwin instances a case of what was held in *Williams* v. *Rome R. W. Co.*, 15 Blatch., 201, the "Locomotive

Head Light" case, to be a good and successful "aggregation," making it possible to use kerosene oil on locomotive head lights; and on p. 406 Merwin states: "The truth is that the Supreme Court left out of view this sort of combination (referring to *Williams* v. *Rome R. W. Co.*), when they gave judgment in *Hailes* v. *Von Wormer*, in which the separate parts cannot be said to have any operation by themselves," etc.

Exception.

Vide also sec. 122, Merwin, commenting on *Furbush* v. *Cook*, 2 Fisher 668, when a combination of machinery was the subject of the patent, in which Merwin states: "He (Mr. Justice Curtis) had before him *operative parts* as of machinery, whereas an article composed of so to say inert parts (like a lamp considered as a portable article and not as a machine to burn oil) can scarcely be said to have any mode of operation. In such cases (as to operative parts of machinery) a *new result* is the test of invention."

It is to be noted that Mr. Justice Strong, who delivered the judgment of the U. S. Sup. Ct. in *Hailes* v. *Von Wormer*, on June 5th, 1874, on May 8th, 1876, in *Reckendorfer* v. *Faber*, 10 Brodix 399,—the oft quoted rubber-tipped pencil case of "aggregation,"—evidently altered his views as to "*aggregation*," and dissented from the judgment of the majority of Supreme Court, U. S., as did also Mr. Justice Davis and Mr. Justice Bradley.

Sufficient has been said to show that "aggregation" should not be applied to a piece of *operative machinery*—such as the part of a seeding machine in *Wisner* v. *Coulthard* referred to.

The doctrine in *Hailes* v. *Von Wormer*, as stated in the Sup. Ct., U. S., is: "It must be conceded that a new combination, if it produces new and useful results, is patentable, though all the constituents were well-known and in common use before the combination was made. But the results must be a product of the combination, and not a mere aggregate of several results; each the complete product of one of the combined elements. Merely bringing old devices into juxtaposition, and there allowing each to work out its own effect without the production of something novel, is not invention."

Reckendorfer v. *Faber*, 10 Brodix, 399 (1892), U. S., 357, relates to a piece of soft rubber united to one end of a lead pencil; this was a phenomenal success, many millions of specimens being sold, yet the majority of the Sup. Ct., U. S., held that there was no joint operation performed by the pencil and rubber, and that the patent was void; it was a clear case of "aggregation" according to the doctrine given out two years previously, yet

three of the Judges dissented, as stated previously, the adoption of the tipped pencil by the public and its general use being presumptive of invention.

In *Pickering* v. *McCullough*, 104 U. S., 310 (1881), the doctrine was again affirmed in the Sup. Ct. U. S., with the addition, that all the constituents must so enter into the combination, as that each qualifies every other. These form the three leading cases: *Vide* Walker, 2nd ed., secs. 32, 33; Merwin, secs. 117 to 136.

Each Element Need Not Qualify Every Other.

In *National Cash Register Co.* v. *American Cash Register Co.*, U. S. Cir. Ct. of App., 3rd Circt. (decided December 23rd, 1892), 62 O. G.; *Pickering* v. *McCullough*, is examined, and the dangerous doctrine, apparently underlying part of the judgment, explained away, viz.: "No such doctrine (*i. e.*, that each element should modify or change the characteristic mode of action or method of operation of the others) appears to have been essential to the judgment in that case, nor do we think it necessary to attribute to the particular language referred to the meaning ascribed to it by counsel (on reading the whole case instead of an extract), etc. If it were essential to a valid patent for any combination whatever, that the mode of action of every element included in the combination should be changed by each of the others, it would be impossible to sustain several combination patents which have, in fact, been upheld, as indeed, it would be difficult to conceive of any mechanical combination which would be both possible and patentable." There is no intimation in the opinion that *Pickering* v. *McCullough*, should override the earlier decisions with which it apparently conflicts.

The doctrine of aggregation is very sweeping, and there is a conflict of opinion among U. S. Judges how it should be applied. "Aggregation" may be a roundabout way of holding there is no invention.

The elementary parts of the combination of old elements referred to in *Pickering* v. *McCullough*, need not act simultaneously, but may also act successively: *Vide* Walker sec. 33, *Hoe* v. *Cottrill*, 17 Blatchford p. 546.

The leading case in the Ontario Courts is *Hunter* v. *Carrick*, 28 Grant, 489, in which Proudfoot, J., upheld the first claim of the reissued patent: "A fire pot or furnace placed within a baker's oven below the sole thereof, and provided with a door situated above the grate."

"The door situate above the grate" first appears in the reissue, with-

out it there was no novelty in the claim of the original patent. The draft did not affect the fire and the coal did not fall out when the door was opened—the location of the door above the grate was deemed essential.

The Court of App., Ont., 10 App. R. p. 449, reversed, Proudfoot, J. (Patterson J. dissenting), holding the alleged combination an "aggregation" and not patentable.

S. C., 11 Sup. Ct. R. (Can.), p. 300. The judgment in appeal affirmed, the Court (Strong, J., dissenting), holding "aggregation."

In Canada as in the United States there is not a consensus of opinion as to aggregation.

N.B. In this case the headnote to the appeal case is erroneous, in that the claim as above is not properly recited, the tilting grate was in the 4th claim—the case was decided on "aggregation" or no invention rather than want of novelty as stated in the headnote. In the Sup. Ct. (Can.), Henry, J., gives judgment on the first claim of the *original* patent, and strangely overlooks the *reissued* patent which was alone in question.

In *Ball* v. *Crompton*, 12 App. Rep., Ont. (1886), pp. 739-740. Hagarty, C. J., in citing *Hunter* v. *Carrick*, states: "We were satisfied that the plaintiff had, by the skilful adoption and rearrangement of well-known particulars, produced in the whole the best oven that had been heretofore in use, but it was pointed out how he failed to establish his right to a patent for the combination." And again at p. 742: "I believe the result is a cheaper and better article just as the plaintiff in the oven case produced by his shrewdness the best oven."

One would suppose the foregoing was very good grounds for upholding the patent, yet it was set aside on the ground of "aggregation."

If a new and useful result is attained by the combination there can be no aggregation.

Illustration.

Take the twenty-six letters of the alphabet—a table of logarithms will quickly show that there are upwards of 412 septillions of combinations possible, a number of twenty-seven figures; out of these letters it is said that only 225,000 English words can be formed. So that an inconceivable number of com-

binations of the letters of the alphabet are mere "aggregations" or "juxtapositions," while only a few which form words with a definite meaning are good combinations; "cab" is a combination and "bca" is an aggregation.

Again, a mob is an "aggregation," while the body of police or soldiers which scatters it is a "combination."

Recent cases in the Supreme Court, U. S., bearing on "aggregation," are as follows:—

Union Edge Setter Co. v. *Keith*, Sup. Ct. (April, 1891), 55, O. G., p. 285.

Florsheim v. *Schilling* (November, 1890), 20 Brodix, 416, affirming 26 Fed. Rep., 256. This was the same patent in suit in *Ball* v. *Crompton*, 13 Sup. Ct. Rep. (Can.), 469 (1886), relating to a continuous coiled wire spring in a corset.

Watson v. *Cincinnati, Indiana, etc., R. W. Co.*, 20 Brodix, p. 22 (November 18th, 1889), 132 U. S., 161.

County of Fond du Lac v. *May*, 19 Brodix, p. 501 (1889).

Mosler Co. v. *Mosler, Bahmann & Co.*, 18 Brodix, 560 (1888).

Thatcher Heating Co. v. *Burtis*, 17 Brodix, 37 (1887), 121 U. S., 286.

Hailes v. *Albany Stove Co.*, 17 Brodix, 336 (1887), 123 U. S., 582.

(*a*) Mechanical Skill not Invention.

Allen v. *Reed*, 14 Q. L. R., 126 (1888). A manufacture or process which any skilled mechanic or chemist would suggest when required, or the result of judgment and skill in the adaptation and selection of materials is no invention.

Fasset v. *Ewart Manufacturing Co.*, 64 O. G., p. 439, April 3rd, 1893. In a machine for coupling the links of drive chains where a sidewise thrust of the coupling bar had already been patented, it was held only a matter of "*mechanical skill*" to adapt an endwise for a sidewise thrust: *Vide* sections 25 and 27 Walker, 2nd ed.

Day v. *Fairhaven R. W. Co.*, 20 Brodix, p. 1. The application of a diagonal brace to a track scraper involved mechanical skill only, and was not invention.

Butler v. *Steckel*, 20 Brodix, 384, (1890). Cutting dough into bretzels, do.

French v. *Carter*, 20 Brodix, 451 (1890), 137 U. S., 339. Improvements in roofs for vaults, do.

Consolidated Roller Mill Co. v. *Walker*, 20 Brodix, 563 (1891), 138, U. S. 124. Improvements in gearing for roller grinding mills, do. See also *Royer* v. *Roth*, 20 Brodix, 67.

Aron v. *Manhattan R. W. Co.*, 19 Brodix, 609 (1889), 132 U. S. 84.

Brown v. *District of Columbia*, 19 Brodix, 473 (1889), 130 U. S., 87.

Yale Lock Manufacturing Co. v. *Greenleaf*, 117 U. S., 554 (1886), it required only mechanical skill to adopt the anticipating lock.

Window Cleaner Co. v. *Bosley*, 15 Brodix, 64 (1884). Window cleaner—adjustment of parts only.

Hollister v. *Benedict Co.*, 113 U. S., 59 (1885). A stamp and slip of metal so attached as when removed it will mutilate the stamp; only mechanical skill required.

Omitting one element of an existing thing is not invention—unless such omission causes a new mode of operation of the parts retained: *Vide Allen* v. *Reed*, 14 Q. L. R., 126, *S. C.* (1888): *Vide* also *Stow* v. *City of Chicago*, 3 Ban. & Ard., 92 (1877), where omitting the board strips and board foundation of the "Nicholson pavement," was held to be no invention: See also *McClain* v. *Ortmayer*, 33 Fed. Rep., 287 (1888).

Where a process becomes new and patentable by omitting one of the steps of a former process: See *Lowther* v. *Hamilton*, 124 U. S., 1 (1888).

Also a process for the manufacture of gelatine by cutting hides into thin slices and then submitting them, in that state, to the action of caustic alkali, whereby the use of blood, as in the method previously used, was rendered unnecessary; held patentable: See *Wallington* v. *Dale*, 7 Ex. R., 888.

Where a change of form or size does not involve a change in mode of operation, or a change of function, it is not invention.

Illustrations.

A patent for shifting the rakers seat from one side of a reaping machine to the other, though the change made work easier for the raker, was invalid: *Marsh* v. *Dodge, etc., Co.*, 6 Fish., 562.

A mere change of former proportions will not entitle to a patent: *Vide Woodcock* v. *Parker*, Merwin p. 218.

In 7 Geo. IV., c. 5, Upper Canada, it was provided that, "simply changing the form or proportion of any machine or composition in any degree shall not be deemed a discovery." This is taken from the U. S. Act of 1793.

In reed organs making the length and size of the valve opening greater or less in a reed board, or where the reed board was made wider or narrower, or had more or less sets of reeds in it, was no invention: *Vide Esky* v. *Burdett*, 15 Brodix, 32 (1884), 109 U. S., 633.

It is no invention to make a larger sounding board in the same combination. *Day* v. *Bankers Tel. Co.*, 9 Blatch., 345.

An immaterial variation of a machine in general use cannot be the subject of a patent right, there must, at least, be a new adaptation of a known principle, or some change which has called forth the inventive faculty: *Vide Basil* v. *Masterman*, 4 L. N., 8, *S. C.* (1881): See also the judgment of Hagarty, C. J., in *Hunter* v. *Carrick*, 10 App. R. (Ont.), pp. 455–456, where a number of references and English cases, bearing on change of form, etc., are collected.

Old devices combined into a new article, without producing any new mode of operation not invention: *Vide Yale Lock Manufacturing Co.* v. *National Bank*, 17 Fed. Rep., 533 (1883), and sec. 37, Walker.

It is not Invention to Duplicate parts of a Machine.

Making two deflecting plates in a saw mill machine which doubles the effect of the one previously in use, is no invention: *Dunbar* v. *Meyers*, 94 U. S., 187 (1876): *Vide* Walker, sec. 34.

Placing two glass panels instead of one as previously in a street car fare box, not invention: *Slowson* v. *Railroad*, 14 Brodix, 475 (1883).

The substitution of one material for another, if the result be only greater cheapness or durability, is not patentable: *Hotchkiss* v. *Greenwood*, 11 How., 248; Bump., 2nd ed., 55, 56; *Brook* v. *Ashton*, Goodeve, 94; Curtis, 4th ed., sec. 73; Walker, sec. 28; Robinson, p. 330.

In *Rushton* v. *Crawley*, 10 Eq., 522 (1870). The use of a new material to produce a known article not patentable: Curtis, 4th ed., sec. 72, c.

In *Kilbourne* v. *Bingham* (June 6th, 1892), Cir. Ct. of App., 6th Dist., 60 O. G., p. 577. The use of wrought iron or steel in lieu of cast metal, is a mere substitution of materials, and not patentable, notwithstanding the superior results obtained.

Florsheim v. *Schilling*, Sup. Ct., U. S., 20 Brodix, p. 416; 137 U. S., 64 (November, 1890): *Held*, that the substitution of the metal spiral spring for the india rubber spring, which does not involve change of method nor develop novelty of use, even though it may result in a superior article, is not necessarily a patentable invention."

See also *Brush Electric Co.* v. *Electrical Accumulator Co.*, 56 O. G., 1334.

Exception.

Generally speaking, if a result long sought for has been attained, the device or process which attained that result may be patentable: *Tondeur* v. *Chambers*, 37 Fed. Rep., 333 (1889); Walker, 2nd ed., sec. 26.

And in applying the tests, patents are not held void for want of invention, except when invention is clearly absent: *Reiter* v. *Jones*, 35 Fed. Rep., 421 (1888); *Marrin* v. *Gotshall*, 36 Fed. Rep., 908 (1888).

Changing the form of a coal-car from rectangular to conoidal was held patentable: See *Winans* v. *Denmead*, 56 U. S.; Renwick (1893), p. 6.

Lessening the size of the perforations in the lantern-case of the "Davy safety lamp" a proper subject for a patent: Renwick (1893), p. 10.

There may be invention in change of proportion. Nelson Goodyear discovered that by increasing the quantity of sulphur for mixture with crude rubber in the process of vulcanization,

that vulcanized rubber lost its pliable quality and became "vulcanite": See *Goodyear* v. *New York Gutta Percha, etc., Co.*, 2 Fish., 312.

There may be invention in change of material; a rubber roll for wringing machines held patentable: Renwick (1893), p. 12; a rubber plating for a carriage step held patentable: See *Rubber Step Manufacturing Co.* v. *Metropolitan R. Co.*, 3 Ban. & Ard., 252; Renwick (1893), p. 25.

There may be invention in duplication of parts; in an ice-cutting machine a series of cutters arranged behind each other, projecting to progressively increased distances beneath the beam so that the ice was cut by a succession of chippings, was held patentable: *Wyeth* v. *Stone*, 1 Story, 273. See also as to duplication of parts being patentable: *Parker* v. *Hulme*, 1 Fish., 44; Renwick (1893), p. 32.

There may be invention in change of arrangement of parts; arranging the discharging wheel to throw the seed vertically instead of horizontally was held patentable: *Cahoon* v. *Ring*, 1 Cliff., 592; Renwick (1893), p. 16.

The change of location of a quadrantal platform in a reaping machine, inducing a new mode of operation, held patentable by the U. S. Sup. Ct.: *Seymour* v. *Osborne*, 11 Wall., 516.

Abandonment.

(*b*) See section 16. When the invention has been in public use or on sale for more than one year with the consent or allowance of the inventor prior to application for a patent therefor in Canada, it is deemed to be in the possession of or abandoned to the public: *Vide* note *e*, sec. 7, where the matter has been fully discussed.

Illustration.

In *Hessin* v. *Coppin*, 19 Grant, p. 629 (Ont.), 1873, the inventor of a new machine, before taking out a patent, erected and sold a machine embodying his invention, and the purchaser had it in use three years before the inventor procured a patent. The machine so sold was not put up for experimenting, but was sold as a complete machine:—

Held, that the inventor had lost his right to a patent.

In section 7 we have the expression "in public use," here, section 16, we have "in the possession of the public, with the consent or allowance of the inventor," and in section 46 of this Act we have a definition of what will constitute a possession by the public, viz., if it be "purchased, constructed, acquired, or used, with the consent or allowance of the inventor thereof, for a longer period than one year before the application for a patent therefor, making the invention one which had become public and in public use." But as to this last definition, it must be remarked that it relates to a case under section 46, where a person has purchased, constructed, or acquired an invention prior to the issue of a patent, and relates to the "specific article" so purchased, constructed, or acquired.

The establishment of "abandonment" or of "public use" requires proof so clear as to be beyond all reasonable doubt: *Bury* v. *Thompson*, 58 O. G., p. 1255; *Oval Wood Dish Co.* v. *Sandy Creek Manufacturing Co.*, 66 O. G., p. 1895 (March, 1894).

(*c*) See section 16. **Novelty** lies at the root of everything which is patentable in Canada, and has been already discussed under Notes (*c*) and (*d*), sec. 7.

The meaning of "novelty" differs from the meaning in the United States, as well as in England—here we have seen it may have a literal meaning—while in the States, by sections 4887, 4923 R. S., "novelty" is not negatived by prior knowledge and prior use in a foreign country of a patented article, provided the patentee, at the time of making his application for a U. S. patent, believed himself to be the first inventor of the thing covered thereby, and provided that the thing had nowhere been patented to another, and had nowhere been described in a printed publication prior to his invention thereof.

Under note to section 10, we have seen that "*patents of communication*," from abroad, are still obtainable in Great Britain, under the Patent Act of 1883, by agents, and that the first introducer into the realm was held to be "*the true inventor*" within the meaning of the Statute of Monopolies.

In *North* v. *Williams*, 17 Grant (1870), p. 179, the introduction into a drum stove, in addition to a spiral flue which had previously been in use, of a centre pipe closed at sides and open at

top and bottom, as a means of producing greater heat: *Held*, that the improvement did not involve any new principle or new combination, and that the patent was void: *Vide* also *Sylvester* v. *Masson*, 12 App. R. Ont., p. 335 (1885).

Novelty not Negatived.

(1) When all the elements of the combination are old so that the combination be new, and the result useful: *Parks* v. *Booth*, 102 U. S., 104 (1880). It must, however, be a combination and not a mere aggregation: see note, *a*, section 16. There may be a new means of producing an old result: *Vide O'Reilly* v. *Morse*, 15 How 62 (1853).

(2) By an accidental production of an alleged anticipating article, without sufficient knowledge to enable one to repeat the production: *Andrews* v. *Carman*, 2 Ban. & Ard., 277 (1876).

(3) Novelty is not negatived by a prior inoperative device: *Vide Morey* v. *Lockwood*, 8 Wall., 230 (1868).

(4) Novelty is not negatived by prior abandoned applications for a patent; they are not publications: *Vide* Cornplanter Patent, 23 Wall., 211 (1874).

And in Great Britain by 48 and 49 Vic., c. 63, sec. 4 (1885): When an application for a patent has been abandoned or become void, the specification or specifications and drawing (if any) accompanying or left in connection with such application shall not at any time be open to public inspection or be published by the comptroller.

(5) Nor, as we have seen, is novelty negatived—*vide* note *d*, sec. 7—by unpublished drawings or models: *Vide* Walker, 2nd ed., sec. 61.

(6) An abandoned experiment is no evidence of want of novelty: *Vide* Walker, sec. 95.

Novelty Negatived.

But where there has been a public, well-known, practical use in ordinary work, of the exact invention, and although only one article of the patented invention was ever made, which was used two and a half months only, and then taken from the lamp: *Held*, that it was a perfected invention and not a mere aban-

doned experiment. A question of degree in the use of substantially the same means is not novelty: See *Brush* v. *Condit*, Sup. Ct., U. S., 19 Brodix, 582 (November, 1889).

A qualified disclaimer, however, is held to be an admission of want of novelty: See *Collins Co.* v. *Loring*, Sup. Ct., U. S., 19 Brodix, p. 452 (March, 1889); also an express disclaimer: See *Beecher Manufacturing Co.* v. *Atwater Manufacturing Co.*, 16 Brodix 106.

(*d*) See section 16. **Printed description or possession by the public as grounds of refusal of a patent.**

Abandonment to the public by the inventor cannot, it is conceived, take place by the mere description by the inventor himself of his own invention in a book or printed circular, during the year prior to his application for a patent; although a printed description in a book or other publication by the inventor himself more than a year prior to his application, may be held to work such "abandonment."

In *Barter* v. *Howland*, 26 Grant, p. 135 (Ont.), where the plaintiff had more than one year previous to his application for a patent, in Canada, obtained a patent in the U. S., disclosing the same invention though not containing all the claims of the Canadian patent; Blake, V. C.—*Held*, that under sec. 7 of the Patent Act of 1872, such foreign patent amounted to a publication of the whole invention in the United States, and imported a disclaimer of all parts not claimed in the foreign patent. This case is analogous, but, of course, refers to a patent; books or other printed publications are spoken of separately, as distinguished from patents in sub.-secs. (*d*) and (*e*) of this sec. 16.

It does not appear reasonable that a mere printed publication by the inventor himself, within a year prior to his application, should work a forfeiture, when being "in public use or on sale" during that period, "with the consent or allowance of the inventor," will not work such forfeiture. Besides that the right to expose articles for sale implies a right to advertise them for sale in books or printed publications, both by the inventor and by those whom he authorizes and allows. The publication is to be a "printed" publication and not a manuscript.

The publication in this sub-sec. (*d*), "in a book or other printed publication before the date of the application" must then refer to an independent invention by some person, other than the applicant.

The invention may be "otherwise in the possession of the public" by reason of the inventor having taken out a foreign patent and failed to apply for his Canadian patent within a year of the date of his foreign patent under sec. 8; or by reason of an unpatented invention by an independent inventor being in public use or on sale in Canada prior to the application; or by reason of it having been "known or used" anywhere prior to applicant's invention thereof: *Vide* Note (*d*), sec. 7.

In this sub-section (*d*) of section 16 "possession of the public" appears to be contrasted with the "possession of the public" referred to in sub-section (*b*) of section 16, and is without the consent or allowance of the inventor.

There may be an abandonment to the public when an inventor makes an express declaration to that effect: See *Kendall* v. *Winsor*, 21 How., 328 (1858).

The Supreme Court, U. S., has held that the failure for two years without excuse to prosecute an application for a patent works an abandonment of the invention: *Planing Machine Co.* v. *Keith*, 101 U. S., 479; unless there are the strongest reasons for the delay, such as sickness, insanity or actual poverty: See U. S. R. S., sec. 4894.

Publication.

The meaning and effect of "publication" in Great Britain, the United States, and Canada differs, as appears by the following citations:—

Illustrations.

(*d*) See section 16. The printed description must be such as would enable a properly qualified person to put the invention into practical operation from the description alone: *Vide Eames* v. *Andrews*, 17 Brodix, 98.

In *Hills* v. *Evans*, 31 L. J., Ch., 463, Lord Westbury said: "The antecedent statement must, in order to invalidate the subsequent patent, be such, that a person of ordinary knowledge of the subject would, at once,

perceive and understand and be able practically to apply the discovery without the necessity of making further experiments."

And in *Plimpton* v. *Malcolmson*, L. R., 3 Ch. D., 531, Sir George Jessel says: "He must not select eminent engineers or celebrated chemists as the persons to whom the specification must be intelligible, but he must choose ordinary workmen in the particular branch or trade to which the invention refers, etc. He may, of course, call eminent engineers, but their evidence can only have this effect, placing myself in the position of an ordinary workman, whether I think it would or would not be intelligible to me."

On the same line as the foregoing, *Morgan* v. *Seaward*, 1 Web. Pat. Cas., 167, was also decided.

Now, however, in a recent House of Lords case, the foregoing tests have been materially changed, which, in the case of prior publication, enure to the destruction of the patent, and in the case of insufficiency of specification, to its validity.

New Test in England.

The test now as to prior publication is, whether the specification was sufficient to convey to men of science and employers of labour information which would enable them to understand the invention so as to give a workman specific directions for the making of the machine, and applying such test there had been publication: *Anglo American Brush Electric Light Corporation* v. *King, Brown & Co.* (1892), App. Cas., 367, H. L.

Prior publication in a foreign magazine published in Great Britain invalidates the patent: *Pickard & Curry* v. *Prescott* (1892), App. Cas., 263.

"Publication" is defined to be an addition to the stock of knowledge which the public either has or can acquire by consulting some source of information open to it; it has not the same meaning when used with reference to patents as it has when used with reference to libels or slanders: *Vide Gadd & Mason* v. *Mayor of Manchester*, 9 R. P. C., p. 527 (1892); *Humpherson* v. *Syer*, 4 Web. Pat. Cases, 410, and *Plimpton* v. *Malcolmson*, 3 Ch. D., 531, before referred to.

If a foreign patent be taken out first in a country belonging to the International Convention, and then published in England prior to taking out a patent; if the English patent be not antedated to

the date of foreign patent as required by section 103, Patent Act (1883), Eng., the prior publication in England is fatal: *Vide British Tanning Co.* v. *Groth*, 60 L. J., c. 235, 8 R. P. C., 113.

Prior publication in a foreign journal and in a foreign language will invalidate an English patent if it can be shown that a single copy was deposited in England in a public place and was open to public inspection: *United Telephone Co.* v. *Harrison & Co.*, L. R. 21, Ch. D., 720.

Prior publication in England was proved by evidence of delivery of a foreign publication, showing the invention, to several persons a few days before the date of patent: *Pickard* v. *Prescott*, R. P. C., vol. 7, p. 361 (1890).

No prior description ought to invalidate unless the patented thing could be made from the description, per Jessel, M. R.: *Plimpton* v. *Malcolmson*, p. 377, Goodeve, L. R., 3 Ch. D., 531. In this case, a volume of patents from the United States, containing a drawing, had been deposited in a room in the Patent Office Library, which room was not accessible to the public. Jessel, M. R., held that the existence of this book for ten years on the shelf in a private room, was not a publication, and he quotes Tindall, C. J., in *Stead* v. *Williams*, 2 Webs. Pat. Cas., 126: "It must be published in a book made public in England. It must be publicly circulated, and it must give possession of the knowledge to the public." And in *Stead* v. *Anderson*, 2 Webs. Pat. Cas., 147, "That a book must be made public to such an extent as to be generally known by persons practising in such matters."

As to prior publication in England, the law on the subject as stated in *Gadd* v. *The Mayor of Manchester*, T. L. R., vol. 9, p. 42 (November 4th, 1892), is said to be found in *Humpherson* v. *Syer*, 4 Pat. Cas., 410; and *Plimpton* v. *Malcolmson*, 3 Ch. D., 531, *supra*.

A French treatise was placed in the British Museum Library in 1863. The Museum's catalogue is kept with reference to authors' names and subject matter, and parties might have been guided to this treatise: *Held*, that there was no prior publication in England of matter contained in the treatise so as to avoid a patent taken out in 1876, and that as defendant adduced no evidence of such book being actually used, or of any other copies

having been introduced into England, evidence was inadmissible: *Otto* v. *Steel*, R. P. C., vol. 3 (1886), p. 109; 31 Ch. D., 241.

When two specifications in German had been more than two years and forty days respectively, in the Patent Office Library, London, Eng.: *Held*, that having regard to facility of access to the Library, to information given in the "Patent Journal," and the length of time there had been previous publication in England; novelty was negatived; and that it was immaterial whether the publication was in German or English: *Harris* v. *Rothwell*, R. P. C., vol. 3 (1886), p. 383.

Anticipation.

In cases of alleged anticipation by earlier patents from which no actual manufacture had been made, caution is to be observed in dealing with such alleged anticipation: *Ehrlich* v. *Ihlee*, R. P. C., vol. 5, p. 206 (1888).

In the United States a foreign publication prior to the invention in the States, even though it had not reached the States would suffice to avoid the patent under their Act: *Vide* Walker, 2nd ed., sec. 54.

Publication in Canada.

As in Canada, a patentable invention may be required, as we have seen, to be new as to the whole would, the book or other printed publication referred to in sub-section (*d*) of the Act may be held to mean a book or printed publication anywhere. We have no reported judicial decisions exactly on this point, but in *Smith* v. *Greey* (a sequel to *Smith* v. *Goldie*, 9 Sup. Ct., Can., decided June 19th, 1883), tried before Mr. Justice Proudfoot, at the Chancery Sittings, Toronto, in 1886. A work published in France, containing an alleged anticipation of plaintiff's invention of a "Middling's purifier," which had found its way to Minneapolis, U. S., was allowed in, as evidence, at the trial, of the want of novelty of plaintiff's Canadian Letters Patent, under the general plea of want of novelty, set up in the pleadings, notwithstanding the objections of plaintiff's counsel; no particulars had been demanded as to this.

The "printed publication" referred to in this sub-section may

mean the printed specifications attached to Letters Patent in the United States, or in Germany, or the specifications in Great Britain, which are also printed but not attached to the deed.

In foreign countries the specifications are not usually attached to the patent deeds, as is the case in Canada and the United States and Germany and Belgium.

In Canada the specifications are either "written or typewritten," but, as in the Interpretation Act the expression "writing, written or any term of like import, includes words printed, painted, engraved, lithographed or otherwise traced or copied," Canadian specifications may thus come within the meaning of a "printed publication."

Defects in Section 16.

The section is defective in that it does not directly refer to inventions previously patented in Canada or elsewhere, as anticipations, for the reference to them in sub-section (*e*) following, is confined to cases arising under the eighth section of the Act; proof, however, that an invention had been patented anywhere would go to show that it was "known" within the meaning of the 7th section.

This sub-section (*d*) refers to a publication before the date of the *application* for a patent in Canada; in Canada, the publication may then, possibly, be held to mean a publication outside of Canada, not shown to have reached there, as showing that there had been prior knowledge or use of the patented article elsewhere.

In the United States, by section 4886, "not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof," is held to mean that novelty in the States is not negatived by anything patented or described in the United States or any foreign country, unless such thing antedates *the invention of* the applicant in the United States: See *Cochran* v. *Diener*, 11 Brodix, 290, Sup. Ct., U. S. (1877); *Elizabeth* v. *Pavement Co.*, 11 Brodix, 514, Sup. Ct., U. S.

As to Publication in Canada and United States.

In Canada publication before the date of *application* is material, in U. S. publication before *the date of invention;* the U. S. Statute also expressly refers to foreign publications.

At the Patent Office library in Ottawa, the full text of the U. S. specifications have been received for some years past, and are there in bound volumes. Recently the English and French specifications have been received into said library from the Parliamentary Library.

(*e*) See section 16, This sub-section appears to meet the case of an invention first patented abroad, and the applicant applying within one year of the date of the first foreign patent for a patent in Canada under section 8; if a patent should have already issued in Canada to an independent inventor, this, of course, would cut out the new applicant; this sub-section also, under the words "or elsewhere" covers the case of a foreign patent, being within the knowledge of the commissioner, which foreign patent anticipates that of the applicant, so that he is not the true and first inventor as to the world, as may be required by our Act as it now stands in this case, also the granting of a Canadian patent may be objected to. (See Appx. 3 for amending Act, if any, passed during session of 1894).

But if the Commissioner has doubts whether the prior patentee in Canada, as in the first instance, or the foreign patentee, as in the second instance, be the first and true inventor, or whether the applicant be, he may, it is inferred, grant the patent to the new applicant and allow the parties to adjudicate the matter in the Courts.

By the Act of 1869, sec. 40, this provision appeared for the first time, and the term here could not then mean "the first inventor" the world over, for the Act of 1869, in which they first occur was limited to residents of Canada, and an independent Canadian inventor's patent was not liable to attack, because of any knowledge or use of the invention abroad not accessible or open to the public.

The remedy, although not specifically stated, is implied, and the procedure would, it is conceived, be under the amended 34th section of this Act, by *sci. fa.*, in the Courts of any of the Provinces or North-West Territories of Canada, or in the Exchequer Court of Canada, at the suit of any of the patentees or of any person interested: *Vide* section 34.

Defects in Sub-section (*e*).

This sub-section is defective, in not specifically stating what the Commissioner may do, nor how the matter is to be brought before the Courts to determine who is the "first inventor"; in one instance, at least, the Commissioner held that he had no power to grant another patent, in view of the existence of a previous patent to another inventor; the question, however, might be brought up under section 34, to repeal the existing patent by the new applicant, and if the new applicant were successful in showing that he was the first inventor, the old patent might be repealed and a new one issued to the applicant; there ought to be some provision, as in the States, confining the issue to which was "the first inventor."

Procedure in U. S.

In the United States, the procedure is different. Although the Commissioner of Patents has no power to cancel a patent, he may grant another patent for the same invention to a person who proves to be the prior inventor; and to determine this point, an interference would be declared, *under Rule 94* of the U. S. Patent Office; there are eight cases in which interferences may be declared set out in this rule.

The case in point would come under heading two as between an original application and an unexpired patent containing conflicting claims, when the applicant, having been rejected on the patent, shall file an affidavit that he made the invention before the patentees application was filed.

All preliminary questions having been settled by the primary examiner, the issues are clearly defined, and the case forwarded to the examiner of interferences, who makes a formal declaration of interference, by forwarding notices to the parties to the proceedings.

If, in the interference proceedings, the new applicant be adjudged the prior inventor, it becomes the duty of the commissioner to grant him a patent, under section 4904, Revised Statutes.

A suit in equity may then be instituted to determine which of the two patentees is entitled to the patent or claims in

question, and the only issue of fact is, which of the two is the first inventor? There may, however, be an issue of law: *Vide Morris* v. *Manufacturing Co.*, 20 Fed. Rep., 121 (1884).

Evidence that a third person anticipated both inventors is not admissible in an interference suit.

And the evidence taken in the Patent Office is not to be used in the Court: *Vide Clow* v. *Baker*, 36 Fed. Rep., 692 (1888).

For proceedings as to interfering patents: *Vide* Walker, 2nd ed., c. 13.

17. Whenever the Commissioner objects to grant a patent as aforesaid, he shall notify the applicant to that effect and shall state the ground or reason therefor, with sufficient detail to enable the applicant to answer, if he can, the objection of the commissioner. 35 V., c. 26, s. 41.

NOTE.—Outside of the signing of the patents all the routine work of the Patent Office is done by the Deputy Commissioner and his staff; the Deputy Commissioner having general control of the business as provided in sub-section 2 of section 5 of the Act.

Besides formal objections to the specifications and drawings which are usually capable of correction by correspondence, we have seen that the Commissioner may object to grant a patent if, in his opinion, it lacks (1) novelty, (2) utility, or (3) invention, (4) if it be the mere application of a known machine or process to an analagous purpose, (5) if the invention be injurious to the health, morals or good order of society, (6) if the invention have an illicit object in view, (7) if it be for a scientific principle or abstract theorem, (8) if "mechanical equivalents" be substituted in an existing machine, (9) if "chemical equivalents" be substituted in an existing composition of matter, (10) if it be an "aggregation," (11) if it be merely the result of mechanical skill, (12) if it be the mere omission of one element of an existing thing without setting up a new mode of operation, (13) if it be a mere change of form or size, which does not involve change of operation or change of function, (14) if it be the mere substitution of one material for another, (15) when the invention is abandoned or in the possession of the public, (16) if there be a

disclaimer or a qualified disclaimer, (17) if it be merely a question of degree in the use of substantially the same means, (18) if it be described in a book or printed publication prior to the application, (19) if it be patented previously in Canada or elsewhere, (20) if in the case of an application by a foreign patentee, under section 8 of this Act, a previous patent should have already issued in Canada to an independent inventor, (21) if a foreign patent be in existence anticipating that of the applicant, (22) if the invention by express terms be expressly abandoned to the public, (23) if there be laches in prosecuting the application in the Patent Office, and it be not perfected within two years from date of filing the petition (24) if the device is clearly inoperative.

And for other reasons not above enumerated the Commissioner may object to grant a patent, and he shall notify the applicant, presumably in writing.

The sufficiency of the *detail* to be given by the Commissioner is presumably that which would suffice in a Court of law, giving dates and occasions when and person by whom prior user was had: See *Smith* v. *Greey*, 11 Prac. Rep. (Ont.), p. 169.

The numbers and dates of the patents, and the persons to whom the prior patents were made and the countries in which issued may be demanded.

If publications or books are set up, the pages of the book, etc., its date and where it may be obtained should be pointed out: See *Silsby* v. *Foote*, Sup. Ct., U. S., 14 How., 218; or any other matters which would add definiteness to the grounds of refusal.

Many of the foregoing reasons for refusal of a patent involve mixed questions of law and fact, and the Commissioner of Patents has been in the habit in this country, as well as the Commissioner in the United States, of disregarding the legal aspect of the cases, and confining their objections to such questions of fact as may arise relative to anticipation and to formal matters in the framing of the specification and claims.

18. Every applicant who has failed to obtain a patent by reason of the objection of the commissioner, as aforesaid, may, at any time within six months after notice thereof has been addressed to him or his agent, appeal from the decision of the commissioner to the Governor-in-Council. 35 V., c. 26, s. 42.

NOTE.—The previous section says that the applicant is to answer if he can the objection of the Commissioner; this implies that the Commissioner is to consider the answer to the objection. The answer might take some time to prepare, and the Commissioner might delay the consideration of the answer. One would suppose that the "six months" should then commence to run from the date of addressing the final notice of rejection after the answer had been heard, this latter appears to be the recognized practice.

The term "addressed to him" probably means "mailed to him." A letter or notice might be addressed, but never sent, and the time would commence to run from the date of mailing.

The six months mean "calendar months" under the Interpretation Act. In the United States they may mean "lunar" months, although the practice is now to regard them as calendar months.

The appeal to the Governor-in-Council would practically mean the Minister of Justice; an appeal to the Exchequer Court one would suppose a more desirable procedure.

Appeal in the Matter of a Lapsed Application.

Under this section 18 it has been held by the Commissioner of Patents, Canada (1st February, 1894), in the matter of the lapsing of application No. 57,729 (Fitzmaurice), by reason of the non-completion or non-perfecting of the application within two years from the date of filing, as required by Rule 9 of the Patent Office (see Appendix 1), that an appeal lay from the decision of the Commissioner to the Governor-in-Council. The proceedings are by way of petition to the Governor-in-Council, setting out the facts, with a prayer for the relief required, supported by affidavits; the petition, etc., to be left with the Secretary of State and the Commissioner of Patents.

PART V.

CONFLICTING APPLICATIONS.

19.—(*a*) In case of conflicting applications for any patent, the same shall be submitted to the arbitration of three skilled persons, two of whom shall be chosen by the applicants, one by each, and the third of whom shall be chosen by the commissioner or by the deputy commissioner, or by the person appointed to perform the duty of that officer; and the decision or award of such arbitrators, or of any two of them, delivered to the commissioner in writing, and subscribed by them or any two of them, shall be final, as far as concerns the granting of the patent:

2. (*b*) If either of the applicants refuses or fails to choose an arbitrator, when required so to do by the commissioner; and if there are only two such applicants, the patent shall issue to the opposing applicant:

3. (*c*) If there are more than two conflicting applications, and if the persons applying do not all unite in appointing three arbitrators, the commissioner or the deputy commissioner or person appointed to perform the duty of that officer, may appoint the three arbitrators for the purposes aforesaid:

4. (*d*) The arbitrators so named shall subscribe and take, before a judge of any court of record in Canada, an oath in the form following, that is to say:—

"I, the undersigned (*A. B.*), being duly appointed an arbitrator under the authority of '*The Patent Act*,' do hereby solemnly swear, (*or affirm, as the case may be*), that I will well and truly perform the duty of such arbitrator on the conflicting applications of (*C. D.* and *E. F.*) submitted to me:"

5. (*e*) The arbitrators, or any one of them, when so sworn, may summon before them any applicant or other person, and may require him to give evidence on oath, orally or in writing (*or on solemn affirmation, if such applicant or person is entitled to affirm in civil cases*), and to produce such documents and things as such arbitrators deem requisite to the full investigation of the matters into which they are appointed to examine, and they shall have the same power to enforce the attendance of such applicants and other persons, and to compel them to give evidence, as is vested in any court of justice in civil cases, in the Province in which the arbitration is held: but no such applicant or person shall be compelled to answer any question, by his answer to which he might render himself liable to a criminal prosecution:

6. (*f*) The fees for the services of such arbitrators shall be a matter of agreement between the arbitrators and the applicants, and shall be paid by the applicants who name them, respectively, except those of the arbitrator or arbitrators named by the commissioner, which shall be paid by the applicants jointly. 35 V., c. 26, s. 43, *part*.

(*a*) See section 19, Provision was first made for determining as to interfering applications in 7 Geo. IV., c. 5 (1826), by three arbitrators; one to be chosen by each of the parties, and one by the Secretary of the Province. In 1866, there was an Act to amend the Con. Stat., ch. 34 (1859), which contained this provision, and provided that an oath should be taken by the arbitrators, who could summon witnesses to give evidence on oath, and that any wilfully false statement should be deemed a misdemeanour and be punishable in the same manner as wilful and corrupt perjury, and that no witness should be compelled to answer a question so as to lay himself open to a criminal prosecution. The fees of the arbitrators were to be paid by the parties naming, and those of the third arbitrator, named by the Minister of Agriculture, to be paid jointly, so that the general provisions then were the same as now.

The Patent Act of 1872 provided for arbitration by three skilled persons, "One of whom shall be chosen by each of the applicants," etc.; this is put in a less ambiguous shape now.

The patent referred to in this sub-section includes also the specifications and drawings attached to the Letters Patent. Although the arbitrators are to be "skilled persons," the standard of skill is that which placed by the parties appointing them; and as merely a question of fact has to be determined as to the date of the first invention, no very great skill in the art to which the invention may belong appears to be called for.

The phrase "or by the person appointed to perform the duty of that officer" might refer to either the Commissioner or the Deputy Commissioner; the last mentioned is probably the one intended; but how, or by whom this person is to be appointed, does not appear. The Deputy Commissioner, under section 5 of this Act, is appointed by the Governor-in-Council, apparently to perform the duty of the Commissioner and such other duties as are assigned to him; but there is only provision for one Deputy.

No Time Mentioned for Appointment.

No time is mentioned within which the appointment of the arbitrators is to be made by the applicants or of third arbitrator; nor is any provision made for the enlargement of such time.

No Time for Giving Award.

The award has to be in writing, signed by the arbitrators, or a majority of them, but no time is mentioned for making the award, nor for enlarging such time.

No Provision if Case not Decided.

In the event of the arbitrators being unable to decide which applicant was the first inventor, no provision is made; in Great Britain, where the examiner reports that there are two applicants for the same invention, the comptroller may refuse to seal a patent for the second applicant, preference is shown to the earlier applicant: *Vide* sub-section 6, section 7, British Act, 1883. In Austria and Hungary, the first applicant is the true and lawful inventor whether he be the inventor or not. Generally speaking, the earliest applicant has the preference; in Canada, in the event of indecision, there might be some such rule giving preference to the earliest applicant.

Award Final.

Such award by the arbitrators shall be final; and there is no provision made for a review of the award, in the event of improper reception of evidence, corrupting an arbitrator, etc.

Bell Telephone Co., 9 Ont. R., p. 343, on a motion for a writ of *certiorari*, to bring into the Common Pleas Divisional Court all matters, and the decision of the Minister of Agriculture as to voidance of a patent, Cameron, C. J., states: "In the case of interfering applications when a judicial consideration would seem to be called for, etc. The skilled persons appointed as arbitrators act judicially. The machinery is provided for the summoning and swearing of witnesses, and thus they have the full power to inform themselves as to which applicant has the right."

The board of arbitrators are then a judicial tribunal appointed by the Dominion, and Cameron, C. J., intimates "that Provincial Courts created by local Legislatures cannot have inherent power to reverse decisions of Courts created by the Parliament of the Dominion." Provincial Courts then appear to have no power to review the award in any way.

Exchequer Court has Jurisdiction also.

By the Exchequer Court Amendment Act of 1891, sub-sec. (*a*), sec. 4, the Exchequer Court of Canada has also jurisdiction

"in all cases of conflicting applications for any patent of invention or for the registration of any copyright, trade mark or industrial design."

When a case is referred to arbitration, it is usually done at the instance of the Commissioner or Deputy Commissioner, and there is no appeal from the award.

Proceedings in the Exchequer Court, according to the present rules, would be commenced probably by the junior applicant filing a statement of claim and the senior applicant by statement of defence; but no proper rules such as in the United States in "*interference cases*" have yet been formulated; for it is evident that the disclosure of the party filing a statement of claim as to the date of conception of the invention by him, of making drawings, or date of making model or operative device, might have the most serious consequences, enabling a dishonest contestant to "*antedate*" in all respects.

In the United States, the principal object of Rule 116, as to "*interferences*," is to determine the "*burden of proof*," which is on the junior applicant, and to determine the position of parties as plaintiff and defendant: *Vide O'Shaughnessy* v. *Van Depoéle*, C. D., 62 O. G., p. 1063, decided 1893.

Some provision in Canada as to secrecy, until all parties had filed their statements, should be made; such as is the case with "factums" in the Supreme Court of Canada, and there should be no publicity or interchange until all statements are filed.

At present, the provision as to conflicting applications in the Exchequer Court (Can.), is unworkable.

Appeal to Supreme Court (Can.)

By section 8, chapter 26, of "The Exchequer Court Amendment Act, 1891," paragraph lettered (*b*), sub-section 1, of section 52, of 50-51 Vic., c. 16, is repealed, and the following lettered (*b*) is substituted therefor:—

No appeal shall lie from any judgment of the Exchequer Court in any suit, etc., wherein the actual amount in controversy does not exceed the sum or value of $500, unless such action, suit, cause, matter, or other judicial proceeding, etc. * * *

(*b*) "Relates to any fee of office, duty, rent, revenue, or any sum of money payable to Her Majesty, or to any title to lands, tenements, or annual rents, or to any

question affecting any patent of invention, copyright, trade mark, or industrial design, or to any matter or thing where rights in future might be bound."

Appeal to Supreme Court Can. Doubtful.

As this relates to a patent "*in esse*" and not to an "application" for Letters Patent, although the Exchequer Court can entertain questions on "conflicting applications," it is questionable whether under this sub-section (*b*) there is any appeal from its decision to the Supreme Court (Can.) as the law now stands.

Interference—Practice U. S. A.

In the United States, under Rule 94, *interferences* are declared between two or more original conflicting applications. Under Rule 110, each party to the interference will be required to file a concise preliminary statement, under oath, on or before a date to be fixed by the Patent Office, showing the following facts:—

1. The date of the original conception of the invention set forth in the declaration of interference.
2. The date upon which a drawing of the invention was made.
3. The date upon which a model of the invention was made.
4. The date upon which the invention was first disclosed to others.
5. The date of the reduction to practice of the invention.
6. A statement showing the extent of use of the invention.

If a drawing or model has not been made, or if the invention has not been reduced to practice or disclosed to others, or used to any extent, the statement must specifically disclose these facts.

In *Slattery* v. *Shallenburger*, C. D., decided 1893, 62 O. G., p. 1515: An interval of a year and a half after conception of an invention, during which the inventor practically gave up work on his improvement: *Held*, to negatives reasonable diligence.

Reduction to Practice.

Rennyson v. *Merritt*, C. D., decided 1893: *Vide* 63 O. G., p. 151: Where a party to an interference claimed to have reduced to practice early in 1887, and then discontinued the use of his invention for two years, meanwhile applying for two other patents

upon devices of the same general character: *Held*, that such conduct was inconsistent with the supposition that he made a successful reduction to practice at the earlier date.

Statement.

When the invention was made abroad the statements should set forth:—

1. That the applicant made the invention set forth in the declaration of interference.

2. Whether or not the invention was ever patented; if so, when and where, giving the date and number of each patent.

3. Whether or not the invention was ever described in a printed publication; if so, when and where, giving the title, place and date of such publication.

4. Whether or not the invention was ever introduced into this country; if so, giving the circumstances, with the dates connected therewith, which are relied on to establish that fact.

The preliminary statements should be carefully prepared, as the parties will be strictly held in their proofs to the dates set up therein.

The statements must be sealed up before filing, to be opened only by the Examiner of Interferences: (See U. S. Rule 111), and the name of the party filing the title of the case, and the subject of the invention indicated on the envelope. The envelope should contain nothing but the statement.

By U. S. Rule 111, the preliminary statements shall not be opened to the inspection of the opposing party until each one shall have been filed, or the time for such filing with any extension thereof, shall have expired, and not then, unless they have been examined by the proper officer and found to be satisfactory.

Any party in default in filing his preliminary statement shall not have access to the preliminary statement or statements of his opponent or opponents, until he has either filed his statement or waived his right thereto and agreed to stand on his record date.

In certain cases of error arising through inadvertence or mistake, or if defective, the statement may be amended under U. S. Rules, 112–13, but this must be done before testimony is taken.

If a party fail to file a statement, testimony will not be received subsequently from him to prove that he made the invention at a date prior to his application.

By U. S. Rule 116, in original proceedings, inventions will be presumed to have been made in the chronological order in which they filed their completed applications, and the burden of proof will rest on the party who seeks to establish a different state of facts.

Times are assigned for taking testimony after the original statements are in.

And by U. S. Rule 146 parties may appeal to the examiners in chief and to the Commissioner, but no appeal lies from the decision of the Commissioner.

Defeated contestants may, however, have remedy by bill in equity, and appeals must be accompanied by printed briefs.

The foregoing and a number of other salutary rules relating to interfering applications in the States might, in some measure, be adopted by our Exchequer Court. A preliminary statement under the headings indicated ought certainly to be made and filed prior to the hearing of the case; the rules relating to the filing and interchange of factums as in appeals to the Supreme Court (Can.) might be taken as precedents.

In a recent arbitration held under section 19, the arbitrators required the contestants to file each a declaration following the headings enumerated as nearly as possible, which were not opened till the meeting.

The rule by which the burden of proof is cast on the later applicant is a salutary one.

The repeal of the Dominion Act relating to official arbitrators, and the substitution of the Exchequer Court as the tribunal, by sec. 58, c. 16, 50, 51 Vic. (1887), would indicate that the present policy was to do away with arbitrators, as called for under this section 19, and to transfer the jurisdiction to the Exchequer Court. Now we have, in Canada, two courts of concurrent jurisdiction, and no appeal from one, while appeal from the Exchequer Court on a conflicting application is not specially provided for.

In England, under section 7 of the Act of 1883, in conflicting

applications for the same invention, there is an appeal from the decision of the examiner and of the comptroller to the Attorney-General and Solicitor-General of England.

(*b*) See section 19. In this sub-section it is the Commissioner who is to call upon the parties to choose each their arbitrator "the deputy commissioner or the person appointed to perform the duty of that officer" having been left out, "and if there are only two such applicants," these words have been added to the section in the Act of 1872, and are hardly necessary, as only two applicants have heretofore been spoken of, and instead of "the opposite party" in the Act of 1872, we have now "the opposing applicant," which means the party who has chosen an arbitrator at the behest of the Commissioner.

This sub-section is defective in that it limits no time after which refusal to appoint an arbitrator may be presumed, so as to work a forfeiture.

When there are Three or More Conflicting Applications.

(*c*) See section 19. Why the Commissioner or Deputy Commissioner, etc., should not, in the case of three or more conflicting applications, still retain the power of appointing one of the arbitrators, is not easily seen; leaving the matter altogether to the parties themselves, makes way for collusion.

Oath.

(*d*) See section 19. Nothing is said as to what shall be done with the oath subscribed and taken with the formalities designated; it is presumed that it is written out in triplicate, signed by the arbitrators and Judge, respectively, and attached to the proceedings in some manner; although, the award, of which no special form is indicated, is alone required to be delivered, in writing, to the Commissioner, signed by the arbitrators or any two of them.

(*e*) See section 19. A notification to the applicants under the hand of the arbitrators, or any one of them, after having been sworn, of the time and place of holding the arbitration, would be all that would be necessary—it would be for the applicants to determine what witnesses they may desire to bring or summon, if necessary, so as to present their respective cases in the best aspect possible;

the arbitrators might, but hardly would take the initiative in summoning witnesses. If the applicants do not know the witnesses, documents, etc., which shall be produced, it is not likely the arbitrators will.

In *Smith Co.* v. *Greey*, 11 Prac. Rep. Ont., p. 345: The fact that there was then pending against plaintiffs' president, at the instance of a stranger to the action, proceedings for perjury, which might affect some point in controversy; though it might be a reason for his refusing to answer any question on this point, was not a reason for refusing to attend on the examination.

Who May Administer Oath.

The oath may be a solemn declaration or affirmation: *Vide* sub-section 5 of this section and paragraph 28 of section 7 Interpretation Act; and by paragraph 28, section 7: The arbitrators named, a Judge of any Court, a notary public, a justice of the peace or a Commissioner, may administer such oath, and certify as to its having been made and administered.

Fees.

(*f*) There is no tariff of fees; $25 per diem and travelling expenses (if any) is not unusual, unless there be exceptional circumstances.

The arbitrator named by the Commissioner is the arbitrator referred to under (*a*) section 19, and "the arbitrators," when the whole three are appointed, as under Note (*c*), section 19.

The arbitrator or arbitrators appointed by the Deputy Commissioner, or by the person appointed to perform the duty of that officer, should also have been referred to, the omission is merely an oversight.

Filing Protest.

Under Rule 11 of the Patent Office (Canada), the filing of a protest against the issuing of a patent shall not be taken in itself as sufficient reason to withhold the granting of a patent to an applicant. If another claims to be the inventor he shall proceed to file his application, and proceedings may be taken under this section to determine the priority of right to the patent.

There is nothing to indicate in this Rule 11, that a well-founded protest will not receive attention.

Rival Applicants.

In *The Queen* v. *La Force*, Can. L. T., vol. 14, p. 27, decided in the Exchequer Court, Canada, by Mr. Justice Burbidge, in January, 1894, to be reported in full in 4 Exch. Ct. R., Can., in speaking of conflicting applications he states:—

"In the case of conflicting applications, the Crown has not parted with its power to make a grant, and there is provision for the appointment of arbitrators to decide between the applicants. In such a controversy it seems to me, *that the first applicant if he be a true inventor, and the first to make known his invention to the public*, should be preferred. If there is any doubt as to that being the law at present, or if it is not the law, I venture to hope that the doubt may be removed and the law changed; for not only is the rule a just one, as it gives the reward to the person *who first communicates a knowledge of the invention to the public*, but it is a convenient one in respect of the proof by which under it any question of priority may be determined."

NOTE.—It may be remarked that Mr. Justice Burbidge, when he wrote this, read section 47 of the Patent Act as meaning that pending applications in the Patent Office, Canada, were open to public inspection. This is not the practice: See also Rule 15, Patent Office, Can., Appx. 1.

Abandoned applications even are not open to public inspection in U. S. A.: See *Ex parte Wyckoff*, 60 O. G., p. 1104 (1892); nor in England: See British Act, 1885, sec. 4.

PART VI.

GRANT AND DURATION OF PATENTS.

20.—(*a*) Every patent granted under this Act shall contain the title or name of the invention, with a reference to the specification, and shall grant to the patentee and his legal representatives, for the term therein mentioned, from the granting of the same, the exclusive right, privilege and liberty of making, constructing and using, and vending to others to be used, the said invention, subject to adjudication in respect thereof before any court of competent jurisdiction:

2. (*b*) In cases of joint applications, the patents shall be granted in the names of all the applicants. 35 V., c. 26, s. 10, *part*, and s. 16;—36 V., c. 44, s. 5.

Title or Name.

NOTE.—(*a*) The title or name of the invention is given by the applicant in Canada, whereas in the States the title or name is inserted in the Patent Office at Washington; in Great Britain, it is of some moment to have the title defined so that it may agree with the invention, otherwise as we have seen (*Vide* p. 96) that there may be some danger of the patent being voided.

In England, the specification does not form part of the patent, so as to control its construction; but the rights of the inventor are made to depend on the description of his invention inserted in the title of the patent and cannot be helped by the specification, the office of which is to describe the mode of using, constructing or compounding the invention mentioned in the patent: *Vide* Curtis, 4th ed., sec. 221.

A duplicate copy of the specification is attached to Canadian Letters Patent and is made an essential part thereof, as well as the drawings, which, on their face, are certified to be the drawings referred to in the specifications.

By section 22, the term of a Canadian patent is now eighteen years.

The grant, on its face, was conditional as to manufacture and importation, as provided in the 37th section of the Patent Act, and sections 22 and 37 of the Act used to be set out on the last page of the patent in full; but now, with the new form, since the Act of 1892, the grant is made subject to the conditions of the Patent Act, 61 R. S. C., and the Acts amending the same, which covers manufacture and importation under the 37th section, although the attention of the patentee is not now specially directed thereto.

Exclusive Right.

"The exclusive right, privilege and liberty of making, constructing and using and vending to others to be used" in the Dominion of Canada, the said invention, etc., is not really an "*exclusive right*" for more than two years, as we shall see under section 37 of this Act; and, is not exclusive even for two years, for under section 44, the Government of Canada may, at any time, use any patented invention on paying

to the patentee such amount as the Commissioner deems proper. Nothing is said here about granting licenses, which is an inherent right of a patentee. The words at the beginning of this paragraph first occur in the Provincial Act of 1826, 7 Geo. IV., c. 5.

In the United States a patent right may be more appropriately deemed an exclusive property, for there is no obligation there to manufacture, as in Canada, or to license to use.

The Government of the United States may make and use a patented article, but not without the license of the patentee: *Cammeyer* v. *Newton*, 94 U. S., 234 (1876); *McKeever* v. *United States*, 23 O. G., 1527 (1879).

A British Patent Binding as Against the Government.

By 27 British Patent Act, 1883, a patent has the same binding effect as against the Queen, her heirs and successors, as it has against a subject.

But the invention may be used for the service of the Crown on terms, to be before or after the use thereof agreed on, or on terms settled by the Treasury. This is an important change in the law in Great Britain.

In 1865 it was held that the Crown might use a patented invention, without the assent of and without remuneration to the patentee, on the ground that the grant of a patent was simply an exercise of the prerogative: *Vide Feather* v. *The Queen*, 35 L. J., Q. B., 200.

By section 44, Act of 1883, the inventor of improvements in munitions of war may assign to the Secretary of State for War, and if the Secretary of State certifies, such invention shall be kept secret.

In England there are **Compulsory Licenses,** under section 22 of the Act of 1883; the terms and conditions, as to royalties, are regulated by the Board of Trade, from whose judicial decision there is no appeal. If the Board of Trade acts improperly it is apprehended they are subject to mandamus: *Vide* Tapping, on Mandamus, c. 3.

Courts.

The Courts of competent jurisdiction before which a patent may be adjudicated are the Courts of record of the various Provinces and the Exchequer Court of Canada.

By 53 Vic., c. 13 (1890), "An Act to amend the Patent Act," the Exchequer Court obtained jurisdiction in the matter of the repeal of Letters Patent by "*sci. fa.*"

And by 54, 55 Vic. (1891), c. 26, "An Act to amend the Exchequer Court Act," the Exchequer Court obtained jurisdiction in all cases of conflicting applications, for any patents of invention, or the registration of any copyright, trade mark, or industrial design, etc.; (*b*) in all cases in which it is sought to impeach or annul any patent of invention, etc.; (*c*) in all cases in which a remedy is sought respecting the infringement of any patent of invention, copyright, trade mark, or industrial design.

In the Exchequer Court you obtain the advantage of being able to proceed with respect to infringements in any part of the Dominion, and you can issue execution to any part of the Dominion of Canada; whereas in the Provincial Courts you are confined to the Province in which the suit has been instituted.

If Partial Fee Paid.

If a partial fee only be paid for six years, as is usually the case, there is a notification that the patent shall cease unless at or before the expiration of the said term the holder thereof pay the fee required for the further term or terms.

(*b*) Under note "a" to section 7, we have already shown that where there are joint patentees, in the absence of special contract, each can deal with the patent as if he were sole owner, without being liable to account to his co-patentees therefor.

21.—(*a*) Every patent shall be issued under the seal of the Patent Office and the signature of the commissioner or of the deputy commissioner, and when duly registered, shall be good, and shall avail the grantee and his legal representatives for the term mentioned in the patent: 35 V., c. 26, s. 6, *part, and* s. 18, Patent Act (1886), 56 V., c. 34, s. 2.

2. (*b*) The commissioner may require that any patent, before it is signed by the commissioner or by any other member of the Queen's Privy Council for Canada, acting for him, and before the seal hereinbefore mentioned is affixed to it, shall be examined by the Minister of Justice; and if such examination is so required, the Minister of Justice shall, accordingly, examine it, and if he finds it conformable to law, he shall certify accordingly, and such patent may then be signed, and the seal affixed thereto. 35 V., c. 26, s. 6, *part, and* s. 18.

(*a*) See section 21. By section 2, chapter 34, 56 Vic. (1893), sub-sec. 1, of sec. 21, of the Patent Act, was repealed, and the foregoing sub-section 1 enacted; whereby the words "or of the deputy commissioner" were substituted for "or of some other member of the Queen's Privy Council acting for him," of the Patent Act.

So that the effect of this sub-section 1, as it now stands, is to substitute the Deputy Commissioner for a member of the Privy Council; the only parties now entitled to sign patents being the Commissioner or the Deputy Commissioner who have co-ordinate power.

Before this new sub-section came into force (April 1st, 1893), it was usual for the Commissioner of Patents, who is also the Minister of Agriculture, to sign the patents which were countersigned by the Deputy Commissioner who is the executive officer.

The seal of the Patent Office being affixed and the patent registered, the patent is deemed duly issued, and is sent to the patentee or his agent.

The term legal representatives means "executors, administrators, and assigns."

In the U. S., section 4883 R. S., as amended by the Act of 1888: All patents are issued under the seal of the Patent Office, and shall be signed by the Secretary of the Interior or under his direction by one of the Assistant Secretaries of the Interior.

(*b*) See section 21. Under what circumstances the Commissioner may require the Minister of Justice to examine a patent so as to certify that it is conformable to law, before the patent is issued, does not appear; the Commissioner may presumably require the opinion of the Minister of Justice on cases arising under section 16 of this Act, already discussed :—

On a question whether the specification and drawings does or does not sufficiently describe and claim a certain invention, one would suppose that the examiners in the Patent Office, and those skilled in the art to which the invention pertains, would be better able to express an opinion than the Minister of Justice.

In this sub-section 2, the singular mistake has occurred of leaving in it the words, "any other member of the Queen's Privy Council for Canada, acting for him," and failing to substitute therefor the Deputy

Commissioner; it should also be so amended that either the Commissioner or the Deputy Commissioner may make the requisition on the Minister of Justice alluded to in this sub-section 2.

As it now stands, this sub-section 2 remains intact, and is inconsistent with sub-section 1, which has been amended as indicated.

Patent Issued to a Dead Applicant.

A patent issued in the name of an applicant who died while his application was pending and before issue has been held void for want of a grantee: *De la Vergne Refrigerating Machine Co.* v. *Featherstone* (1892), 58 O. G., p. 1842: See also *Galloway* v. *Findlay*, 12 Pet., 264; but these cases have been overruled in the Sup. Ct., U. S., on appeal in *De la Vergne Refrigerating Machine Co.* v. *Featherstone*, 147 U. S. Rep., p. 209 (decided January 9th, 1893); the decision is to the effect, that a patent for an invention issued to the inventor "*his heirs or assigns*" after his death, is a valid patent, and should be construed in the alternative as a grant to "*him or his heirs or assigns.*" So that on filing a certified copy of the probate of the will, or of letters of administration (if from Canada, legalized by the U. S. Consul), the title would enure to and become vested in the personal representative. In the above judgment Fuller, C. J., said: "If the patent had issued to Boyle, when living, although an assignment of his entire interest had been recorded before the patent issued, the patent would have enured to the benefit of the assignee, and it is difficult to see why, if Boyle died prior to the issue of the patent, and after he had made the application and assigned his interest, the assignee should lose the benefit of the assignment because of the death."

We have no rule to meet a case of this kind; what might be done would be to file probate of the will or letters of administration, when the Commissioner would possibly grant a re-issued patent in the name of the executor or personal representative, or person entitled to the patent issued erroneously in the name of the dead person, on the original patent being surrendered and cancelled; or the patent might be read as in the U. S. Sup. Ct. case. We should have a rule to meet a case of this kind.

In the House of Congress, U. S., a bill (No. 1985) was introduced September 9th, 1893, to give effect to patents issued in the

names of deceased persons; it provides that when a patent has been issued to a person who shall have died before the date of the patent, such patent shall not be deemed invalid by reason of such decease, but the title thereto shall enure to and become vested in the executors or administrators of the deceased in the same manner as if issued direct to them; since the above Sup. Ct. (U. S.) decision this bill may not be deemed necessary.

22. The term limited for the duration of every patent of invention issued by the Patent Office shall be eighteen years; but at the time of the application therefor it shall be at the option of the applicant to pay the full fee required for the term of eighteen years, or the partial fee required for the term of six years, or the partial fee required for the term of twelve years: 46 V., c. 19, s. 1, Patent Act (1886); 55, 56 V., c. 24, s. 5 (1892).

2. If a partial fee only is paid, the proportion of the fee paid shall be stated in the patent, and the patent shall, notwithstanding anything therein or in this Act contained, cease at the end of the term for which the partial fee has been paid, unless before the expiration of the said term the holder of the patent pays the fee required for the further term of six or twelve years, and obtains from the Patent Office a certificate of such payment in the form which is, from time to time, adopted, which certificate shall be attached to and refer to the patent, and shall be under the signature of the commissioner, or of the deputy commissioner: 46 V., c. 19, s. 1, Patent Act (1886); 55, 56 V., c. 24, s. 5; 56 V., c. 34, s. 3.

3. If such second payment, together with the first payment, makes up only the fee required for twelve years, then the patent shall, notwithstanding anything therein or in this Act contained, cease at the end of the term of twelve years, unless at or before the expiration of such term the holder thereof pays the further fee required for the remaining six years, making up the full term of eighteen years, and obtains a like certificate in respect thereof: 46 V., c. 19, s. 1, The Patent Act (1886); 55–56 V., c. 24, s. 5.

Eighteen Year Patents.

NOTE.—By section 5, of 55-56 Vic., c. 24 (1892), section 22 of The Patent Act, was repealed, and the foregoing sub-sections 1 and 3 substituted; and by section 3, of 56 Vic., c. 34 (1893), sub-section 2, of the said Act of 1892, was also repealed, and the foregoing sub-section 2, was substituted; the change from the provision in the Act of 1892, in this sub-section 2, being, that the words "at or before the expiration" now read "before the expiration," so that the further fee must now be paid before the expiration of

the term; the words "or the signature of any other member of the Queen's Privy Council for Canada acting for him," were struck out, and "or of the deputy commissioner" at the end of sub-section 2 substituted, so that the certificate may now be signed by the Commissioner or Deputy Commissioner.

By this section, Canadian patents were, for the first time, extended to eighteen years.

In Upper and Lower Canada, patents were originally granted for a period of fourteen years; the same was the case in New Brunswick and Nova Scotia. In Canada, by the Patent Act of 1869, the period was extended to fifteen years, and this continued to be the case until the Patent Act Amendment, 1892, when all patents issued after the 9th July, 1892, are for eighteen years.

Under note (*d*), section 8, the effect of a prior issue of a foreign patent has been discussed, and the length for which British and foreign patents are granted is enumerated.

There is nothing to be gained by paying the full fee for eighteen years at the time of application; the one-third fee for six years ($20) is usually paid in. If the full fee ($60) be paid at application, under Rule 9 of the Patent Office, should the application be deemed abandoned, all fees paid in would be held forfeited.

The Act of 1872 was defective, in that it provided (*Vide* section 17) that patents should be valid for five, ten or fifteen years, at the option of the applicant; but at or before the expiration of five or ten years, the holder might obtain an extension.

By 46 Vic. (Can.), c. 19 (1883), this provision was repealed, and patents were issued for fifteen years, but partial fees might be paid, but in such case the patent was to lapse at the end of five or ten years, unless the remainder of the fee is paid; and it was declared that every patent theretofore issued, in respect of which the fee required for the whole or any unexpired portion of the term of fifteen years has been duly paid, shall be deemed to have been issued for fifteen years, etc.: See further note to section 58.

In the United States a fee of $15 is payable on filing the applications, and a further fee of $20 when allowed—if not paid

within six months of the date of allowance—the first fee becomes forfeited and a new fee of $15 has to be paid.

The U. S. Act of March 2, 1861, abolished extensions of patents, and made the term of patents seventeen years, instead of fourteen years.

The U. S. Act of 1836 is the foundation of the existing law in the States, by it the Patent Office and the office of Commissioner of Patents was created, and patents were granted for fourteen years, extensible, conditionally, for seven years more.

The Acts (U. S.) subsequent to that of 1861 are codifications of it as modified by the decisions of the Courts.

Months Mean Calendar Months.

Ex parte Brown, C. D., decided 1890, 63 O. G., p. 759 (1893). The time for payment of the final fee in the United States has, time out of mind, been construed to be six calendar months from the date of allowance. The Commissioner has no doubt the practice is a legal and valid one: *Sheets* v. *Shelden's Lessee*, 2 Wall., 177; *United States* v. *The Ship Recorder*, 1 Blatch., 218.

We have before noted that Walker, sec. 125, holds that the months mean "lunar" months, giving reasons for holding, that if the patent were issued on a final fee paid more than six months after allowance, the patent would be void for want of jurisdiction, this decision completely upsets Walker's view. Whether month means a lunar or calendar month, when not covered by Act of Interpretation: See *Hart* v. *Middleton*, 2 Car. & Kir., 9. In legal matters a "month" means a "lunar month," in commercial matters a "calendar month": *Hutton* v. *Brown*, 45 L. T. N. S. (1881). By Interpretation Act (D.) "month" means "calendar month."

If a partial fee only is paid in the first instance, it appears on the face of the patent; and if there be a subsequent renewal, the original patent should be sent to Ottawa, in order that the renewal certificate mentioned in sub-section 2 be attached to the patent.

Great care must be taken, that the patent be not allowed to expire by non-payment of the fee in time; the rule is rigorous, and is relentlessly enforced.

By 54, 55 Vic., c. 131, Can. (1891), a special Act was passed for the relief of Jay S. Corbin, whose patent for "*improvements in combined harrows and seeders*," was inadvertently allowed to expire after the first five years, the renewal fee not having been tendered till nearly a week too late, when the Commissioner could not accept the fee and grant the renewal certificate.

This Act, which was exceptional in its nature, authorized the Commissioner to receive the renewal fee and renew the patent; but any rights acquired by third persons by assignment, user, manufacture or otherwise between the date of expiry and the renewal under the special Act, were preserved.

A number of patents are allowed to lapse every year, many through inadvertence, one cannot rely on being able to obtain a private Act to renew them.

Patent solicitors in Canada are in the habit of sending out circulars to patentees as to renewal of patents about to expire, both by way of advertisement and to earn a fee; but it is not safe to rely on this; patentees should know enough to look after their own interests in this respect.

Some provision should be made, whereby, on a payment of a fine, as in Great Britain and many foreign countries, enlargement of the time for paying renewal fees, within a period of one to three months, might be attainable.

The fees in England on enlargement of time for paying the annual Government fee are, if not exceeding one month, £3; not exceeding two months, £7; not exceeding three months, £10. Taxes in foreign countries are usually paid yearly in advance.

Countries in which there is no Prolongation of Time to Pay Taxes.

In Austria and Hungary, no extension of time for payment taxes is permissible, nor in British Guiana, nor Brazil, nor British Honduras, nor Cape Colony, nor in France, nor Gautemala, nor Leeward Islands, nor Natal, nor South Australia, nor Spain, nor Tasmania, nor Uruguay.

Countries in which Prolongation of Time to Pay Taxes is Allowable.

In Belgium, there is one month's grace without fine for the making payment, or six months' grace with a fine of ten francs ($2).

In the German Empire, three months grace is allowed for these payments without fine; no further prolongation is obtainable.

In India, an extension of time to pay taxes, which are payable yearly in advance at the end of fourth year, is obtainable for three months, at most, on payment of a fine.

In Italy, three months grace is allowed without fine within which to pay taxes.

In Luxembourg, three months grace allowed without fine; no further prolongation.

In New Zealand, an extension of time not exceeding three months, obtainable on payment of £4.

In Norway, three months grace, together with a fine of one-fifth of the tax payable; the same rule applies in Sweden.

Orange Free State, an extension of time not exceeding three months, and a fine of £5; also in South African Republic (Transvaal).

Queensland, an extension of time not exceeding three months.

Switzerland, three months' grace allowed without fine; no further prolongation.

Victoria, an extension of time not exceeding six months, with statutory declaration setting out the grounds, and a fine of 15*s*. ($3.75) for each month of such extension.

PART VII.

Reissue of Patents.

23. Whenever any patent is deemed defective or inoperative by reason of insufficient description or specification (*a*), or by reason of the patentee claiming more than he had a right to claim as new, but at the same time it appears that the error arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention (*b*), the commissioner may, upon the surrender of such patent

and the payment of the further fee hereinafter provided, cause a new patent, in accordance with an amended description and specification made by such patentee, to be issued to him for the same invention for any part or for the whole of the then unexpired residue of the term for which the original patent was, or might have been granted (*c*) :

2. In the event of the death of the original patentee or of his having assigned the patent, a like right shall vest in his assignee or his legal representatives (*d*) :

3. Such new patent, and the amended description and specification, shall have the same effect in law, on the trial of any action thereafter commenced for any cause subsequently accruing, as if the same had been originally filed in such corrected form before the issue of the original patent (*e*) :

4. The commissioner may entertain separate applications, and cause patents to be issued for distinct and separate parts of the invention patented, upon payment of the fee for a reissue for each of such reissued patents. 35 V., c. 26, s. 19 ;—38 V., c. 14, s. 1.

NOTE.—This section 23 and its sub-sections follow the provisions of section 4916, R. S. U. S., the wording being somewhat altered; but, unlike our section, the U. S. section provides: "But no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioners that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid." *Vide* also Patterson, J., on p. 468, 10 App. Rep. (Ont.), in *Hunter* v. *Carrick*, as to the similarity with the U. S. Act, and as to treating the U. S. judgments as laying down rules we should follow.

Rule 14, Patent Office (Can.).

Although these provisions do not appear in our Act, yet Rule 14 of the Patent Office provides that, "in the matter of a reissue, whatever is really embraced in the original application and so described or shown in the same, that it might have been embraced in the original patent may be ground for a reissue. No new matter can be introduced into the specifications, nor can the models or drawings be amended except each by the other. In the absence of model or drawings, the reissue may contain amendments upon satisfactory proof to the commissioner that such amendments were part of the invention, although omitted in the original application, etc."

This covers the same ground as the extra matter contained in the U. S. Act. So between our section and the above quoted

Canada Patent Office Rule 14, we have practically the same provisions for reissue as in the States. If the specification describes the invention as shown in the drawing, and the drawing contradicts the model, a reissue cannot be granted for a feature shown in the model, but proved by the drawing not to be a part of the invention: *Re Hunt*, 15 O. G., p. 831.

In *Flower* v. *City of Detroit*, Sup. Ct., U. S., decided October, 1887, 18 Brodix, p. 621, the rule in *Parker & Whipple Co.* v. *Yale Clock Co.*, 123 U. S. (1887), 17 Brodix, 194, was affirmed, viz.: "That the Patent Office model alone is not to be considered the basis of a reissue, in which a change of the invention of the original patent is sought."

The same rules would probably apply in Canada, although Patent Office models are now rarely filed; if the drawings agree with the models, the case might possibly be different.

(*a*) The word "defective" and the word "inoperative" are possibly synonymous, both indicate something lacking; if a description be obscurely worded it may convey a wrong impression and is defective; again, parts may be omitted altogether in the description which would render the device unworkable or inoperative; the patent may also be defective (although the description may be complete), on account of a claim or claims being omitted, the claims may be nebulous and cover the whole invention imperfectly, being liable to be misunderstood, or they may be too narrow for the invention and therefore defective, or they may be too broad; then, as the claims are the only operative parts of a specification, serious difficulties may arise, if corrections be not promptly made: *Eames* v. *Andrews*, Sup. Ct., U. S., 17 Brodix, p. 98 (May, 1887).

If, in the reissue, the scope of the original is so enlarged as to cover and claim as a new invention, that which was not in the original specification, as a part of the invention described, or if described, was by reason of not being claimed, virtually abandoned and dedicated to public use, the reissue is unauthorized: *Eames* v. *Andrews*, *supra*, p. 126.

Or again, all reference whatever may be omitted in the specifications, claims and drawings to an integral, distinct and necessary part of the invention, in which case, the patent and specifi-

cations which form an essential part thereof, would be defective and bad. A question may arise whether a matter described but not claimed may not be deemed abandoned to the public.

In *Barter* v. *Howland*, 26 Grant, p. 135, though not exactly in point, when the plaintiff had more than one year previous to his application for a patent in Canada, obtained a patent in the U. S., disclosing the same invention though not containing all the claims contained in the Canadian patent. *Held*, that such foreign patent amounted to a publication of the whole invention in the United States and imported a disclaimer of all parts not claimed in the foreign patent.

The law, however, is averse to forfeitures, and unless there be laches, or if express evidence of actual intention to abandon and dedicate to the public be lacking, it is conceived that possibly a claim or claims may now be added, in a reissue for matter previously described and not claimed in the original patent; it is usual in Canada to make such reissues, and hitherto they have not been questioned, and this was the view taken by the Chancery Division Court in *Withrow* v. *Malcolm*, 6 Ont. R., 12, and indeed appears to be covered by the first part of Pat. Off. Rule 14, just quoted. The description of the part in the original patent, without claiming it, will not constitute an abandonment of it to the public so as to prevent him from claiming it in the reissue: *Batten* v. *Taggert*, 17 How., 74.

The decision in *Barter* v. *Howland*, would appear to indicate, that had the Canadian patent been applied for in time, there might not be a reissue in Canada for that which had been described, but not claimed in the foreign patent; this question of reissue was, however, not then under discussion and we have no judicial decisions exactly bearing on this point.

The word "specification" when used without the word "claim," means both "description and claim," therefore, a reissue is allowed when the specification is defective or insufficient in regard to either the description or claim, or both: *Wilson* v. *Coon*, 18 Blatch., 532; *Smith* v. *Merriam*, 6 Fed. Rep., 713; *vide* Bump, 2nd ed., p. 240.

Should it be held that the matter was previously undescribed

and new, and therefore not subject matter for reissue, but for a new application; it might then turn out, that the omitted matter having been in public use or on sale in connection with that which was described in the patent, for more than one year previous to application, could not form, under section 7, subject matter for a patent.

This was actually held to be the case in *Hunter* v. *Carrick*, 28 Grant (Ont.), 1881, when it was held, Proudfoot, J., "That the last four claims being for what was new, the first patent could not be inoperative as to them, and the second patent as to these must be construed as an independent one issuing the first time on its date, and as all other than the first combination had been used for upwards of a year prior to the patent, he was not entitled to a patent therefor," *i.e.*, for the last four claims.

This seems rather inconsistent, for the same reasoning should have applied to the first combination, which was also new—"a door situated above the grate" having been added; yet this claim was held infringed and the proper subject of a reissue, although it had been in use for upwards of a year prior to the reissued patent.

In the United States, the statutory provision which makes a patent void if the invention it covers was in public use or on sale for more than two years before the patent was applied for does not apply to reissue patents: *Shaw* v. *Lead Co.*, 11 Fed. Rep., 714 (1882). The reissued application is considered appended to the original application, and the two years during which public use or sale may take place prior to the application cease to run with the filing of the latter: *Grant* v. *Raymond*, 6 Peters, 218 (1832).

In *Withrow* v. *Malcolm*, 6 Ont. R., p. 12, Ch. Divl. Ct., an action on a reissued patent, it was objected that the reissued patent contained a combination claim not in the original, but was shown in the drawings and specifications of the original patent, but through mistake and inadvertence was not separated from the other parts and made the subject of a distinct claim. *Held*, per Boyd, C., affirming Ferguson, J., that the reissue was valid; Proudfoot, J., dissenting.

Headnote in Withrow v. Malcolm, 6 Ont. R., p. 12.

"What could have been claimed under the specification and description of the original patent, but was not by error, accident, mistake, or inadvertence, may be claimed on a reissue, if there had been no laches.

"Not what patentee claims but what is first disclosed on his application is the measure of his rights on a reissue."

This case would then indicate that a claim may be added for that which had been previously described in the original patent, and that unless there be some disclosure on the original application, no rights exist for a reissue; and that the lapse of about a year between the original and reissued patents was not so great a delay as to prejudice the inventor.

The American Act expressly states that no new matter shall be introduced, although the Commissioner may grant reissue on proof that the omitted part was part of the original invention. Our Act merely states that the reissue shall be for the same invention; but our Patent Office Rule 14, besides stating that no new matter shall be introduced, authorizes the Commissioner to grant reissues on proof in the same way as in the States.

In *Eames* v. *Andrews*, Sup. Ct., U. S., (decided May 23rd, 1887), 39 O. G., p. 1319, "The driven well case."

Held, that where matters found only in the reissued patent, or matters where a change has been made from that described in the original patent occur, if the addition and changes do not, in fact, amount to different invention, the case is one simply of a defective specification, and a proper subject of amendment.

Reissue With Broadened Claims.

Cobbin Cabinet Lock Co. v. *Eagle Lock Co.*, Sup. Ct., U. S., (decided October 30th, 1893), 65 O. G., p. 1066.

It is settled by authorities that to warrant new or broader claims in a reissue, such claims must not only be indicated in the original application, but it must further appear, (1) that they constituted part of the original invention, and (2) were sought and intended to be covered or secured by the original patent: *Bantz* v. *Frantz*, 105 U. S., 160; *Heald* v. *Rice*, 104 U. S., 737; *Miller* v. *Brass Co.*, 104 U. S., 350; *Topliff* v. *Topliff*, 145 U. S., 156.

There cannot be a reissue for that which has been expressly disclaimed in the original patent: *Beecher Manufacturing Co.* v. *Atwater Manufacturing Co.*, 16 Brodix, 106.

(*b*) Should a patentee desire to obtain a reissue, by reason of claiming more than he had a right to claim as new, and thus to narrow his claim or claims, application may be made regardless of the age of the patent: *Vide Matthew* v. *Flower*, 25 Fed. Rep., 134 (1885).

Lapse of time may be of small consequence on an application for the reissue of a patent on account of a defective specification or description, or where the original claim is too broad: *Vide Mahn* v. *Harwood*, Sup. Ct., U. S. (decided November 3rd, 1884), 15 Brodix, 339–40, 112 U. S.

Where a patentee claims more than he has a right to claim, instead of having the patent reissued, it will be less expensive, and more desirable in many respects to disclaim under section 24, as often may be done.

It is only with broadened reissues that the element of age may become material. In the United States *Miller* v. *Brass Co.*, 104 U. S., 350 (1881), 13 Brodix, 303, introduced a new doctrine into the patent law, which has been recognized in our Canadian Courts; in that case it was established, that the right to obtain a broadened reissue was lost by a long lapse of time after the date of the original and before the application for that reissue; in that case, the fatal lapse of time begins to run from the date of the original patent. In *Miller* v. *Brass Co.*, the delay had continued for fifteen years.

In *Mahn* v. *Harwood*, 112 U. S., 354, Sup. Ct., the principles enunciated in *Miller* v. *Brass Co.*, were affirmed, and the Court stated that there are substantial reasons why a claim cannot be enlarged and made broader after an undue lapse of time. "The rights of the public here intervene, which are totally inconsistent with such tardy reissues, and the great opportunity and temptation to commit fraud, after any considerable lapse of time, when the circumstances of the original application have passed out of mind, and monopoly has proved to be of great value, make it imperative on the Courts as a dictate of justice and public policy to hold the patentees strictly to the rule of reasonable diligence in making applications for this kind of reissues." In this case a delay of nearly four years was deemed fatal to the reissue.

And the Supreme Court also held (*vide* p. 343, 15 Brodix, *S. C.*) that no invariable rule can be laid down as to what is a reasonable time within which the patentee must seek for the correction of a claim which he considers too narrow. "It is for the Court to judge in each case, and it will exercise proper liberality towards the patentee. But as the law charges him with notice of what his patent contains, he will be held to reasonable diligence. By analogy to the rule as to the effect of public use before an application for a patent (in U. S.) a delay of more than two years would, in general, require special circumstances for its excuse."

Should the same analogy prevail in Canada, a delay of more than one year would require special excuse.

Whiteley v. *Gowdey*, Ferguson, J. (decided 16th May, 1885), Can. L. T., vol. 5, p. 327; Can. L. J., vol. 21, p. 260. Where, in a reissued patent, a claim constituting a new feature was introduced, a thing which was not in the original patent or contemplated at all by the then inventor, and which was of substantial importance and practical utility, and amounted to an invention, and it did not appear to be a correction of a mistake or a thing arising by reason of accident or inadvertence: *Held*, that the claim in the reissue was invalid.

Held, also, that a reissue cannot contain matter of invention which, with regard to the original, is new, as a broadening of the invention, although it may, under proper circumstances, contain a broadening of a specific claim made.

Where, in a reissue, the claim was identical with that in the original patent, but contained the words "substantially as shown and described," and the reissue contained in the specifications certain additions which read with reference to the claim indicated something different from that claimed in the original patent, and it did not appear that this change could be said to be made to correct a mistake or by reason of accident or inadvertence: *Held*, that the claim in the reissue patent could not be sustained, and was invalid.

Where the original patent to D. Maxwell was dated 4th January, 1878 (not 6th December, 1877, as in Report), and the reissue, No. 12452, 7th March, 1881, and it appears that the attention of the patentee must have been called to the scope of the patent as early as 7th March, 1879, by reason of a disclaimer of

that date; that a second patent to D. Maxwell was originally dated 14th November, 1876, and the reissue, No. 12512, 17th March, 1881, and that there was also a disclaimer, 7th March, 1879, also calling attention; that a third patent to C. C. Brayley was originally dated 28th September, 1876 (not 1879, as in Report), and the reissue, No. 11469, 10th July, 1880, and during this interval the patentee's attention had also been drawn to the defects of his patent, and that in the reissues there had been the introduction of new invention and an enlarging of the scope of the patent and a broadening of the claim.

Held, that the rule of laches must be strictly applied, and the delay being unaccounted for, the reissues were invalid at all events to the claims of the reissues which constituted a broadening and enlargement of the claims in the original patent.

NOTE.—In the first instance, the delay was over three years and one month; in the second instance, nearly four years and four months; and in the third instance, nearly three years and nine months, after the date of the original patents.

In *Woolensak* v. *Sargent & Co.* (decided January 4th, 1894), Sup. Ct., U. S., 66 O. G., p. 1007, a delay of eight years, by advice of solicitor, was held not excusable and fatal: *Dobson* v. *Lees*, 137 U. S., 258, cited.

In *Cornell* v. *Weidner*, Sup. Ct., U. S. (decided April 30th, 1888), 18 Brodix, p. 549, is a case of a reissue of a reissue; the second reissue was obtained nearly seven years after the original reissue, the first reissue being a bushing for bungs having a notch; the second reissue being without any such notch, was held as an unwarrantable enlargement.

In *Kidder* v. *Smart et al.*, 8 Ont. R., p. 362 (decided February 21st, 1884), application for a broadened reissue of a patent for Kidder's sliding door, in which the hanger, a very material part, was not fully described and claimed; it was held by Ferguson, J., that the delay (without any excuse) for a period of over one year and nine months after full knowledge of the inadvertence and mistake in the original patent, and after professional advice, and after a reissue of the same patent in United States, founded on the same alleged inadvertence and mistake (during which

period manufacture had been carried on in the United States under a reissue there) before the application for a reissue in this country, is fatal to the validity of reissue here.

The reissue in Canada was not applied for, for more than two years from the date of the original patent.

A number of cases are referred to in *Withrow* v. *Malcolm*, 6 Ont. R., 12, in which reissued patents have been held good, notwithstanding the lapse of a number of years after the issue of the original patent, and before the application for the reissue. One case in Bump., 2nd ed., p. 242, is mentioned, in which sixteen years elapsed: *Hussey* v. *Bradley*, 2 Fish., 362, but it does not appear that these long periods elapsed after the discovery of the alleged mistake, and before the application for reissue. And Ferguson, J., cited *Miller* v. *Brass Co.*, 104 U. S., p. 350, *supra*, in which Mr. Justice Bradley says: "But in reference to reissues made for the purpose of enlarging the scope of the patent, the rule of laches should be strictly applied, and no one should be relieved who has slept upon his rights, and has thus lead the public to rely upon the implied disclaimer involved in the terms of the original patent; and when this is a matter apparent on the face of the instrument, upon a mere companion of the original patent with the reissue, it is competent for the Courts to decide whether the delay was unreasonable, and whether the reissue was therefore contrary to law and void."

In Walker, 2nd ed., sec. 227, a number of instances are given in which delay in applying was fatal to a broadened reissue.

The general rule in the States appears to be that a delay of two years or more invalidates a broadened reissue unless accounted for and excused by special circumstances: Sup. Ct., U. S., *Topliff* v. *Topliff* (April, 1892), 59 O. G., 1256.

If a reissue be sought to enlarge a claim, a delay of two years in applying therefor will ordinarily, though not always, be treated as evidence of abandonment of the new matter to the public.

A reissue may be had for an enlarged claim provided no third persons have meanwhile acquired rights to manufacture or sell what he failed to claim.

In *Farmer's Friend Manufacturing Co.* v. *Challenge Corn-planter Co.*, 128 U. S., 506 (1888), 19 Brodix, p. 86, a delay of less than two years sufficed to destroy a broadened reissue; in

this case the original patent was dated August 10th, 1880, and the reissued patent with the broadened claim was granted July 11th, 1882.

Provided the faults arise from inadvertence, accident or mistake, and disregarding the nugatory provisions relevant to broadened reissues: Walker, 2nd ed., sec. 218, lays down four faults which make patents reissuable and which are applicable to our section:

1. Invalidity arising from defective description.
2. Invalidity arising from insufficient description.
3. Invalidity arising from defective claims.
4. Inoperativeness arising from insufficient claims.

He might have added that there may be a combination of two or possibly more of these causes.

Besides mistakes in the written or printed matter, there may be mistakes of such a nature in the drawings as might necessitate a reissue, although this is unlikely to occur, a drawing which was clearly indicated in the original specification may be added to the reissue: *Union Paper Bag Co.* v. *Nixon*, 6 Fisher, 402.

Reissue Not Allowable.

Where it appears on the face of the patent or by contemporary records, that no accident, inadvertence or mistake could have occurred, an expansion of the claim cannot be allowed or sustained: Bradley, J., in *James* v. *Campbell*, 104 U. S., 356; *Mahn* v. *Harwood*, 112 U. S., 359 (1884), 15 Brodix, 339; *Coon* v. *Wilson*, 113 U. S., 277 (1884), 15 Brodix, 504; in this last case the reissue was applied for a little over three months after the date of the original patent, and the claim of the original patent was enlarged to cover collars manufactured by defendants after the original patent was issued and before the reissue.

In *Wicks* v. *Stevens*, 2 Ban and Ard., 318 (1876), Bradley, J., decided that neither inadvertence, accident or mistake did cause the particular omission, and that the claim of the reissued patent could not be sustained: *Vide* also *Giant Powder Co.* v. *Vigorit Powder Co.*, 6 Sawyer, 508 (1880).

The omission in the original patent to claim sub-combinations

in the combinations claimed was a mistake, apparent on the face of the patent, and was in law such a dedication of them, if new to the public, that a reissue cannot be availed of: See *Clements* v. *Odorless Excavating Co.*, 15 Brodix, 44 (January, 1884).

In *Goodyear* v. *Rubber Co.*, 9 Wall., 795 (1869), the Supreme Court reviewed the decision of the Commissioner as to reissue and upheld it.

Electric Gas Co. v. *Boston Electric Co.*, 139 U. S., 481, a reissue was invalid because there was no inadvertence, accident or mistake, the sole object being unlawfully to expand the claims.

The omission of an element in a claim held to be an illegal enlargement of the claim: *Pattee Plow Co.* v. *Kingman*, 19 Brodix, 355 (February, 1889, Sup. Ct., U. S.), 129 U. S. 294.

The "surrender" of the patent is made according to Form 8, Appx. 1, which is to be endorsed on the original patent, and the fee payable is at the rate of $3.33\frac{1}{3}$ per annum for the whole or any aliquot part (6 years) of the unexpired residue of the term; under section 39 it might be contended that $4 a year was payable for a reissue.

Reissue for Same Invention.

The reissue is to be for "the same invention," and whether the subject matter of the invention is the "same invention" as described or intended to be described in the original application, is a matter for consideration and of the judicial decision of the Commissioner; each case must necessarily be described on its own merits: *Freeman* v. *Asmues*, 59 O. G., Sup. Ct. (May 16th, 1892), p. 1432.

In *Yale Lock Co.* v. *Berkshire Bank*, 135 U. S., 342, a reissue was held invalid although it was applied for thirteen days after granting the original, because there was not a clear mistake inadvertently committed in the wording of the claim. It is well settled that a reissue can only be granted for the same invention, and the specification cannot be substantially changed: *Vide Pattee Plow Co.* v. *Kingsman*, *supra*, 19 Brodix, 355.

Under Rule 14, in the absence of model or drawing, the Commissioner may receive proof or written evidence that the pro-

posed amendments were part of the original invention or application, and in special cases may reissue the patent accordingly. This appears to be inconsistent with the statement in this Rule 14, that no new matter can be introduced into the specifications, for if it be admissible by extraneous evidence, it must be new matter introduced into the specifications.

Although the Commissioner may receive evidence when there is neither model or drawing, yet his power to grant a reissue is restricted to the granting of a reissue for the same invention: *Powder Co.* v. *Powder Works*, 98 U. S., 126.

If the original patent is for a process, a reissue may embrace the process and the product: *Merrill* v. *Yeomans*, 94 U. S., 568.

If the original patent specified a certain material a reissue may specify the equivalents for it: *Dunbar* v. *White*, 15 Fed. Rep., 747, and generally, equivalents may be substituted in a reissue.

In *Flower* v. *City of Detroit* (Sup. Ct., U. S.), decided May 14th, 1888, improvements in hydrants, for the independent up and down motion of the casing, held to be for an invention not indicated or suggested in the original, and is new matter, contrary to the express inhibition of R. S., sec. 4916, and void.

Vide also *Parker & Whipple Co.* v. *Yale Lock Co.*, 17 Brodix, 194 (October, 1887); *Moffatt* v. *Rogers*, 14 Brodix, 244.

Primâ facie, then, the Commissioner is to decide the whole law and the facts relative to the reissue, and whether the matter embraced in the reissue be for the same invention as that in the original, must in many cases be a matter of difficulty to decide. The presumption is that in granting the reissue, the Commissioner acted lawfully and correctly, and unless that presumption be rebutted the Courts would uphold the reissue.

If there be such a repugnancy between the old and the new patent, that it must be held as a matter of legal construction, that the new patent is not for the same invention as that embraced and secured in the original patent, and that the Commissioner has exceeded his authority, then his decision is subject to be reviewed and reversed in the Courts: *Vide Seymour* v. *Osborne*, 11 Wall., 516; *Collar Co.* v. *Van Dusen*, 23 Wall., 530.

Form 6, Appx. 1, is the form of petition for a reissue by the original patentee, who need not necessarily be the inventor.

The patentee may redescribe his invention in an amended specification. In so doing he is not rigidly confined to what was described before, but he may include in the new description whatever else was suggested or substantially indicated in the old, provided it was properly embraced in the invention as actually made and perfected. But the interpolations of new features, which would make the reissued patent for a substantially different invention from that embraced in the original, are not allowed.

Whether a reissued patent is for the same invention as the original, is a question for the Court, to be determined as a matter of construction on a comparison of the two instruments, aided or not by the testimony of experts: *Seymour* v. *Osborne*, 11 Wall., 516.

It is assumed that the applicant for reissue should take the oath, the same as on the original application, this is required in United States: *Vide* Rule 87, though nothing is said about it with us.

Practice as to Reissue in U. S. A.

And in the United States, the petition for reissue must be accompanied by a certified copy of the abstract of title giving the names of all assignees owning any undivided interest in the patent.

There must also be a statement on oath to be filed with the petitions in the States.

(1) That applicant verily believes the original patent to be inoperative or invalid, and the reasons why.

(2) When it is claimed that such patent is so inoperative or invalid "*by reason of a defective or insufficient specification*" particularly specifying the defects or insufficiencies.

(3) When it is claimed that such patent is inoperative or invalid by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, distinctly specifying the part or parts so alleged to have been improperly claimed as new.

(4) Particularly specifying the errors which constitute the inadvertence, accident or mistake relied upon, and how they arose or occurred.

(5) That said errors arose "*without any fraudulent or deceptive intention*" on the part of the applicant.

This very salutary statement is entirely wanting from Patent Office practice in Canada.

An original claim, if reproduced in the reissue, is subject to re-examination, and the entire application will be revised and restricted in the same manner as original applications; this is specially provided for in United States, section 4916, and Patent Office Rule 90, but no provision is made therefor in Canada.

(*d*) There is no form of petition in the Patent Office forms for obtaining a reissue by the legal representatives of a deceased patentee, but under Rule 6, one can readily be made; a certified copy of letters of administration or of the will of the deceased patentee should be attached to the petition, and the surrender of the original patent duly executed by the legal representatives.

Form 7, Appx. 1., covers the case of a reissue by the assignee.

The assignment mentioned refers apparently to an absolute assignment, leaving nothing in the assignee, the U. S., sec. 4916, embraces an assignment of "*the whole or any undivided part of the original patent.*" Our section should also read this way, and the reissue of a patent to one having a partial interest should avail only to him and those claiming through him.

In Canada, the petition is to be made by the assignee; but the amended description and specification referred to in sub-section 1, should apparently be made by the inventor if alive, or by his legal representatives, if dead. In this instance, would "legal representatives" cover assignees so as to entitle them, if the inventor be dead, to sign the amended specification; by analogy to sub-section 2, of section 10, one would suppose this to be the case.

Surrender.

The surrender of the original patent, Form 8, Appx. 1, must be made by the party holding the patent; the form only relates to the party "*within named*" (the patentee), it must be varied if made by an assignee or legal representative.

Practice Since 1870 in U. S. A.

In the U. S. A., in the case of assignments assigned after July 8th, 1870, the application must be made and the new specification must be signed by the inventor, if living: *Vide* section 4895. And in that case, the assignee of the entire or undivided interest must endorse on the petition of the inventor for reissue, his assent to the application. The application for reissue must be accompanied by a surrender of the original patent, or if that be lost, by a petition to that effect and a certified copy of the patent; but if a reissue be refused, the original patent will, on request, be returned.

Where several executors are appointed in a will, a reissued patent may be granted to one of such executors who receives probate, with respect to a patent of the testator: *Rubber Co.* v. *Goodyear*, 9 Wall., 788 (1869).

Assignee.

An assignee of a patent is a person to whom the entire legal interest or an undivided part of the entire legal interest in a patent has been duly assigned by an instrument in writing: *Vide* Walker, sec. 252. An assignment must, by express provision of the statute, be in writing: *Vide Dagleish* v. *Conboy*, 26 U. C. C. P. R., 25 (1876).

A reissue may be granted to an assignee of the executor or administrator of the patentee: *Carew* v. *Fabric Co.*, 1 Holmes, 45 (1871).

Or to an assignee of an assignee: *Swift* v. *Whisen*, 2 Bond, 115 (1867).

Or to any assignee, no matter how far removed from the original patentee by mesne assignments: *Selden* v. *Gas Burner Co.*, 9 Fed. Rep., 390 (1881).

And a recital of these mesne assignments in the reissuing patent is *primâ facie* evidence thereof in an infringement suit: *Middletown Tool Co.* v. *Judd*, 3 Fish., 144 (1867).

If a patent is owned jointly by two or more patentees, or by two or more assignees, or one or more patentees, and one or more assignees, all the owners must join in a reissue or ratify it, or it

will be void; but neither grantees or licensees are required to do either: *Potter* v. *Holland*, 4 Blatch., 206; *Meyer* v. *Bailey*, 2 Ban. & Ard., 73 (1875).

The right of a patentee or assignee to receive a reissue is not affected by his having made grants or issued licenses under his patent: *Smith* v. *Mercer*, 3 Pen. N. J. R., 529 (1846).

(*e*) This sub-section 3 formed the latter part of section 19 of the Act of 1872, indeed sub-sections 1, 2 and 3 of section 23 comprised section 19 of the Act of 1872, with a few immaterial verbal alterations.

In *Patric* v. *Sylvester*, 23 Grant, p. 573 (1876), tried before Proudfoot, V. C., it was stated that the patent was reissued 21st September, 1874, and the defect in the original specification, did not touch the matter in question in the suit.

This latter part of the section 19 of the Act of 1872 was held to date back the reissue to the original patent, and to destroy the operation of *user* as invalidating the later or reissued patent.

And it was also held that there can be no remedy for the intermediate *user*, as the patent was then inoperative, but for a subsequent infraction of the discovery *the user* shall not operate as a defence.

Damages.

The effect of this then is that in estimating damages for the infringement of a patent, all infringements occurring before the date of a reissue are condoned, and no money can be claimed in respect thereof, and this although the reissue does not touch the claims in question in the suit, as was the case here. One could well understand how this should be the case, if a reissued claim, which did not appear in the original patent, were in suit, but not where the original claim was intact, and the new matter or the eliminated matter in the reissued patent did not effect it in the slightest.

In the same way in *Wisner* v. *Coulthard*, Hodgins, Q. C., the Master-in-Ordinary, assessed the damages at $6,190.00 for infringements covering about four years, subsequent to the date of the

reissued patent. And no claim was made for infringements extending over four years previous thereto, during which infringement was actively going on, although the patent had been reissued on account of the addition of a new claim, which had no bearing whatever on the matter complained of, or the claim in suit.

Query, whether, notwithstanding reissue in this case, claim for damages for infringement of the claim in suit, which was not the subject of reissue, might not have been made, the patent was not defective or inoperative as to the claim in suit. Each claim of a patent stands or falls on its own merits, and may be considered as an independent patent.

In *Hunter* v. *Carrick*, 28 Grant, Ch. Rep. (Ont.), 1881, the original patent was issued in 1879 and reissued in August, 1880.

The suit was sustained with reference to the first claim, which was a broadened reissue of the claim of the original patent. The original claim being "In combination with a baker's oven a furnace D. set within the oven, but below the sole A."

The reissued claim being; "1. In a fire pot or furnace placed within a baker's oven below the sole thereof, and provided with a door situated above the grate"; "the door situated above the grate" being new matter added and which alone made the claim sustainable.

No Damages for Immediate Use.

In this case it was properly held that there is no remedy for the intermediate user as the patent was inoperative, but for the subsequent infringement the user does not operate as a defence. *Patric* v. *Sylvester*, 23 Grant, 573, cited.

Damages can only be claimed for infringements after the reissue.

It was also pointed out, that section 19 of the Act of 1872, which is similar to the first three sub-sections of this section 23, is similar to section 4916 U. S. Rev. Stat. and under American authorities, no prior use under the defective patent can authorize the use of the invention after the reissue.

Headnotes Erroneous in Hunter v. Carrick.

The headnotes in this case are erroneous and misleading. In the Ontario Digest, 1880-90, p. 1549, l. 17 (2), *the first* combina-

tion (*not the fifth*) of previously known articles, as applied to a baker's oven, which was productive of results which were new and useful to the trade, was held a proper subject of a patent.

The headnote in 10 A. R. (Ont.), 449, as well as 11 Sup. Ct. Rep., are incorrect. The *fourth* claim is the one referred to in the headnote, whereas the *first* claim, in which the tilting grate is not mentioned, was the only one in appeal; it was expressly shown in the evidence that the first claim of the reissue was new, and novelty was not rebutted.

Both the appellate Courts held, that the patent was void, as being merely an "aggregation."

And Henry, J., in the Supreme Court, founds his judgment on the claim of the *original* patent, which was not in suit, having been reissued; and finds that the original combination was not new, which was well-known and was the cause of the reissue, the door situate above the grate having been added to give patentability.

(f) Sometimes it may be desirable to split up a patent and obtain reissued patents for distinct and separate parts of the invention originally patented, on account of facility of assignment, if for no other reason.

In Rule 14, Patent Office (Can.), the reissued patents must be for separate and distinct parts of the invention comprehended in the original patent. If each part is not capable of being isolated it cannot be the subject of reissue.

As to this fourth sub-section of section 23, the tenth section of c. 49, 12 Vic., makes a similar provision for correction and reissue of the original, where the patentee may claim several patents for distinct and separate parts of the thing patented, which was probably adopted from section 5 of the U. S. Act of 1837. This is re-enacted and embodied in the Patent Act of 1872 by 38 Vic., c. 14, sec. 1.

If the original patent is for a process, it may be reissued in two parts, one for the process and the other for the product: *Tucker* v. *Dana*, 7 Fed. Rep., 213.

NOTE—(*a*), (*b*), (*c*), (*d*), (*e*) and (*f*) refer to section 23.

Government Fees.

As $4 a year for every unexpired year of a reissue is payable under sec. 39 of this Act, and as under sec. 22, the life of the Canadian patent is now eighteen years, should a patent be reissued in Canada during its first year, the amount of fees payable on a reissue may amount to $72 instead of the usual $60; although this has not been demanded, the wording of the section being erroneous, no provision having been made for the extension of the patent from fifteen to eighteen years.

Grantees of interests may continue to hold their rights under an original patent after it is surrendered and reissued by the patentee or assignee, or they may take corresponding rights under the reissued patents. They have their choice between the two: *Potter* v. *Holland*, 4 Blatch., 206 (1858); *Washburn* v. *Gould*, 3 Story, 122 (1844).

Earliest Reissue in U. S. A.

The earliest instance of reissue in the United States was in 1821, when James Grant, of Providence, R. I., petitioned Henry Clay, Secretary of State, praying that his old patent might be cancelled and a new one, in a corrected form, issued, which was done on the advice of the Attorney-General, and a new patent was issued by the President.

This reissued patent was called in question in *Grant* v. *Raymond*, 6 Peters, 243 (1832), and the validity was sustained by the Supreme Court.

A few months after this decision in 1832, Congress passed a statute relating to the granting reissued Letters Patent.

A practice sprung up in the States after this of surrendering valid patents and obtaining reissues for the purpose of inserting therein expanded and equivocal claims, which became a matter of judicial cognizance: *Vide Burr* v. *Duryee*, 1 Wall., 531.

In Canada, by 12 Vic., c. 24, sec. 7 (1849), passed to consolidate and amend the laws of patents of invention in Upper and Lower Canada, provision was, for the first time, made for granting reissues, hereafter set out in full.

Illustrations.

Should the Commissioner reject a broad claim on the erroneous assumption that it had been anticipated, and should the inventor acquiesce in the rejection, he would, no doubt, be entitled to a reissue with a broadened claim co-extensive with his original invention on the mistake being found out following, *Morey* v. *Lockwood* (1868), 8 Wall., 230.

A patent for a process cannot, after a considerable lapse of time, be reissued as a patent for a product: *Powder Co.* v. *Powder Co.*, 98 U. S., 126.

In *Toplif* v. *Toplif*, 12 Sup. Ct. (U. S.), 825 (decided May 2nd, 1892), the Supreme Court, U. S., held that a reissue may be had to get an enlarged claim, and intimated that the application therefor may be made at any time within two years of the original patent.

All owners of undivided rights in a patent must join in procuring a reissue or ratify it afterwards, or the reissue is void: *Potter* v *Holland*, 4 Blatch., 206.

It was definitely settled, that in a suit for infringement, whether of a reissued or an extended patent, the defendant is not at liberty to question the decision of the Commissioner in granting such reissue upon the ground of fraud: *Vide Rubber Co.* v. *Goodyear* (1869), 9 Wall., 788; *Eureka Company* v. *Bailey Company*, 11 Wall., 488; and *Seymour* v. *Osborne*, 11 Wall., 516.

The function the Commissioner performed is judicial in its nature. His decision must be held conclusive as to fraud until the patent is impeached in a proceeding had directly for that purpose, according to the rules which define the remedy as shown by the precedents and authorities on that subject: *Vide* Curtis, 4th ed., sec. 282-6.

Disclaimer may be Withdrawn.

If a disclaimer be entered by mistake or inadvertence, it may be withdrawn on reissue: *Daniels* v. *Chesterman*, 13 O. G., 4.

A reissue which contains claims which had previously been abandoned by the patentee in order to obtain his original Letters

Patent must be held to be invalid as to such claims: *Yale Lock Manufacturing Co.* v. *Berkshire National Bank*, 20 Brodix, 267 (decided May 5th, 1890), 125 U. S., p. 342. In this case the reissue was applied for only thirteen days after the grant of the original patent; this did not establish its validity: *Vide* also, *Dobson* v. *Lees*, 20 Brodix, 461 (decided December 1st, 1890), 137 U. S., 258; *Crawford* v. *Heisinger*, 17 Brodix, 367 (1887), 123 U. S., 589.

An Element Cannot be Dropped.

When the original claim was for five elements in combination with two other elements: *Held*, that it is an enlargement of a claim to reissue it for a combination of the five elements only: *Vide Gage* v. *Herring*, 14 Brodix, 454; 107 U. S., 640. A reissue for matter disclaimed or rejected with patentee's acquiescence is invalid: *Leggett* v. *Avery*, 101 U. S., 256; *Goodyear Dental Vulcanite Co.* v. *Davis*, 102 U. S., 222; *Eames* v. *Andrews*, 122 U. S., 40.

No Reissue in England.

In England, there does not appear to be reissue such as in Canada and United States. In *Kelly* v. *Heathman*, 45 Ch. D., 256, when the "*correction or explanation*" did not make the invention substantially larger than or substantially different from the invention claimed by the original specifications, it was within the meaning of the Act of 1883 and did not render the patent invalid.

Reissue U. S. A.—What may be Subject of.

Clerical errors may be corrected by reissue or any obvious error in a drawing, and, if a model is on file, permits the drawing to be amended thereby; it may correct an error in the title, a mistake in the name or residence or any grammatical error; when a specification is insufficient to work by it may correct this; or, if a whole class of subjects are stated to be necessary when only one or more may answer; or, if something essential has been omitted; it may correct a mistake in dates, or may cure an uncertain and ambiguous claim; a claim may also be cancelled or

narrowed by reissue: *Vulcanite Co.* v. *Wetherby*, 2 Cliff., 555, Simond's Condensed Treatise, p. 55–56 and *Buerck* v. *Valentine*, 9 Blatch., 479; *Collar Co.* v. *White*, 2 Ban. and Ard., 60; *Schneider* v. *Bassett*, 13 Fed. Rep., 351; *Soladee* v. *Carriage Co.*, 20 Fed. Rep., 686; *Schneider* v. *Pountney*, 21 Fed. Rep., 399.

The original provision in Canada as to reissues was 12 Vic., c. 49, sec. 7 (1849): *Vide* Form 53, Appx. 2.

This section, as set out in Form 53, was a copy of section 13 of the U. S. Patent Act of 1836, the latter part of this section relating to the addition or substitution of any corrected matter.

In the C. S. C. 1859, c. 34, the said sec. 7, 12 Vic., c. 49, was re-enacted and divided into three sub-sections.

The Patent Act of 1869 puts it in the same form as in section 6 of the Patent Act of 1872, which latter has been sub-divided and forms the first three sub-sections of the present Act.

These enactments have practically always been the same as to reissues.

PART VIII.

DISCLAIMERS.

24. (*a*) Whenever, by any mistake, accident or inadvertence, and without any wilful intent to defraud or mislead the public, a patentee has made his specification too broad, claiming more than that of which he or the person through whom he claims was the first inventor,—or has, in the specification, claimed that he or the person through whom he claims was the first inventor of any material or substantial part of the invention patented, of which he was not the first inventor, and to which he had no lawful right—the patentee may, on payment of the fee hereinafter provided, make disclaimer of such parts as he does not claim to hold by virtue of the patent or the assignment thereof:

2. (*b*) Such disclaimer shall be in writing, and in duplicate, and shall be attested in the manner hereinbefore prescribed in respect of an application for a patent; one copy thereof shall be filed and recorded in the office of the commissioner, and the other copy thereof shall be attached to the patent and made a part thereof by reference, and such disclaimer shall thereafter be taken and considered as part of the original specification:

3. (*c*) Such disclaimer shall not affect any action pending at the time of its being made, except in so far as relates to the question of unreasonable neglect or delay in making it:

4. (*d*) In case of the death of the original patentee, or of his having assigned the patent, a like right shall vest in his legal representatives, any of whom may make disclaimer:

5. (*e*) The patent shall thereafter be deemed good and valid for so much of the invention as is truly the invention of the disclaimant, and is not disclaimed, if it is a material and substantial part of the invention, and is definitely distinguished from other parts claimed without right; and the disclaimant shall be entitled to maintain an action or suit in respect of such part accordingly. 35 V., c. 26, sec. 20.

Disclaimer in Canada Originated in 1849.

NOTE.—By the Act of the Province of Canada, 12 Vic., c. 24 (passed 30th May, 1849), which consolidated 6 Will. IV., c. 34 (1836), for Lower Canada, and 7 Geo. IV., c. 5 (1826), for Upper Canada, a patentee was for the first time allowed to disclaim, and if defendant had used part justly claimed as new, the Court may adjudge and award as to costs. The right of disclaimer has been continued down through the various Patent Acts ever since. The present five sub-sections of section 24, being section 20 of the Act of 1872, split up into five parts, with a few verbal alterations.

Each Claim is a Separate Patent.

Each claim stands by itself and may be treated as a distinct and separate patent, by section 32 of this Act each claim may be taken by itself: *Vide Hunter* v. *Carrick*, 10 App. Rep., Ont., p. 472.

Disclaimer in U. S. A. Originated in 1837.

In the United States statutory provisions as to disclaimers originated in 1837, and have remained substantially the same up to the present date, being R. S., secs. 4917 and 4922.

In Canada our section is modelled somewhat after the two U. S. sections, but with us the two are blended into one: Walker, 2nd ed., in sec. 193, has, with some omissions, blended the two U. S. sections together and made a better blend than ours.

Rule 195 U. S. Patent Office.

In Rule 195, U. S. Pat. Off., the two sections are also blended, leaving out, however, all reference to the maintenance of a suit for infringement by the patentee, whether of the whole or any sectional interest in the patent, also, to the fact that no costs are recoverable unless the proper disclaimer was entered in the Patent Office before the commencement of the suit, or that no patentee shall be entitled to maintain any such suit if he has unreasonably neglected to enter a disclaimer.

Rule 196, U. S. Pat. Off., refers to another class of disclaimer, which is embodied in original or reissue applications, and also to those made to avoid the continuance of an interference, which also are required to be in writing, signed by the applicant in person and to be duly witnessed, and call for no fee.

(*a*) The first sub-section speaks of a patentee making his specification too broad, and claiming more than that which he, or the person through whom he claims, was the first inventor, this language would hardly be applicable in the event of an assignee being the patentee, for then the inventor would make the oath and sign the specification, and the patentee would make no claims at all, as would also be the case in the event of a patentee being the assignee, while the original inventor was the first patentee; but would be directly in point in the event of the patentee being the original inventor, or being the legal representative or the assignee of a deceased inventor, who had died before taking steps to patent his invention, as referred to in sub-section 2 of section 10 of this Act.

Parts of claims or combinations are not referred to, as subject matter of disclaimer, for a claim is an entirety, and if one or more of its elements be given up the combination claimed disappears. A disclaimer cannot then be called in to modify and thus save a combination claim, for unless the combination remains intact the invention fails: *Vide Vance* v. *Campbell*, 1 Black, 429.

Disclaimer Limited to Mistake, Accident or Inadvertence.

The right of disclaimer must also be limited to "*mistake, accident or inadvertence*," as we have discussed under the head of

reissue, in section 23; if it cannot come under any of these headings there is no statutory right to disclaimer: See *Schillenger* v. *Gunther*, 17 Blatch., 66. There may be a mistake of fact or a mistake of law; the former arises when a claim is made to that which is not new, as mentioned under notes (*b*) and (*c*) of section 16, and is the property of another; the latter, when a claim is made to that which is not patentable, as was the case in *O'Reilly* v. *Morse*, 15 How., 120 (1853), when a claim was made to the principle of employing electricity in the transmission of messages, and other cases referred to under notes (*a*) and (*d*) to section 16.

Patent Office Form 26.

The fee payable on asking to attach a disclaimer to a patent is $2 by section 39, and in the U. S. it is $10. Form 26 of Pat. Off. Forms is to be followed, to be varied in the event of the assignee or legal representative disclaiming. The intention of sub-section 1 is, that an assignee should be able to disclaim, though the wording is not very apposite.

No Disclaimer for Useless Matter or Void Claims.

That which is void for want of utility does not appear to be subject matter for disclaimer; where a patent has but one claim, and where the matter covered by that claim is useless, no disclaimer can make that patent valid. Where a claim purports to cover a thing constructed, in either of several ways; and where that thing is useless, if constructed in another, the claim cannot be limited to the useful construction by means of any disclaimer, for it is not the office of a disclaimer to reform or to alter the description or claim of an invention. See *Hailes* v. *Albany Stove Co.*, 16 Fed. Rep., 242 (1883); *White* v. *Manufacturing Co.*, 24 O. G. 205 (1883). The function of a disclaimer is to eliminate all claims for inventions which were not new or inventions with the patentee. Where a part only of the claims of a patent are void for want of utility, and for no other cause, the void claims are not injurious to the valid ones, and therefore no disclaimer is needed: *Vide* Walker, sec. 197. In both foregoing instances where the claim is useless or improperly drawn, it might under circumstances already discussed be subject matter for a reissue.

This sub-sec. 1 refers to that which is a "material and substantial part of the thing patented," if then the matter be not material, but a mere surplusage, there is no obligation to disclaim: *Vide Hall* v. *Wiles*, 2 Blatch., 199 (1851); *Peek* v. *Frame*, 5 Fisher, 212 (1871).

Should fraud on the public, or anything misleading be shown, the disclaimer would be void.

Our section 24 is a bad blend of sections 4917-4922, U. S. Rev. Pat. Stats., which two latter have reference to the same set of circumstances as grounds for disclaimer, the former authorizing the filing of a disclaimer, and the other legalizing suits brought on patents such as have been amended under the first mentioned section.

Disclaimer Must Not Change the Invention.

A disclaimer is properly employed for the surrender of a separate claim, or some other distinct and separate matter which can be eliminated without mutilating or changing what is left standing. Perhaps it may be used to limit a claim to a particular class of objects, or to change the form of a claim which is too broad; but certainly it cannot be used to change the character of the invention: *Vide Hailes* v. *Albany Stove Co.*, 17 Brodix, 336 (decided December 12th, 1887), Sup. Ct., U. S.

In this case it was held to be an attempt to obtain a new patent by an amended specification and supplemental description, and not a proper disclaimer, and that the drawings annexed to the patent cannot be used, even on an application for reissue, much less on a disclaimer, to change the patent and make it embrace a different invention from that described in the specifications, *S. C.*, p. 362.

If the effect of disclaimer is to make a complete specification a different invention from that in the provisional specification, the British patent issued after disclaimer is void: *Fox* v. *Kensington Electric Lighting Co.*, L. R., 1892, 2 Ch. 66.

The original patent cannot be revived by a disclaimer in the reissue: *Vide McMurray* v. *Mallory*, 111 U. S., 79, 15 Brodix, 171 (decided March 24th, 1884).

(b) The disclaimer must be in duplicate in writing and must be witnessed by two witnesses in the same manner as an application for a patent.

Defects in Patent Office Form No. 26 (Can.).

The form of disclaimer in our Patent Office forms is No. 26, and is defective, in that it is not applicable in the case of an assignee or a legal representative, or the case of a joint owner or tenant in common of a patent right, and it also purports to disclaim a *part of* a claim, which is incorrect, for a combination claim is an entirety, and no element or elements can be given up (*vide* note *a*, sec. 24): *Vance* v. *Campbell*, 1 Black, 429; Walker, 2nd ed., s. 197.

Under exceptional circumstances, however, it may be possible that two or more inventions may be included in one claim when, if definitely distinguishable, one of them may be expunged: *Vide Tuck* v. *Bramhill*, 6 Blatch., 95 (1868); *Taylor* v. *Archer*, 8 Blatch., 318 (1871). In this exceptional instance the form 26 may be applicable, although the illustration of the part disclaimed in the form is not correct.

When a disclaimer is made as to a claim *primâ facie* the whole claim goes; the disclaimer bears specially on the claim which is the operative part of the specification.

It is conceived that the Patent Office form 26 would be in better shape if as follows, and could then be made to embrace all classes of disclaimants.

Suggested Form of Disclaimer.

To the Commissioner of Patents, Ottawa:

Your petitioner W. L., of the city of Hull, in the county of Ottawa, Province of Quebec (or as the case may be, of any other locality and country), represents that, in the matter of certain new and useful improvements in waggon-brakes, for which Letters Patent of the Dominion of Canada No. — were granted to the said W. L. (or as the case may be) on the 1st day of April, A.D. 18—, he is (*here state the exact interest of the disclaimant, and whether legal representative or assignee or joint owner; and if assignee, a reference to the date and serial number of*

the assignment as recorded), and that he has reason to believe that through inadvertence, accident or mistake, without any wilful intent to defraud or mislead the public, the specification and claim of said Letters Patent are too broad as to a material and substantial part of the invention, including that of which said W. L. was not the first inventor (*or*, which is not lawfully patentable).

Your petitioner, therefore, hereby enters his disclaimer to (*here set out in full the number and wording of the claim or claims disclaimed, as well as any reference to the body of the specifications bearing on such claims, which it may be desirable to eliminate*).

Hull, day of April, 18

Signed in duplicate in the presence of
DAVID BROWN,
FRANCIS LEMIEUX.

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The United States form No. 27, "Disclaimer after Patent" is also defective in that it refers to a part of a claim.

Extent of Interest to be Stated in United States Disclaimer.

The United States, section 4917, specially requires that the disclaimant is to state the extent of his interest in such patent; that it shall be in writing, attested by one or more witnesses, and recorded in the Patent Office, and it shall thereafter be considered as part of the original specification, to the extent of the interest possessed by the claimant and by those claiming under him, after the recording thereof.

This leaves all other interests in the patent intact, and only affects the disclaimant and those claiming through him: See *Potter* v. *Holland*, 1 Fish., 327.

Omission in Patent Act (Can.).

Our Act entirely omits all reference to this material matter, viz., the extent of interest of the disclaimant and the effect of a disclaimer by one having only a partial interest, and therein is defective.

Our form should also set out the capacity in which disclaimant makes disclaimer, whether as inventor and patentee, or assignee and patentee, or assignee, or as legal representative of a deceased inventor, or as a joint owner.

First Inventor.

This section 24 refers to a patentee claiming more than that which he or the person through whom he claims was the "*first inventor*"; and it is in 12 Vic., c. 24, sec. 8, that any of our Acts first speak of the "*first inventor.*" At the time of this Act (as Burbidge, J., in the judgment of *The Queen* v. *La Force*, in Exchequer Court, Canada, decided January, 1894, points out), what would defeat his patent and prevent him from being, in the eyes of the law, the "*first inventor*," was **the prior knowledge or use of the invention in public.** Against such knowledge or use in a foreign country, sec. 2, 12 Vic., c. 24, proposed to protect him, except in the case of the invention having previously been patented or described in a printed publication, and Burbidge, J., thinks that the word "*first*" here is used to express the idea of novelty, and is not incident to any controversy or priority of conception between rival inventors, and that there is no reason to think that these words "*first inventor*" had now any significance different from that with which they were then used; and that "*first inventor*" did not mean "*the world over the first inventor,*" because its advantages were limited to British subjects resident in the Province who were not affected by any foreign invention that had not been previously patented or described.

(*c*) This provides for the case of a disclaimer being made and filed during the progress of the suit, and it is inferred that the claim or claims disclaimed has or have a bearing on the suit; if not, it is not apparent why the disclaimer should affect the suit.

If, for instance, there be an infringement suit with respect to five claims of a patent, two of which cannot lawfully be claimed by the patentee, being either not patentable at law, or the invention of another, it would then be in order for the patentee to disclaim, and to proceed on the three claims which are justly his own.

In Ontario there is no reason why proceedings may not be abandoned as to these two claims at any stage of the suit, without any formal disclaimer, on such terms as to costs as may be found proper; they might even be formally dropped out, on terms as to costs, even at the trial, the Judge noting it on the record, and stating thereon that the trial proceeded and was confined to the three remaining claims, giving their numbers. This latter has been the practice in Ontario Courts, as was done by Ferguson, J., in *Wisner* v. *Coulthard* (unreported), heard at Toronto, December, 1889.

Owing to the ample powers of amendment since the Ontario Judicature Act, 1881, disclaimers have not, at any rate in Ontario, the same prominence they formerly had, and with us no disabilities are imposed on failure to file a disclaimer, as is the case in the States.

Practice in United States of America.

In the States it has been held that where a plaintiff sues on certain of the claims of his patent only, the defendant will not be able to raise an issue relevant to the validity of any other claim, to show a necessity for disclaimer, and thus to escape costs: *American Bell Telephone Co.* v. *Spencer*, 8 Fed. Rep., 512, 1881.

Practice in Canada contrasted with that in England.

The term "at the time of its being made," in sub-section 3 of section 24 of our Patent Act, obviously from the preceding sub-section 2, means filed and recorded in the Patent Office.

In Canada, disclaimers have been made during the progress of a suit as to claims not sued on, on the apparent ground that the presence of a bad claim would vitiate the patent. In *Hunter* v. *Carrick*, 10 App. Rep. Ont., p. 450, defendant's counsel takes this view, and cites a number of English cases in support of this proposition.

Before the English Patent Act of 1883, a number of English authorities went to show that a failure in part of an invention avoids a patent; that the consideration is the entirety of all the improvements, and if there is no novelty in one of the improvements, the consideration fails in the whole: *Vide Brunton* v. *Hawke*,

Goodeve, p. 98; *vide* also *Thomas* v. *Foxwell*, Goodeve, p. 461, where the patent was void for want of novelty in the second claim; also *Patterson* v. *Gas Light Co.*, Goodeve, p. 364 (1875); *Morgan* v. *Seaward*, Goodeve, p. 309 (1835).

There are also recent decisions to this effect in Great Britain. If the patent consist of several claims, and one of those several inventions is useless, the patent is void: See *United States Horseshoe Nail Co.* v. *Stewart*, R. P. C., vol. 2 (1885), p. 132, the novelty and merit of each claim was distinctly set forth in the specifications as the consideration for the grant: *Simpson* v. *Halliday*, L. R., 1 H. L. 315; and *Templeton* v. *Macfarlane*, 1 H. L. 595, cited; the opposite is the case in United States of America; see Walker, sec. 197, *ante*.

Where one claim is not novel, appeal on this ground was allowed: *Cropper* v. *Smith*, R. P. C., vol. 2 (1885), p. 17, and in *Laurence* v. *Perry*, R. P. C., vol. 2 (1885), p. 179, in such case the patent was held invalid.

This extreme view does not prevail in Canada or the United States.

Although in these recent English cases (1885) the patents have been declared invalid, sec. 18 of the British Patent Act of 1883 provides for amendment by way of disclaimer, correction or explanation; and by section 19 power is given to disclaim a part of an invention, during action, on such terms as to costs, or otherwise, as may be imposed by the Court or Judge. This is new, and appears to be in the discretion of the Court, which might not give leave to discard a claim to save a patent, if the patentee had not taken reasonable precautions to ascertain the validity of his claims.

One Invalid Claim does not Invalidate all the Claims of a Canadian Patent.

However, these English cases have no bearing on Canadian cases, for we have had express power of disclaimer since 1849; and by section 32 of this Act (section 25 of the Act of 1872), the Court may discriminate: *Vide* Patterson, J., in *Hunter* v. *Carrick*, 10 App. Rep. (Ont.), p. 472; also section 28, where the patent

shall be held valid for such part of the invention described as the patentee is found entitled to, where there has been involuntary error.

Notwithstanding the broad difference between our Act and the English Acts before 1883, and even the Act of 1883, Hagarty, C. J., on p. 452 of *Hunter* v. *Carrick*, 10 App Rep., Ont. (November, 1884), takes the English view of the situation, and states that the plaintiff would apparently fail, if one of the subsidiary combinations was a known old invention, citing a very recent English case.

In the same way, in view of these old English decisions, in *Collette* v. *Lasnier*, 13 Sup. Ct. Rep. (Can.), March, 1886, Henry, J., held, that the patent was void because one or more of the claims were void, and that the appeal should be allowed.

These English decisions, and the supposition that failure to file a "disclaimer," induced disabilities as is the case in the States, have led to a number of misapprehensions in Canada as to the effect of disclaimers, and narrowed reissues.

No Penalty Stated on Failure to File Disclaimer.

This section does not state what will be the consequence of unreasonable neglect or delay in making the disclaimer, nor what constitutes unreasonable neglect or delay. It merely follows the wording of the latter part of sec. 4917 of the U. S. Act, which provides no penalty in case of default in filing; our section is in this respect defective.

The Penalty in U. S. A.

The U. S. Act, section 4922, enacts that "No costs shall be recoverable unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit," and again section 4917 provides for the case of filing a disclaimer while an action is pending, which action shall not be affected thereby, except, so far as may relate to the question of unreasonable neglect or delay in filing it. We have no provision, such as this, in section 4922, with reference to costs; and of the two U. S. sections 4917 and 4922, this section 4922 is the only one which prescribes any penalty or disability to prosecute a suit for failure to duly disclaim.

The two U. S. sections must be construed together.

Disclaimer Pending Action in England.

Leave to disclaim, granted in the terms that the specification, when amended, should not be given in evidence at the trial of the action, and that no evidence should be given of any infringement prior to the date of filing the amended specification, and that the costs be paid by plaintiff: *Re* Codd's Patent, R. P. C. vol. 1 (1884), p. 209; see also *Goulard* v. *Lindsay*, 38 Ch. D., 38, where disclaimer was allowed on payment of all costs up to time of leave given to disclaim, and waiver of all damages prior to amendment.

Unreasonable Neglect or Delay.

As to the question of "unreasonable neglect or delay" in filing a disclaimer pending an action, neglect or delay begins when knowledge is brought home to the patentee that the inventor, on whose account the patent was granted, was not the first inventor of a part claimed in the patent, and which formed a material and substantial part of the patented invention: Walker, sec. 204; *vide Singer* v. *Walmsley*, 1 Fisher, 558 (1860); *O'Reilly* v. *Morse*, 15 How., 121 (1853); *Gage* v. *Herring*, 107 U. S., 640; 14 Brodix, 454; *Dunbar* v. *Meyers*, 94 U. S., 187; 11 Brodix, 59; *Smith* v. *Nicholls*, 21 Wall., 112; 9 Brodix, 425.

If there be reasonable ground for doubting whether the alleged anticipation brought home to the knowledge of the patentee negatives the novelty of anything claimed by him, then unreasonable delay will not begin until the question be finally settled in the Courts: Walker, sec. 204; and *vide Seymour* v. *McCormick*, 19 Howard, 106 (1856).

When Delay is not Unreasonable.

Where the validity of a reissue claim had been sanctioned by the Commissioner in granting it, and the claim was not held invalid by the Circuit Court: *Held*, that there was no unreasonable delay in filing a disclaimer to it: *Yale Lock Manufacturing Co.* v. *Sargent* (Sup. Ct., April 5th, 1886), 16 Brodix, 275; 117 U. S., 536.

There is no unreasonable delay in disclaiming until the highest Court has been reached: *Gage* v. *Herring*, 107 U. S., 640, and cases cited 15 Brodix, p. 190.

An unreasonable delay in filing a disclaimer in the States deprives the patentee of all right of action for infringement: *Brooks* v. *Jenkins*, 3 McLean, 432.

The question whether delay in filing disclaimer was or was not unreasonable is a mixed question of law and of fact. It must largely depend upon the circumstances which surrounded the person chargeable, and this must be a question of fact, and whether they constituted an excuse for the delay is a question of law: *Vide* Walker, sec. 204.

The Judge has Discretion as to Costs in Canada.

As the Judge has a discretion as to costs, under this sub-section, he might deprive plaintiff of costs, if there had been unreasonable delay shown in filing disclaimer, although not specially provided for as in the U. S. section.

As to Damages.

Whether damages are recoverable in Canada, in the event of "unreasonable neglect or delay" in filing disclaimer, is an open question, and we have no judicial decisions thereon. In the States the suit could not be maintained. In England, under section 19, Act 1883, power to disclaim during action may be ordered on terms as to costs and postponement of the action, and by section 20 (Eng.) there is a strangely worded provision that "no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction or explanation, unless the patentee establishes to the satisfaction of the Court that his original claim was framed in good faith, and with reasonable skill and knowledge."

Why a defendant should be mulcted in damages for infringement under any circumstances, when he has been rightly advised that the patent for the alleged invention is invalid, merely because the patentee made stupid mistakes in "good faith," is impossible to understand.

Effects of Disclaimer.

A disclaimer may cancel one or more claims in a patent, even if it be a claim in a reissued patent: *Schillinger* v. *Gunther*, 17 Blatch., 66.

It may cancel parts of the description to harmonize with the

cancellation of the claim as auxillary to the disclaimer: *Cartridge Co.* v. *Cartridge Co.*, 112 U. S., 624.

In the case of a claim for "a concrete pavement laid in detached blocks or sections substantially in the manner shown and described." The disclaimer was to the effect that "it disclaims the forming of blocks from plastic material without interposing anything between their joints while in the process of formation." This the Court sustained, and said "the sole claim of the patent left after the disclaimer is this: The arrangement of tar paper, or its equivalent, between adjoining blocks of concrete, substantially as and for the purpose set forth": *Schillinger* v. *Gunther*, 15 Blatch., 303.

A disclaimer may cancel an alternative in a claim; and it may qualify and modify a claim whenever the effect is simply to throw open to the public some part of the ground which a claim already covers. It cannot restate a claim with another effect.

(*d*) In this sub-section 4 "legal representatives" includes assignees as is evident by the context.

There is no provision in our statute for assignment of *sectional interests*, as is the case in the States, whatever that may exactly mean.

The expression "any of whom may make disclaimer" in this sub-section 4 would, however, seem to imply that one out of several executors or assignees may make disclaimer.

As to Joint Owner Making Disclaimer.

This suggests the question, whether one of several joint owners or "*tenants in common*" of a patent may file a disclaimer; he can sell, assign and grant licenses with respect to the whole invention: *Vide* Note (*a*), section 7, and may maintain an action in his own name to restrain infringement, without joining his co-owners: *Vide Sheehan* v. *Great Eastern R. W. Co.*, 16 Ch. D., 59; and under sub-sec. 2, sec. 20 of the Pat. Act (Can.), special provision is made for granting patents in the name of all the applicants.

This being the case why should not a joint owner or "*tenant in common*" of a patented invention file a disclaimer; the Act might provide expressly for this, confining the effect of the disclaimer to such joint owner and those claiming through him, leaving the interest of the other owner or owners intact, if they so desire it.

If one only of several joint owners of a patent file a disclaimer, no other owner could avail himself of its benefits, nor could it affect a suit brought by all the owners jointly: *Wyeth* v. *Stone*, 1 Story, 294 (1840).

Sub-section 5 Relates Only to the Inventor.

(*e*) In this sub-section the invention may not be that of the "*disclaimant*" at all; for the disclaimant may be the assignee or a legal representative of a deceased inventor. This sub-section assumes that the disclaimant is the inventor, and makes no provision for anyone else, for it refers only to *the invention* of the disclaimant.

A Material and Substantial Part.

A disclaimer must be for a "material and substantial part" of the thing patented: *Vide Hailes* v. *Albany Stove Co.*, 16 Fed. Rep., 242 (1883); *White* v. *Manufacturing Co.*, 24 O. G., 205 (1883). A claim which is useless need not be disclaimed.

No Disabilities in Canada.

Our section, although it gives a disclaimant a right to maintain a suit for that which is his invention and is not disclaimed, and is a material and substantial part thereof, does not, like the U. S. Act, provide that no patentee shall be entitled to maintain a suit if he has unreasonably neglected or delayed to enter a disclaimer; so in this respect in Canada there are no disabilities prescribed.

Owner of a Sectional Interest.

Nor does our section authorize the owner of a sectional interest in a patented invention who has made disclaimer to maintain a suit for infringement as does U. S. section 4922; it is not clear what may be the meaning of "*sectional*" interest; it cannot mean a licensee, for he has no power to maintain an action for infringement by himself, nor yet a joint owner.

For the first Canadian enactment as to disclaimers, 12 Vic., c. 24, sec. 8 (1849): See Form 54, Appx. 2.

This is an obvious blending together of secs. 7 and 9 of the U. S. Pat. Act of 1837; differences being that said U. S. sec. 7

refers to the payment of a fee of $10 by the person disclaiming, and said U. S. sec. 9 to the fact that no costs are recoverable unless the disclaimer has been filed in the Patent Office before the commencement of the suit; while our section of 1849 does not refer to the fee payable, and specifies no special time for filing the disclaimer, in order that costs may be recovered.

Our section of 1849 speaks of a "fractional" interest in a patent, whatever that may mean, this word being substituted for "sectional" in the U. S. Act; the foregoing sec. 8, 12 Vic., c. 24, appears in C. S. C. (1859), c. 34, sec. 18, and was there split into five sub-sections, the name of the Minister of Agriculture being substituted for that of the Provincial Secretary throughout.

If the old section 18 of the Consolidated Act of 1859 were amended in some particulars, so as to bring it down to date, it would be in better workable shape than our present section 24.

In the Patent Act of 1869, sec. 20, a change took place for the worse, and this section 24 which subsequently appeared "*verbatim*" in the Patent Act of 1872, and which is the same section as appears in our present Patent Act, in a subdivided form, was for the first time enacted.

The old section 8 of the Act of 1849, as already stated, is not so faulty as our present section 24, which latter is an abortive revision and consolidation of U. S. sections 4917, 4922, which latter are also defective in some respects.

Improvements Suggested.

1. Our section, it is suggested, should provide for "disclaimer" by a joint owner, or "tenant in common," of a patent right; confining the effect of such disclaimer to himself and those claiming through him, leaving the interests of co-owners intact, unless they join in the disclaimer.

2. The defect or mistake pointed out at the opening of note (*a*), section 24, should be remedied so as to provide for the case of an assignee.

3. As well as the mistake pointed out at the opening of note (*e*), section 24, so as to provide for the case of assignee, etc.

4. That, in the disclaimer, the extent of the interest of the dis-

claimant in the patent should be stated as well as the capacity in which he disclaims.

5. That a new form of disclaimer should be adopted in place of Form 26, Appx. I., for the reasons stated in note (*b*), section 24, etc.

As to Disclaimer in the Case of a Claim "With or Without" a Special Element.

The parts retained after disclaimer must be definitely distinguishable from the part disclaimed; in *Tuck* v. *Bramhill*, 6 Blatch., 95 (1868), the claim was "the forming of packing for pistons or stuffing boxes for steam engines, and for like purposes, out of saturated canvas, so cut that the thread or warp shall run in a diagonal direction from the line or centre of the roll of packing and rolled into form, either in connection with the india rubber core or other elastic material, or without, as herein set forth."

Litigation showed that such a thing, without a core, was old, the patentee disclaimed this and retained the packing with the core. Blatchford, J., held the disclaimer to be proper and effectual: *Vide* Walker, 199, where *Taylor* v. *Archer*, 8 Blatch., 318 (1871), is also cited.

In U. S. Circuit Court of Appeals, 9th Circuit: *Hunt Bros. Fruit Packing Co.* v. *Cassidy* (decided October 24th, 1892), 62 O. G., p. 1965, in an improvement in fruit driers, the patentee first claimed "spring or other catches," but on an objection that this was not in the proper form, amended by striking out "or other": *Held*, that this was not a disclaimer of "gravity catches" which were known mechanical equivalents for spring catches.

Disclaimers During Suit in U. S A.

In the States disclaimers may be filed pending a suit, but in that event the plaintiff, even if he prevails in the suit, can recover no costs: *Smith* v. *Nicholls*, 21 Wall., 117 (1874).

In Canada No Time Stated for Filing.

It must, however, be borne in mind that our Act does not prescribe when the disclaimer is to be filed, it only says there must not be unreasonable neglect or delay; in the States *it must be filed before action brought*, so as to recover costs, and the claim to be disclaimed must refer to the subject matter of suit.

Effect of Section 32, Patent Act, Canada (1887).

Our section 32 gives our Courts greater latitude in the matter of disclaimer than the U. S. Courts have; but to avoid all questions it is better to file a disclaimer of that which is not new when found out, if it relates to the subject matter of the suit, even though, as the section stands, "unreasonable neglect or delay" does not deprive us in Canada of the benefits of the section, as is the case in the States, if the disclaimer be not filed before action brought.

Failure to Disclaim Affects Costs in U. S. A.

The failure to disclaim in the States affects more the question of costs, for if a patentee at the trial is found entitled to sustain certain claims, but not entitled with respect to others, he is entitled to damages for violation of his valid claims, but he gets no costs: *Vide Seymour* v. *McCormick*, 3 Blatch., 209, and cases in Bump., 2nd ed., p. 270.

The question of costs in the United States of America are not, as with us, of much moment, for comparatively small costs there are taxable against an opposite party on a patent suit.

Descriptive matter may be erased by disclaimer, but if there be merely a defective or insufficient description, it must be corrected by reissue: *Cartridge Co.* v. *Cartridge Co.*, 15 Brodix, 364 (1884).

Constructive Disclaimer.

As an instance of "constructive disclaimer," where the body of the specification described a composition of matter, but only claimed a sheet of material or fabric coated with such composition, the composition not having been specially claimed: *Held*, that this composition must be regarded as disclaimed, and, being public property, that there was no invention in applying it to paper as claimed: See *Underwood* v. *Gerber*, Sup. Ct. U. S. (May 1st, 1893), 63 O. G., p. 1063; see also *Miller* v. *Brass Co.*, 104 U. S. 350-352; *Mahn* v. *Harwood*, 112 U. S., pp. 360, 361; *Watson* v. *Cincinnati R. W. Co.*, 20 Brodix, 49, 132, U. S., 161 (November 18th, 1889), and cases there cited.

PART IX.

ASSIGNMENTS.

25. The patent may be granted to any person to whom the inventor, entitled under this Act to obtain a patent, has assigned or bequeathed the right of obtaining the same, or in default of such assignment or bequest, to the legal representatives of the deceased inventor. 35 V., c. 26, s. 8; 36 V., c. 44, s. 2.

Assignment by Inventor.

NOTE.—In the event of an assignment during the lifetime of the inventor, the inventor must make the affidavit prescribed by the forms, and sign the specifications, and not the assignee, the assignee signing the petition Form 3, Appx. I.; and the assignment Form 24 must be executed in duplicate by the inventor, and registered in the Patent Office on payment of a fee of $2.

The assignment referred to in this section means an absolute assignment, otherwise Form 4 would be used.

If the inventor be dead, the assignee may obtain a patent, as already indicated under sub-section 2 of section 10 of this Act. The assignment must be filed and proof of the death of the inventor given in the Patent Office.

In the United States one copy of assignment and one original executed by the inventor, is required, which is registered for a fee of $1 for documents of 300 words or under.

Power of Attorney.

A power of attorney, Form 11, accompanies the papers if the patent is taken out through a solicitor of patents, which is almost invariably the case. Patent Offices do not anywhere encourage inventors in taking out their own patents, because it entails so much extra trouble on the offices; besides that, the drawings and documents must reach a certain standard of excellence or they will be rejected as informal, and this standard, those who are unaccustomed to the work, are unable to attain. In the United States Patent Office it is necessary to have an accredited agent in

Washington, U. S., who may attend and assist the examiner when examining the application; besides that, the practice in the Patent Office on appeals, interferences, etc., is very intricate, more so than in any Dominion Court of law, and calls for a regular practitioner, etc.

It is well nigh impossible for an ordinary inventor to obtain a patent himself, without employing a patent solicitor, he would be blocked and delayed at every step; indeed, the Patent Office in Washington, U. S. A., could not well be carried on without the aid of duly qualified patent solicitors.

On a Bequest.

If the right to obtain the patent be bequeathed and the inventor be dead, Form 3, Appx. I., adapted for the petition for a legatee, must be signed by the party to whom the invention has been bequeathed, who must make oath that the person, named as inventor, was the inventor (no special form of oath has been prescribed by our forms), and he must also sign the specification and power of attorney; and a certified copy of the probate of the will must accompany the petition.

Defect in Canadian Form of Oath.

The oath prescribed in Canada, whoever may take it, does not, but should state whether the invention has been previously patented in the United Kingdom or any of its possessions or colonies, although as pointed out in note (*a*), section 8, through the wording of this section, this is not material as to these countries; it should certainly refer to previous foreign patents, if there be any, or if not, it should be so stated, as is the case in the States, especially as the Canadian patent, under section 8, is limited to expire at the earliest date on which any foreign patent for the same invention expires.

Legal Representatives as Patentees.

If the legal representatives are to obtain the patent, Form 5, Appx. I., is utilized, and the administrator or executor must make the oath as to the death of the inventor, and that the person named as the inventor was the inventor; no special form

is provided; probate of the will or letters of administration, as the case may be, should accompany the application.

When the inventor is not alive to sign the specifications, Form 16, Appx. I., is to be followed, when drawing the specifications for the legal representative, the assignee or legatee to sign.

26. Every patent issued for an invention shall be assignable in law, either as to the whole interest or as to any part thereof, by any instrument in writing; but such assignment, and every grant and conveyance of any exclusive right to make and use and to grant to others the right to make and use the invention patented, within and throughout Canada or any part thereof, shall be registered in the Patent Office in the manner, from time to time, prescribed by the commissioner for such registration; and every assignment affecting a patent for invention shall be null and void against any subsequent assignee, unless such instrument is registered as hereinbefore prescribed, before the registration of the instrument under which such subsequent assignee claims. 35 V., c. 26, s. 22.

Prior Legislation.

NOTE.—In the Act of 1869, sec. 22, there is a provision similar to the foregoing section 26; and in C. S. C. (1859), c. 34, consolidating the Acts of 1849 and 1851, there was the foregoing provision as to registration of assignments, but providing no disability or penalty in the event of failure to register, the latter part of the section having been first added in 1869.

In *Dagleish* v. *Conboy*, 26 U. C. C. P. R., 254 (1876), Harrison, C. J., takes up the question of assignments, and refers to the similarity of the foregoing provision (which is the same as in the Act of 1872), with sec. 11 of U. S. Patent Act of 1836, and quotes Curtis, 4th ed., sec. 178. The dissimilarity, however, is, that this U. S. provision referred to by Harrison, C. J., provides no penalty in the event of failure to register, and is the same as the provision in our Con. Stat. (Can.), c. 34 (1859). Harrison, C. J., however, quoted the wrong Act, and should have referred to the United States Act in force at the time he gave judgment, which further provides that "an assignment, grant or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, *without notice*, unless it is recorded in the Patent Office within three months from the date thereof: *Vide*, also, section 4898, Revised Statutes U. S., and section 36 of Act of 1870, U. S."

This U. S. enactment is like the provision in our present Act, but it contains the words "without notice," as well as "subsequent purchaser or mortgagee for a valuable consideration," not in ours, so that it would appear that if an assignee for value in the States had express notice of a prior assignment, the mere prior registration of his own assignment within the three months mentioned would avail him nothing; whereas, in Canada, nothing is said about notice or valuable consideration, or any time within which registration should be made; so that it is more in the nature of a race for registration in Canada, where prior registration by a subsequent assignee might avail, even with express notice of a prior assignment, where the element of fraud does not come in.

Interest Saleable at Common Law.

Harrison, C. J., states: "The beneficial interest which a patentee of an invention acquires in his invention may, at common law, be sold, and, subject to the provisions of the statute, assigned in the same manner as any other property acquired by personal industry: *Vide Cartwright* v. *Arnott*, 2 B. & P., 43."

Documents Which Should Be Written.

"The statute does not require a mere contract of sale to be in writing."

"An assignment by the express provision of the Canadian Statute must be in writing."

"The interest, therefore, which a patentee may sell and assign is either his whole interest for the whole or part of Canada, or a part interest for the whole or part of Canada: *Vide Walton* v. *Lavater*, 8 C. B. N. S., 162.

What May Be Registered.

The instruments to be registered are,

1. An assignment of the whole interest in a patent throughout Canada.
2. An assignment of the undivided part of a patent throughout Canada.
3. The grant or conveyance of right to make and use the thing patented in some specified part of Canada, to the exclusion of the patentee.

[N. B. BY ED.—Since the Act of 1892 a mortgage or any other document affecting or relating to a patent may also be registered.]

A License Need Not Be Registered.

"If the grant be not an interest, either for the whole or some part of Canada, to the exclusion of the patentee, but at most the right to make, vend or use the subject matter of the patent concurrently with the patentee, or with other grantees under him, it is in the nature of a license and need not be registered: *Protheroe* v. *May et al.*, Web. P. C., 411; *Farrington* v. *Gregory*, 4 Fisher, 12; *Gaylor* v. *Wilder*, 10 How., 477.

Assignment.

"An assignment, then, must be a grant which vests in the grantee the right to the whole patent or some undivided part of it, or to the whole or some undivided part of some territorial interest, to the exclusion of the patentee.

In *Perry* v. *Corning*, 7 Blatch., 195, the patentee had transferred all his right, title and interest in certain letters patent to manufacture and to sell the same in the States of New York and Connecticut; it was contended that this was not an assignment, but the Court held it was. The patentee was excluded from all interest within the specified district.

In the case of *Hussey* v. *Whitely*, 2 Fisher, 123, where there was an exclusive right to make and sell in twenty-three counties of Ohio, but the patentee reserved the right to send machines of his own manufacture into the territory. This was held to be a license.

"I do not read the Act as providing that registration is essential to the validity of an assignment as between the immediate parties thereto, but only necessary to secure priority as against a subsequent assignee."

The first U. S. Patent Act (1793) made registry essential to the validity of an assignment: *Dobson* v. *Campbell*, 1 Sumner, 319; but the existing U. S. Act only requests registry to secure priority as against a subsequent assignee: *Perry* v. *Corning*, 7 Blatch., 61; *Pitts* v. *Whitman*, 2 Story, 609; Harrison, C.J., in *Dagleish* v. *Conboy*, *supra*.

Licenses.

The document is a license, if it does not convey the entire monopoly or an undivided interest therein, throughout the territory to which it refers: *Gaylor* v. *Wilder*, 10 How., 494 (1850).

The following then have been held to constitute licenses merely:

A right to make and sell but not to use: *Hayward* v. *Andrews*, 14 Brodix, 276, 106 U. S., 673 (1882); *Waterman* v. *McKenzie*, 20 Brodix, 607 (1891).

A right to make and use but not to sell: *Mitchell* v. *Hawley*, 16 Wall., 544 (1872).

A right to use and sell but not to make: *Hamilton* v. *Kingsbury*, 17 Blatch., 265 (1879).

A right to make, to use, and to sell to be used, for certain purposes, but for no other: *Gamewell Telegraph Co.* v. *Brooklyn*, 14 Fed. Rep., 255 (1882).

The right to make, the right to sell, and the right to use, are each substantive rights; but the right to make would be nugatory unless it also implied a right to sell or to use. Either of these

last two rights will be implied by surroundings: *Steam Cutter Co.* v. *Sheldon*, 10 Blatch., 8 (1872), but both will not be implied in a license to make: Walker, sec. 297.

An agreement granting the "sole and exclusive right and license to manufacture and sell" the patented article "throughout the United States" held not to include the right to use such patented articles, at least if manufactured by third persons, and construed to be a mere license: See *Waterman* v. *Mackenzie*, Sup., Ct. U. S. (decided February 2nd, 1891), 20 Brodix, 607, 138 U. S., 252.

If the patentee retains a right to manufacture, then it is a mere license: See *Green* v. *Watson*, 10 App. Rep. (Ont.), p. 119, *per* Burton, J., and the party to sue is the patentee; an assignee, however, has the right to sue: *S. C.*

Assignment in U. S. A.

An assignment is an instrument in writing conveying either (1) the whole patent, comprising the exclusive right to make, use and vend the invention throughout the United States; or (2) an undivided part or share of that exclusive right; or (3) the exclusive right under the patent within and throughout a specified part of the United States; and vests in the assignee a title in so much of the patent itself, with a right to sue infringers alone in the (1) and (3) cases, and jointly with the assignee in the (2) case: *Waterman* v. *McKenzie, supra.*, 614.

Any transfer short of one of these is a mere license, giving the licensee no title in the patent, and no right to sue at law in his own name for an infringement. Any rights of the licensee must be enforced through or in the name of the owner of the patent, and perhaps, if necessary, to protect the rights of all parties, joining the licensee with him as plaintiff: *S. C.*, p. 614.

Effect of Registration.

Registration does not avail in United States of America in favour of a subsequent purchaser who had actual notice: *Continental Windmill Co.* v. *Windmill Co.*, 8 Blatch., 295 (1871); nor a subsequent party who paid no valuable consideration: *Saxton* v. *Aultman*, 15 Ohio, 471 (1864). A merely good consideration in the States will not support an assignment as against a prior

unrecorded assignment for value; whereas in Canada it might under the wording of our Act have such an effect.

And in Canada from 12 Vic., c. 24, up to the Patent Act of 1869, it was provided, that the assignment shall be recorded in the office of the Provincial Secretary or Minister of Agriculture, as the case may be, within two months from the execution thereof.

Section 26, Whence Derived.

Our section 26 is a sort of melange of sec. 11, of the U. S. Patent Act, 1836, and (as to disability for non-registration) of sec. 4898, R. S. U. S., now in force; but, this latter refers specifically to a subsequent purchaser or a mortgagee for a valuable consideration without notice, and to recording in the Patent Office within three months, whereas our section 26 is silent as to these last matters.

Anomaly in Section 26.

The effect of copying, almost verbatim, sec. 11 of the Act of 1836 (U. S.), has introduced an anomaly into our section 26, where the term "any exclusive right to make and use, and to grant to others the right to make and use" occurs, and which term found its way into our Patent Act of 1849; for we shall see under section 37 of this Act that now, no such thing as an "*exclusive*" right to make and use exists in Canada two years after the date of the patent; under no circumstances, after said two years, can there be an "*exclusive right*" to use, although there might be (*vide* Note, section 37) under certain circumstances, an "*exclusive right*" to supply a manufactured article, such as in the Goodyear rubber patent for the product, if the patentee is able to supply the whole demand in Canada. Under the Patent Act of 1869 this obligation to manufacture or supply the patented article was first enacted in Canada, and the "*exclusive right*" merely existed for three years, until the Act of 1872, when it was reduced to two.

This section should be amended as to its wording, by leaving out the words "any exclusive" for this term "exclusive" does not tally very well with the provisions of the 37th section. In this section 26 we retain the wording of the old Act of 1849, unmodified by the change, which was for the first time introduced by the Act of

1869, as to manufacture and importation and the creation of *quasi* statutory licensees. In reading U. S. cases bearing on this branch of assignments, etc., it cannot be too strongly borne in mind that in the States an "*exclusive right*" in a patent or patented article still exists, there being no obligation to manufacture or license any person, the patentee being the untrammelled owner.

Compulsory Licenses in Great Britain.

In England, also, a patentee used to be an untrammelled owner, as is still the case in the United States; but, by section 22 of the Patent Act of 1883 "*compulsory licenses*" were first introduced; the Board of Trade having power, on petition of any person interested, to order the patentee to grant licenses on such terms, as to royalties and security, for payment, etc., as the Board may deem just, which order may be enforced by "*mandamus*"; the petitioner must show that by reason of the default of a patentee to grant licenses on reasonable terms: that,

(*a*) The patent is not being worked in the United Kingdom; or,

(*b*) The reasonable requirements of the public, with respect to the invention, cannot be supplied; or,

(*c*) Any person is prevented from working or using, to the best advantage, an invention of which he is possessed.

(*c*) Refers to a case where a patentee cannot work his invention, by reason of its involving the use of another patented invention, where the owner of the latter will not grant a license, or puts on a prohibitory price.

There is no appeal from the Board of Trade, who act "*judicially*"; the parties, therefore, have a right to be heard and to adduce evidence for its consideration. The Board may be compelled to hear and determine judicially by "*mandamus*" from The Queen's Bench Division, H. C. J.: *Vide* Tapping on Mandamus, c. 3, p. 12.

The Board need not hear agents or counsel, unless they choose, but only the parties themselves.

In Whom Interests May Be Vested.

Interests in patents may be vested in assignees, in grantees of sectional rights, in mortgagees, and in licensees.

Assignees.

(1) An assignee is a transferee of the whole interest of the original patent or of an undivided part of such whole interest extending to every portion of Canada. The assignment must be written or printed and duly signed, and should be registered to ensure priority.

Grantees.

(2) A grantee acquires by the grant the right under the patent, to make and use, the thing patented, within and throughout some specified part of Canada, excluding the patentee therefrom. The grant must be written or printed and duly signed, and should be registered to ensure priority.

N. B.—Assignees and grantees are those specially referred to in this section 26, though in fact both may be called assignees.

Mortgagees.

(3) A mortgagee is one who takes an interest in a patent under a mortgage, which must be written or printed and duly signed; although not specially referred to in section 26, as it is in the U. S. section, a mortgage is a conditional assignment, and may also be registered under the Patent Act amendment, 1892 (Can.) for $2, as a document "affecting or relating to a patent."

Licensees.

(4) A "licensee" takes an interest less than or different from either of the others.

License to Be Written (Can.).

A license must also in Canada be in writing, by reason of section 29 of this Act, and be duly signed; but need not be registered; although like a mortgage, it may be registered, as may be often advisable to be done.

By the 7th sec. 14 and 15 Vic., c. 79, a license must be in writing: See *Smith* v. *Mutchmore*, 10 U. C. C. P., p. 391: and this appears to have been the case ever since: See also *Dagleish* v. *Conboy*, 26 U. C. C. P. R., 254 and sec. 29 Patent Act, Canada.

In the United States a license may be "*oral*," but if written or printed, must be duly signed.

License to Be Written (Eng.).

Formerly in Great Britain a license to use a patented article need not have been made under seal: *Chanter* v. *Johnson*, 4 M. & A.; but the effect of the prohibiting clause in modern Letters Patent seems to make it compulsory that the license must now be under the hand and seal of the patentee, that is to say, it must be by deed: *Vide* Frost on p. 326.

As a license must be granted by deed it is not necessary that there should be any consideration at all.

The form of English patent provides that no person shall use the invention "without the consent, license or agreement of the said patentee in writing under his hand and seal": *Vide* Frost, p. 332. If the license, which is the lesser thing, must be in writing, "*a fortiori*" the assignment which is the greater thing must also be: Lord Ellenborough in *Power* v. *Walker*, 3 M. & W., 9.

Any instrument affecting or relating to a patent is capable of registration, in Canada, since the Act of 1892, no matter what may be its length, for the sum of $2; all such instruments, capable of registration, should identify the patent by date and number, or if the invention be unpatented, the name of the inventor, the serial number and date of the application should be stated.

As to the definition of the various forms of assignment: *Vide Waterman* v. *Mackenzie*, 20 Brodix, 607 (1891).

Mortgage—U. S.

A mortgage of a patent is recognized by section 4898 of the Revised Statutes, U. S. As it conveys no larger interest than an assignment, it does not require sealing, witnessing or acknowledgment, for an assignment or grant requires neither so far as Federal Courts are concerned. If action be brought on it in a State Court, it should conform to the formalities of mortgages required by the laws of the State.

A mortgage by a patentee vests in the mortgagee the whole title to the patent rights, subject to be defeated by performance of the condition; and the right of possession to the incorporeal property is in legal effect delivered to the mortgagee at the time of recording the mortgage at the Patent Office: See *Waterman* v. *Shipman*, 64 O. G., p. 713 (1893).

Mortgages in the States are regarded as absolute assignments until cancelled with the written consent of both parties or by the decree of a competent Court; the same rule would, no doubt, prevail in Canada, although there is no special provision to this effect.

An assignment of a patent for a machine will not convey any patent for the process, in the performance of which the machine finds its only utility: *Downton* v. *Manufacturing Co.*, 9 Fed. Rep., 402 (1879); *Downton* v. *Allen*, 9 Fed. Rep., 771 (1881).

An assignment by a corporation in the United States of America need not be under its corporate seal, but may be executed in the name of the corporation and by its proper officer: See *Gottfried* v. *Miller*, 104 U. S., 528 (1881). In Canada it is usual to have the assignment by a corporation under seal; and this should particularly be the case if intended for England, its colonies, or possessions.

Rights of action for past infringement are not conveyed by any mere assignment of the patent: See *Moore* v. *Marsh*, 7 Wall., 515 (1868); but may be conveyed, if rights of action are specially mentioned: See *Hamilton* v. *Rollins*, 3 Ban. & Ard., 160 (1877); *Hayward* v. *Andrews*, 12 Fed. Rep., 786 (1882).

Parol Evidence to Explain.

Parol evidence may be admissible to explain an ambiguous assignment, if it points to collateral documents, or such surroundings as throw light upon the words: See *Read* v. *Bowman*, 2 Wall., 591 (1864); *Witherell* v. *Zinc Co.*, 6 Fish., 50 (1872); if unsolvable ambiguities remain, they should be construed against the grantor: See *May* v. *Chafee*, 2 Dill., 385 (1871).

In the States where a patent is to issue to an assignee, the assignment must be recorded in the Patent Office not later than the day on which the final fee is paid after the allowance of the patent; if under 300 words $1 is chargeable, one original and a copy is to be forwarded; in Canada a duplicate original is forwarded, and the fee is $2.

In England Registration Essential.

In England also, by sec. 23 of the Patent Act of 1883, patents, assignments and licenses must be registered, and no action is maintainable until after such registration: *Vide Chollett* v. *Hoffman*, 26 L. J. Q. B., 249; *Re Morgan's Patent*, 24 W. R., 245, etc.; and by sec. 87 of Act of 1883 the registered proprietor has absolute control.

Assignment from an Employé.

A manufacturing corporation which has employed a skilled workman for a stated compensation to take charge of its works and to devote his time and services to devising and making improvements in articles there manufactured, is not entitled to a conveyance of patents obtained by him while so employed, in the absence of express agreement to that effect: *Dalzell* v. *Dueber Watchcase Manufacturing Co.*, Sup. Ct., U. S., 63 O. G., p. 1381 (1893).

An oral agreement for the sale and assignment of the right to obtain a patent for an invention is not within the Statute of Frauds, nor within sec. 4898, Rev. Stats., U. S., requiring assignments to be in writing, and may be specifically enforced in equity on sufficient proof thereof: *S. C.*

"Without Notice."

It would be better if our section followed the wording of the U. S. section where the words "without notice" occur, thus making the assignment against a subsequent purchaser or mortgagee for a valuable consideration, "*without notice*," void in default of registration.

As our section now stands, it goes further than our Registry Act, c. 114, R. S., Ont. (1887), sec. 82, relating to lands, which provides that "priority of registration shall prevail unless before the registration there has been actual notice of the prior instrument by the party claiming under the prior registration."

Slipping in a subsequent assignment for registration, with full knowledge of the prior assignment for value, and with knowledge of its existence at the time the subsequent assignment was obtained, for the purpose of cutting out and rendering null and void a prior unregistered conveyance, can hardly be the intention of this section 26.

No Time Limit in Canada.

There ought also to be a time limit within which registration should be made after the date of the document, say three months, as in U. S. A.

Illustrations.

After an assignee has, under an agreement with a patentee, manufactured and sold machines, he is estopped from denying that the patentee was the original inventor of the device when called upon for an accounting: *Kinsman* v. *Parkhurst*, 18 How., 289.

A contract or assignment referring to an original patent refers also to the reissue: *Tool Co.* v. *Judd*, 3 Fish., P. C., 141.

An agreement by an assignor "to protect the sale from infringements," is a warranty that the sale and use of the device would infringe no existing patent: See *Croninger* v. *Paige*, 4 N. W. Rep., 106.

A patent that a Court has declared void may be reissued: See *Mathews* v. *Flower*, 25 Fed. Rep., 830.

A contract by an employé to permit his employers to apply for and obtain a patent for a devise he has invented, may be proved by parol in the United States of America: See *Lockwood* v. *Lockwood*, 33 Iowa, 509; but this will not apply to Canada, where the contract must be in writing.

A man can pass by grant or assignment that which he now possesses, and which is in existence at the time, either actually or potentially, unless he uses other language which imports an intention to grant what he does not now possess, and what is not now in existence; in the latter case, the language acts as a covenant or contract which a Court of Equity will carry into full effect when the right or thing comes "*in esse*": See *Woodworth* v. *Sherman*, 3 Story, 171.

A deed to a dead man has hitherto been held to be a nullity, and though made "*to him and his heirs*," the word heirs was not a word of purchase carrying title to the heirs but only qualifying the title of grantee: *Hunter* v. *Watson*, 12 Cal., 363; *Price* v. *Johnston*, 1 Ohio, 390; *Wood* v. *Ferguson*, 7 Ohio, 228; *De la Vergne Refrigerating Co.* v. *Featherstone*, 58 O. G. (1842); but

these cases have been recently overruled in the U. S. Sup. Ct. by *De la Vergne Refrigerating Machine Co.* v. *Featherstone*, 147 U. S. Rep., p. 209, relating to a patent deed, and was decided January 9th, 1893. By this Supreme Court decision it now means "*to him* or *his heirs*," and the patent enures to the benefit of his heirs.

NOTE.—There is now before Congress a bill to meet the specific case just decided by the Sup. Ct., U. S., which, in view of this decision, may not be necessary; so that if it should happen, that between the time the application for a patent was allowed in U. S. A. and the final fee paid, the applicant should die and the patent issue in the name of the deceased applicant, on filing a certified copy of the probate of will or of letters of administration, the executor or administrator would, in the U. S. Patent Office, be recognized as clothed with authority to deal with or assign the Letters Patent. Under a similar state of facts in Canada, it is probable that the personal representative of the deceased, would, on filing the requisite documents, be also recognized.

A patent having been reissued to the inventor, will not be reissued also to his assignee, whose assignment was not recorded before the reissue to the inventor: See *Ex parte* Whitely, C. D. (1869), p. 79.

A patentee cannot sell his right to another, and then buy or obtain control of an older patent, and through such older patent dispossess his assignee of the full benefit of what he purchased: See *Curran* v. *Burdsill*, 20 Fed. Rep., 835.

"*Legal representatives*" includes assignees as well as executors and administrators in its terms: See *Hamilton* v. *Kingsbury*, 15 Blatch., 64; also includes assignees, etc., by sec. 2 of the Patent Act, Can.

The mere assignment of a patent gives the assignee no right to damages or profits already accrued, unless the language of the instrument shows that such was the intention: See *Merriam* v. *Smith*, 11 Fed. Rep., 588; *New York Grape Sugar Co.* v. *Buffalo Grape Sugar Co.*, 18 Fed. Rep., 638.

The U. S., sec. 5046, R. S., vests all patent rights at once in the assignee of a bankrupt; a recorded assignment from an administrator of a bankrupt made after the bankruptcy, cannot pre-

vail over an assignment to the assignee in bankruptcy: See *Prince* v. *Brandon Manufacturing Co.*, 4 Ban. & Ard., 379. (In Canada we have no such special enactment.)

A receiver of an insolvent debtor is entitled to a patent right belonging to the debtor; and a Court is empowered to order the debtor to convey the right to such receiver, if such conveyance is necessary: See Petition of Keach, Receiver, Duryee, p. 110.

In the U. S. A. an assignment of an interest in a patent, to be valid, must be in writing; it cannot be evidenced by parol testimony: See *Baldwin* v. *Silby*, 1 Cliff., 150. (N. B.—When there is in U. S. the relation of employer and employé, this rule may be modified.)

Assignments of patents in U. S. A. are not required to be under seal: *Gottfried* v. *Miller*, 104 U. S., 521.

Assignments of patents in U. S. A. are not required to be recorded in order to be valid between the parties thereto: *Holden* v. *Curtis*, 2 N. H., 61; *Moor* v. *Base*, 11 Iowa, 198.

Under the statutes of New York, assignments duly acknowledged before a notary are sufficiently proved, and it is not incumbent upon the complainant to prove the signatures of the assignors: See *Houghton* v. *Jones*, 1 Wall., 702; *New York Pharmical Association* v. *Tilden*, 14 Fed. Rep., 740.

It is not necessary in U. S. A. that all the administrators should join in an assignment of a patent. A deed by one of them will convey the entire interest: See *Wintermute* v. *Redington*, 1 Fish., 239.

An assignment of an expired patent is void *as an assignment*, although it may be good *as a power of attorney* to collect for infringements: See *Bell* v. *McCullough*, 1 Fish., 380.

A certificate that A "is the owner of five fortieth parts of the Letters Patent" is not such an assignment as the law requires, and would give the person no interest whatever in the patent: *Hope Iron Works* v. *Holden*, 58 Maine, 146.

If an assignment contains no "*warranty*" but a simple transfer of title the vendee cannot set up a "*parol warranty*," for it must be presumed that the article contains the entire contract: *Jollife* v. *Collins*, 21 Mo., 338.

The "*legal title*" to the patent becomes vested in the assignee

although the patent issued to the inventor, the assignment authorizing the Commissioner to issue the patent to the assignee, not having been recorded until after the issue of the patent: See *U. S. Stamping Co.* v. *Jewett*, 18 Blatch., 469.

An owner of a patent who conveys by deed "all his property and estate whatsoever and whensoever of every kind and description" carries the right to the patent: See *Railroad Co.* v. *Trimble*, 10 Wall., 367.

A Court of Equity in U. S. may direct the sale of the interest of an inventor in his patent in order to satisfy a judgment debt, and the Court may appoint a trustee to execute the same: See *Murray* v. *Ager*, 20 O. G., 1311.

A Court of Equity will not release a purchaser of a patent right from liability upon his bond, if there were no fraud on the part of the assignor, notwithstanding the patent may be void: See *Cansler* v. *Eaton*, 2 Jones' Eq. (N. C.), 499; *Stevens* v. *Head*, 9 Vt., 174.

When a patent owner assigns certain patents, "together with the right to modifications, improvements or reissues thereof, and all other and similar patents in the United States which may be issued to us or any of us, directly or indirectly, in aid of the improvements above specified," such assignment does not cover subsequently invented improvements not covered by the claims of any of the existing patents specified in such assignment: *Stebbins Co.* v. *Stebbins*, 4 Fed. Rep., 445 (1880).

NOTE.—The only idea in common was that of employing the power of either one or two cylinders, as required, so as to economize water; the new device, however, could not be substituted to operate in combination with the device first patented, nor the old device with the new; therefore, the new device was held to be entirely different in the particular feature of construction, and mode of operation, and not an infringement. The action was for infringement, and to compel an assignment of the newly patented invention as coming within the terms of the above, in part, quoted agreement.

"An assignment of an imperfect invention, with all the improvements upon it that the inventor may make, is equivalent in equity to an assignment of the perfected results": *Littlefield* v. *Perry*, 21 Wall., 205.

NOTE.—The above extract from the judgment refers to a case in which the improvement was specifically defined as relating "*to*

an application then pending," the plaintiff agreed that this was an improvement on the original device, and induced defendant to purchase by reason of this agreement.

Void, if Against Public Policy.

A contract wherein one party, in consideration of receiving a license, agrees never to dispute the validity of certain other patents or the licensor's title thereto, is not enforceable, being against public policy: *Vide Pope Manufacturing Co.* v. *Gormully* (1892), Sup. Ct., U. S., 59 O. G., p. 465.

If a license to use covers more time than the thing will last, then there is an implied right to repair or to rebuild that specimen, or to replace it: *Steam Cutter Co.* v. *Sheldon*, 10 Blatch., 8 (1872); Walker, sec. 298.

Implied License in U. S. A. (See also p. 231.)

An actual recovery of money in an infringement suit for unlicensed making and selling a specimen of a patented thing operates as an "*implied license*" to use such specimen: See *Steam Stove Manufacturing Co.* v. *Manufacturing Co.*, 17 Batch., 31; *Gilbert & Barker Manufacturing Co.* v. *Bussing*, 12 Blatch., 426 (1875). If there be user there is an implied contract to pay royalty: See *United States* v. *Palmer*, 19 Brodix, 23 (1888).

For implied license, as between employer and inventor: *Vide Lowther* v. *Hamilton*, 17 Brodix, 396 (1888).

A license to sell does not imply a right to make; but does imply, that a right to use and to sell again shall be conferred on the vendees of the licensees: See Walker, sec. 299.

Where the Government has used, without consent of the patentee, there is an implied license and royalty payable on these facts alone: See *Solomon* v. *United States*, 20 Brodix, 488 (December, 1890).

A license to make and use does not authorize any sale of the thing so made, nor authorize any purchaser to use the same: *Wilson* v. *Stolley*, 4 McLean, 277.

Eviction.

A license does imply that the licensee shall not be evicted from its enjoyment, and such an eviction is a defence to a suit for royalties, after it occurred: See *White* v. *Lee*, 14 Fed. Rep., 791 (1882).

In *Green* v. *Watson*, 2 Ont. R., p. 627 (1883), however, it was held, that a covenant to "warrant and defend W in possession of the patent right," meant "as against all persons having the right to manufacture or sell, and that there was no eviction as against wrong-doers." The question was whether royalties were payable so long as infringements were allowed to go on by wrong-doers, and it was held they were payable; on appeal 10 App. Rep., Ont., p. 113, the Court was equally divided and the appeal dismissed. Burton and Patterson, JJ.A., taking the ground that the covenant bound the patentee to protect against all infringers, and that the rule of construction "to warrant and defend" as applied to lands had no application; and Patterson, J., stated, that a person who pays a royalty ought to be protected against those manufacturing in defiance of the patent right. A patent right is of an intangible nature and not like lands. As there was eviction, the latter view would be in accord with *White* v. *Lee*, 14 Fed. Rep., 791, *supra*, and as the Court of Appeal divided, the original decision is open to question: *Vide* also *Pacific Iron Works* v. *Newhall*, 34 Conn., 167 (1867).

An Eviction will take place when a patent is annulled by a decree of a Court in which an action is brought by the U. S. for that purpose: *Marston* v. *Sweet*, 82 N. Y., 526 (1880).

In the same way an eviction would, doubtless, take place in Canada if a patent were repealed by "*sci fa*" under section 34.

Such an eviction would also occur when the licensee is enjoined from acting at the suit of an owner of a senior patent: See *Pacific Iron Works* v. *Newhall*, 34 Conn., 67 (1867). This case might be cited against the decision in *Green* v. *Watson*, 2 Ont. R., p. 627.

Non-payment of royalty on a specified day, although specially stated that forfeiture will follow such breach, will not work a forfeiture, if non-payment arose from uncertainty as to place of payment and lack of demand by licensor: See *Dan* v. *Boylston*, 6 Fed. Rep., 493 (1880); Walker, sec. 308.

No license is assignable unless it contains words authorizing it: *Vide Rubber Co.* v. *Goodyear*, 9 Wall., 788 (1869); *Hapgood* v. *Hewitt*, 16 Brodix, 412 (1886). The word assigns is usually introduced, but in *Hamilton* v. *Kingsbury*, 15 Blatch., 69 (1878), "*legal representatives*" were held to include "*assigns*" as well as "*executors and administrators*": *Vide* also *Oliver Co.* v. *Chemical Works*, 14 Brodix, 532 (1883).

Where a license is given to a partnership and that partnership is dissolved, and its business continued by one of the partners, the latter is entitled to that license: See *Belding* v. *Turner*, 8 Blatch., 321, though it would be well to get a quit claim from the retiring partners.

Fraud.

A licensee can challenge a patent on the ground of fraud, but the fraud must be a clear case, clearly alleged and made out: See *McDougall* v. *Partington*, 7 R. P. C., p. 223 (1890); *Ashworth* v. *Law*, 7 R. P. C., p. 231 (1890).

A licensee may be held liable to make payments, though the patent had lapsed for non-payment of fees: See *Mills* v. *Carson*, 9 R. P. C., p. 338 (1892).

An assignment of an invalid patent is sufficient consideration in U. S. A. to support a promissory note, where there is no warranty or fraud: *Thomas* v. *Quintard*, 5 Duer (N. Y.), 80 (1855).

Express Warranty.

Express warranties of validity may, of course, be incorporated in assignments, when the assignors will be subject to action for damages in the event of invalidity: See *Wright* v. *Wilson*, 11 Rich. (South Car. L. Rep.), 151 (1856).

In *The Fire Extinguisher Co.* v. *The N. W. Babcock Fire Extinguisher Co.*, 20 Grant, 625 (1873), where the patentees of a machine for extinguishing fire assigned to another the right to manufacture such machines, reserving a certain royalty, with the right to licensee to purchase at a stated sum within one year:

Held, notwithstanding such right to purchase, that the assignee was not entitled to the exclusive right to manufacture, and that the patentees could confer on other parties the right of manufacturing.

N. B.—There was nothing said in the agreement in the foregoing case as to the right granted to the licensees being an exclusive right.

When a party signs a license without reading it he is bound by its terms, unless he lacks capacity to comprehend properly what he is doing: See *McKay* v. *Jackman*, 17 Fed. Rep., 641.

A license to manufacture at a certain place is a personal license, not transferable: See *Searls* v. *Bonton*, 12 Fed. Rep., 140.

A licensee having transferred his license without the consent of his licensor, as required, and having received payments for the use of the machine he cannot assail the validity of the transfer: See *Bloomer* v. *Gilpin*, 4 Fish., 50.

There are three classes of persons in whom the patentees can vest an interest of some kind in the patent. They are (1) an assignee; (2) a grantee of an exclusive sectional right; and (3) a licensee: See *Potter* v. *Holland*, 1 Fish., 327.

The right to manufacture, the right to sell and the right to use are each substantive rights, and may be granted or conferred separately by the patentee: See *Adams* v. *Burke*, 17 Wall., 453; *Jenkins* v. *Greenwald*, 2 Fish., 37; *Steam Stone Cutter Co.* v. *Sheldon*, 5 Fish., 477.

A suit on a license for the recovery of royalties is not a question arising under the patent law and the Federal Courts have not jurisdiction: *Kelly* v. *Porter*, 17 Fed. Rep., 519.

Implied License in U. S. A.

If one of a firm invents a machine, and takes out a patent at the expense of the firm, and the machine is used in the partnership business: *Held*, that no implied license to the member of the firm, not the inventor, arose to make use and vend the patented machine after the dissolution of the partnership: *Keller* v. *Stolzenbach*, 20 Fed. Rep., 47.

Where an employé of a firm made an invention in the direct line of its business while in its pay, and there were circumstances which raised a presumption of an implied license to the firm to sell the invention in its line of business, and where the firm is

developed into a corporation upon the same basis, as the firm was, and where both employé and succeeding corporation continued the same relation to each other as existed between him and the firm: *Held*, that the implied license to the firm was transmitted to its successor, the corporation: (*Hapgood* v. *Hewitt*, 119 U. S., 226; *Oliver* v. *Rumford Chemical Works*, 109 U. S., 75, etc., cited): See *Lane & Bodley Co.* v. *Locke* (decided November 13th, 1893), Sup. Ct., U. S., 65 O. G., p. 1406.

If an employé makes an invention in his employer's time using the latters tools and material, though the invention may be the employé's, the employer, in U. S. A., has an implied license to use that invention in his business, the employer's right is not transferable, and if the employer be a corporation the dissolution of the corporation extinguishes the license: *Hapgood* v. *Hewitt*, 7 Sup. Ct. Rep., 193.

N. B.—In considering these cases of "implied license" it must be borne in mind that in the U. S. A. there is no statutory provision, as in Canada, requiring a license to be "in writing." So an "implied license" cannot arise in Canada in the same way as in the States, and caution must be used in applying the U. S. cases: See under sec. 46 as to only instance of *implied license* in Canada.

Where one has the legal title to a patent and another an equitable title both must be made parties to a suit in an action in equity in U. S. A., to restrain infringement: See *Gamewell Fire Alarm Telegraph Co.* v. *City of Brooklyn*, 14 Fed. Rep., 255.

A deed by which an inventor conveys all his right in an invention, and in or to the Letters Patent that are or may be granted therefor, vests the legal title in the assignee: See *Railroad Co.* v. *Trimble*, 10 Wall., 367.

A licensee, who has manufactured under a patent and paid royalties, cannot escape liability for arrears on the plea that he has taken the assignment under a misrepresentation and concealment as to the invention by the assignee: See *Shaw* v. *Soule*, 20 Fed. Rep., 790.

License to Use How Construed.

A license to use one machine will always be construed to be an authority to use *a machine* unless in express terms it is limited

to the identical machine referred to: *Wilson* v. *Stolby*, 4 McLean, 275.

A license to a person to use an invention "*at his own establishment*" does not authorize its use at one occupied by himself and others: *Goodyear* v. *Providence Rubber Co.*, 2 Fish., 499.

A licensee cannot subdivide and assign the rights granted to him to use or work the patent: *Consol. Fruit Jar Co.* v. *Whitney*, 1 Ban. & Ard., 356.

A mere license to a party without having "his assigns" or equivalent words to them, showing that it was meant to be assignable, is only the grant of a personal power to the licensee, and is not transferable by him to another: *Troy Iron and Nail Factory* v. *Corning*, 14 How., 193; *Goodyear* v. *Providence Rubber Co.*, 2 Fisher, 499; *Baldwin* v. *Sibley*, 1 Cliff., 150; *Bull* v. *Pratt*, 1 Conn., 342, and does not pass to a receiver appointed as supplementary to executions under N. Y. Civil Code: *Waterman* v. *Shipman*, 64 O. G., p. 713.

A licensee cannot put an end to his contract, deny the validity of the patent, and afterwards when the validity of the patent is sustained, set up a license from the patentee as a defence: See *Moody* v. *Taber*, 1 Ban. & Ard., p. 41, 5 O. G., 273.

Although an invention is misnamed in a conveyance, if the deed furnishes sufficient means for correcting the mistake or identifying the thing sold, it will pass title to the invention patented: See *Harmon* v. *Bird*, 22 Wend. (N. Y.), 113.

Joint Owners.

Joint owners are not copartners, and each may in the absence of express contract use his moiety as he sees fit without accounting to the others: *De Witt* v. *Elmira Nobles Manufacturing Co.*, 12 N. Y., Sup. Ct., 301; *Vose* v. *Singer*, 4 Allen (Mass.), 226; *Dunham* v. *Indiana and St. Louis R. W.*, 2 Ban. & Ard., 327.

The amount of license fee is not required to be shown in writing, it may be shown by parol: *Wooster* v. *Simonson*, 20 Rep., 317.

A licensee is at liberty to contest the question whether the articles made by him embody the invention or any material part

thereof, and a stipulation to the contrary in the contract is of no effect: See *White* v. *Lee*, 14 Fed. Rep., 789; but so long as he retains the license he is estopped from denying this: See *Marsh* v. *Dodge*, 11 N. Y., Sup. Ct., 278.

A purchaser who was deceived by the misrepresentations of the vendor is entitled to a recission of the sale: *Pierce* v. *Watson*, 34 Ala., 596; *Hall* v. *Orvis*, 35 Iowa, 366; *Page* v. *Dickerson*, 28 Wis., 694.

A shop right is a personal license and not assignable: See *Gills* v. *Hiefner*, 19 Fed. Rep., 323.

Right to Repair.

He who acquires the right to use a machine takes the right to repair it and to replace parts of it, but not wholly to replace it: *Wilson* v. *Simpson*, 9 How., 109.

Sale and Use.

When A owns certain territorial interests under a patent and B owns other under the same patent. If A sells the patented thing, contracting to deliver it in the territory of B, A is an infringer of the right of B, but if A sells the patented thing in the ordinary course of trade to C, knowing that C will take it into B's territory, then neither A nor C is an infringer: *Hobbie* v. *Smith*, 27 Fed. Rep., 656.

Estoppel.

In *Gray* v. *Billington*, 21 U. C. C. P., 288 (1871), an action to pay royalties on a patented cultivator; on demurrer to a plea that after covenanting to pay royalties the defendant discovered the invention was not new, Hagarty, J., for the Court, *held*, the plea was bad and the law clear, following *Lewes* v. *Purser*, 6 El. & Bl., 930; *Hall* v. *Conder*, 2 C. B. N. S., 22, 3 J. N. S., 963.

In *Lewes* v. *Purser* (November 10th, 1856), in the absence of fraud or eviction on a covenant to pay royalties for a patented article: *Held*, on demurrer that the defendant cannot plead that the patent was void.

Hall v. *Conder* (February 20th, 1857): *Held*, in the absence of any allegation of fraud, it must be assumed that the plaintiff

was an inventor, and there was no warranty expressed or implied that he was the true and first inventor, or that the invention was new and useful; but the contract was for the sale of a patent, such as it was, each party having equal means of ascertaining its value, and each acting on his own judgment: Campbell, C. J., p. 53, *S. C.*, stated that, in the absence of a warranty, royalties paid under an agreement are not recoverable.

The doctrine in *Hall* v. *Conder*, was corroborated in *Smith* v. *Buckingham*, 18 W. R., 314, 21 L. J. N. S., 819; and *Dorab Alley Khan* v. *Abdool Azeez*, L. R., 5 Ind. App., 127.

The foregoing are authorities on estoppel to this day.

In the Province of Quebec, however, in *Dery* v. *Hamel*, 7 L. N., 405, Q. B. (1884), it was held that the sale of a right to use an invention contains a warranty that the invention is new and useful—which is directly opposed to *Hall* v. *Conder*, etc.

In *Whiting* v. *Tuttle*, 17 Grant, p. 454 (Ont.), during the existence of a license the licensor cannot dispute the validity of a patent obtained by him and afterwards assigned by him for value to another: Strong, V. C., "You cannot derogate from your own grant," citing *Oldham* v. *Longmead*, 1 Web. P. C., 291; *Chambers* v. *Crichley*, 33 Beaven, 374; Kerr on Inj., 424.

In *Gillies* v. *Colton*, 22 Grant, p. 123 (1875), a preliminary injunction having been granted it was held at the hearing, Blake, V. C., that the defendant was estopped from questioning the validity of the patent which he had assigned: *Crossley* v. *Dixon*, 10 H. L., 290; *Walton* v. *Lister*, 29 L. J., C. P., 275, etc., cited; and in *Owens* v. *Taylor*, 29 Grant, 210 (1880), plaintiff who had merely an assignment of county rights had the patentee Powell, joined as co-plaintiff: *Held*, that notwithstanding the invalidity of the patent, plaintiff was entitled to recover the amounts payable to him under the license during the currency thereof: *Vide Burr* v. *Duryee*, 2 Fish., 285 (1862).

In the absence of warranty there is no implication as to validity.

In *Vermilya* v. *Canniff*, 12 Ont. R., 164, relates to an assignment of interest in certain territory in consideration of royalties. Defendant knew before the end of first year of contract that

others were infringing, but he did not complain or repudiate transaction, or refuse to pay, or offer to reassign, or require the alleged infringers to desist, or the patentees to vindicate their patent, and that he had a profitable user to a substantial extent:

Held (by Boyd, C., June 5th, 1886), that in the absence of fraud or warranty, or representation, which induced the bargain and falsified the result, such contract was a purchase of an interest in an existing patent. There was no implication as to patent being indefeasible: (*Vide* Walker, secs. 283 and 307); *Hall* v. *Conder*, 2 C. B. N. S., 67 and *Smith* v. *Neale*, 2 C. B. N. S., 22, commented on and approved.

"The contract was for plaintiff's right, such as it was, without regard to whether it could be sustained on litigation or not": (Wells, J., in *Smith* v. *Neale*.)

In *Beam* v. *Merner*, 14 Ont. Rep., p. 412, action to recover royalties.

On appeal to Div. Ct. C. P. *Held* (May 22nd, 1886), sustaining original judgment, that defendants, having used plaintiff's invention under the license, could not raise any objection, as to the validity of the patent.

Parol Evidence Cannot Vary the License.

Held, that parol evidence was not admissible to vary the deed, following: *McNeely* v. *McWilliams*, 13 App. Rep. (Ont.), 324.

As to royalties being payable: *Gray* v. *Billington*, 21 U. C. C. P., 288, was referred to with approval.

Employé Estopped.

In *Bonathan* v. *Bowmanville Furniture Manufacturing Co.*, 31 U. C. Q. B. Rep., p. 413 (1871).

The plaintiff having been employed by the defendants expressly to make or improve the machines, was estopped from claiming to be the inventor as against the defendants.

In *Lean* v. *Huston*, 8 Ont. Rep., 521. The plaintiffs being patentees in the States, employed one of defendants, a mechanic, to make a model, embodying some improvements, and placed the U. S. patent in his hands, and under pledge of secrecy, imparted his

ideas as to improvements; defendant so employed took out the patent for himself.

In an action for an injunction and to set aside the patent, *Held*, that plaintiffs was entitled to an injunction and that defendants were estopped from setting up title against plaintiffs, although the latter's title was not good against the public.

Consumers' Gas Co. of Danville v. *American Electric Construction Co., Limited*, U. S. Cir. Ct. of App., 9th Dist. (April 22nd, 1892), 60 O. G., p. 738. In an action for balance due on a written contract, defendant pleaded *inter alia*, that he had been served with notice of a claim for damages for infringement by use of the machinery furnished by plaintiff: *Held*, that as purchaser having had the full use and enjoyment and undisturbed possession of it, he cannot, in the absence of fraud, withhold the purchase money, because of an alleged liability on his part to a patentee for infringement.

Estoppel on Bankruptcy (Eng.).

It is not necessary for one or two, or more defendants in the same interest to deliver particulars of objection, and where the patentee had gone into bankruptcy, and his trustee had assigned, the patentee *was not estopped* from setting up the invalidity of the patent on the ground of want of novelty and insufficiency of specification: *Smith* v. *Cropper*, 10 App. Cas., 249.

Estoppel Not Upheld.

In *Grip Publishing Co.* v. *Butterfield*, 11 App. R. (Ont.), 145, relative to infringement of a black leaf check-book.

One Carter having assigned one-half interest to defendant B, on dissolution of partnership four months after this half interest was reassigned by defendant to C, who conveyed to plaintiffs. Boyd, C. (22nd June, 1882), at the original trial: *Held*, that following *Chambers* v. *Crichley*, 33 Beav., 374, the defendant was estopped from saying, on account of his dealings as partner, that the non-user or rejection of "a tape" destroys the patent or materially affects its combination of parts. *No estoppel in this case.*

On appeal to the Court of Appeal (5th September, 1884),

Patterson, J. (delivering the judgment of the Court), *held*, that *Chambers* v. *Crichley* did not apply so as to estop defendant from disputing the validity of the patent, notwithstanding his reassignment; and that the judgment of Malins, V.C., in *Axmann* v. *Lund*, L. R., 18 Eq., 330, is very much against estoppel.

MEMO.—There is nothing to be learnt further from this case. The judgment of the Sup. Ct., 11 Sup. Ct. R. (Can.), p. 291, held that there was "*infringement*," and that the statement of claim of defendant admits "*utility*," and the Sup. Ct. upheld the original judgment, which contains this strange proposition, viz.: that an element of the combination "*a tape bound across the end of a black leaf*," which the plaintiff, in his patent, claimed to be an essential part of his invention, and which was abandoned on manufacture as expensive and impracticable, might be dropped out of his claim as immaterial; which claim remained as good as ever. The inventor claimed it was essential, and made it a prominent feature as ensuring cleanliness, while the Court held it was not essential. This is contrary to the principles laid down in *Vance* v. *Campbell*, 1 Black, 430 (1861); *Le Fever* v. *Remington*, 13 Fed. Rep., 86 (1882); *Prouty* v. *Ruggles*, 16 Peters, 341 (1842); *Dunbar* v. *Myers*, 94 U. S., 187 (1876); *Fuller* v. *Yentzer*, 94 U. S., 297 (1876); *Water Meter Co.* v. *Desper*, 101 U. S., 332 (1879); *Rowell* v. *Lindsay*, 15 Brodix, 441 (1885); *Peters* v. *Active Manufacturing Co.*; and a large number of Supreme Court cases collected on pages 454, 455, 15 Brodix.

The original judgment in *Grip* v. *Butterfield* also *held*, that defendant claiming to work under an existing patent granted to him subsequent to the date of plaintiff's patent, that the Court had jurisdiction under *Morgan* v. *Seaward*, 2 M. & W., 544, 561, etc., to declare defendant's patent void; whereas, the proceedings for impeachment in Canada are *specially* pointed out in section 34, by "*sci. fa.*," as the mode of procedure as to which the Exchequer Court *now* has concurrent jurisdiction.

Although the Court of Appeal agreed, at the outset, that there was infringement, yet the judgment in effect was, that there was *no* infringement.

Headnote Erroneous.

The headnote in *Grip* v. *Butterfield*, both in App. Rep. Ont. and Sup. Ct. Rep., noted in Ont. Digest (1880-90), p. 1550, *that the patent was void for want of novelty*, is erroneous; in that the Court of Appeal held that it was void as not being "*a patentable combination*," and the Supreme Court held that it *was patentable as a combination*, and restored the original judgment.

Plaintiff's counsel in 11 Sup. Ct. R., Can., 291, cited *Dudgeon* v. *Thompson*, L. R. 3, App. Cas. and other cases, to support the view, that the omission of "*the tape*" from the claim would not prevent the defendants from being liable; whereas these cases support *just the opposite view*, viz.: that the omission of an element in a claim, whereby the same effect was produced, would avoid the original combination.

In *Carter* v. *Hamilton* (reported in 3 Ex. Ct. R., Can., p. 351 (1893): L. N., vol. 16, p. 345; Can. L. J., vol. 29, p. 693; Can. L. T., vol. 13, p. 427), this Carter patent for a black leaf check-book was again in question, and in the judgment of Burbidge, J., of the 26th June, 1893, it was *held* that a check-book, with carbon leaf bound in next the cover, had been anticipated. "*The tape*" is then treated as *an essential part* of the claim, disregarding the judgments in *Grip* v. *Butterfield* aforesaid; and, referring to the Carter's patented improvement in counter check-books, the judgment states: "The leading feature of which is the tape, attached to the black or carbon leaf, for the purpose of enabling the person using the book to turn over the leaf or back without soiling the fingers." It was also *held* that the plaintiff's patent was limited to the use of "*the tape*," and that the defendants did not infringe by using a clean margin on the carbon leaf for a like purpose.

NOTE.—The Sup. Ct., Can., judgment in *Grip* v. *Butterfield*, *supra*, throughout was ignored by Burbidge, J. This case, *Carter* v. *Hamilton*, was heard on appeal before the Supreme Court (Can.), in March, 1894, and on May 1st, 1894, judgment was given dismissing plaintiff's appeal, with costs, and sustaining the judgment of Burbidge, J.

In a recent case (unreported) of *The Canadian Mineral Wool*

Co. v. *Montgomery*, tried before Ferguson, J., at Toronto, on the 13th and 14th November, 1893, in which plaintiff's patent contained four elements:—(1) mineral wool; (2) indented paper; (3) reinforce paper; and, (4) asbestos paper. In order to make out infringement it was necessary that the plaintiff should drop out the "*indented paper*," which made with the "reinforce paper" dead air cells, which the patent showed to be an essential part of the invention; although in actual practice, like "the tape" in the *Grip* v. *Butterfield* case, *supra*, the "indented paper" and the so called dead air cells had been abandoned in actual practice, yet, notwithstanding *Grip* v. *Butterfield* which was urged as an authority, Ferguson, J. refused to admit this, and held plaintiff strictly to the elements claimed in the specification, with the result that no infringement was made out, and the plaintiff's case was dismissed with costs.

A License Determinable.

A licensee may repudiate a license and can attack the patent as to subsequent operations, in the event of a suit brought, although he may be liable for royalties up to the time of repudiation: See *Owens* v. *Taylor*, 29 Grant, 210 (1880); (*Haynes* v. *Maltby*, 3 T. Rep.).

In *Noxon* v. *Noxon*, noted in Can. L. T., vol. 14, p. 97; Can. L. J., vol. 30, p. 104, decided January 29th, 1894, by Boyd, C., at Toronto, reported in full 24 Ont. R., p. 401.

The plaintiff was the assignee of certain Letters Patent and the defendants were licensees. The defendants having become owners of a quarter interest in these Letters Patent through assignment from the plaintiff, notified the plaintiff that they would cease to pay royalties after a certain date:

Held, that the parties became at arms length as to royalties by the written notice of determination, and that the plaintiff could not claim payment thereafter as between licensor and licensee.

Boyd, C., states: "A license, by parol, in respect of a patent, is clearly determinable by the licensee at his pleasure, as was stated by the law lords in *Crowley* v. *Dixon*, 10 H. L. Cas., 308, and I see no good reason why the same should not apply to a *written license*, such as the present, which passes no interest,

but merely makes that lawful, which without it would be unlawful; so far as form goes, a mere license, under seal is as much revocable as a license by parol: See *McKenzie* v. *McGloughlin*, 8 Ont. R., 115.

"If an interest is transferred in a patent, then it requires the consent of both parties to put an end to the transfer, but if the transaction is merely permissive on certain terms to invade the monopoly, then the licensee may, at his option, renounce the license and make the machines patented at his peril."

"The difference between a license being in the form and having the effect of a grant is pointed out in the case of *Heap* v. *Hartley*, 42 Ch. D., 468 and is averted to in the earlier Canadian case of *Dagleish* v. *Conboy*, 26 U. C. C. P., 254.

"It may be that the license, as such, was determined by the act of the patentee in assigning the patent according to the doctrine of *Coleman* v. *Fuler*, 1 H. & N., 37."

N. B.—Though the licensee may determine a license, there is nothing to show that the licensor can withdraw his license, in the absence of express provision in the written document creating it.

27. In cases of joint applications or grants, every assignment from one or more of the applicants or patentees to the other or others, or to any other person, shall be registered in like manner as other assignments. 35 V., c. 26, s. 10, *part*.

NOTE.—The section 10 of the Patent Act of 1872, of which the foregoing is a revision, was as follows:—

"In cases of joint applications, the patent shall be granted in the name of all the applicants, and in such cases any assignment from one of the said applicants or patentees to the other or to any person shall be registered in like manner as other assignments."

The meaning is now materially altered; the term *patentees*, in this section 10 of the Act of 1872, has no sense, for it relates to cases of joint *applications* for a patent.

Joint Applications.

The "joint applications" referred to in section 27 refer to joint applications of: (1) two or more inventors; or (2) to an inventor and an assignee or assignees; or (3) joint inventors and an assignee or assignees; it is only *as to the two latter classes*, in the event of assignment and registration before patent granted, that this section has any significance; if the "joint applicants" be "*joint inventors*," it has no significance, for there

is no necessity for an assignment at all in this case, and in any event, before patent issued, it is difficult to see what bearing the words "or to any other person" may have, for unless this "other person" is to join in the application and have the patent issue to him jointly with the other applicants, what object is attained by him in procuring an assignment and registering it; the registered assignees, who are petitioners, are those to whom alone the patent issues.

Joint Grants.

The word "grants" in this section is an innovation, its apparent meaning in connection with the word "patentees" thereafter written, is "*joint grants*" of Letters Patent after joint application by the three classes already referred to, in which case by assignment and registration the interest in the Letters Patent may become vested in one or more of the original joint patentees, or may be assigned "*in toto*" to "any other person" by assignment from the joint owners for the time being.

There might also, of course, be a joint application by two or more legal representatives, or two or more joint assignees of a deceased inventor or deceased joint inventors, when, by assignment, duly filed and registered, and a remodelling of the petition in the Patent Office Form 5, Appx. I., the patent might issue to one executor, administrator or assignee, as the case may be.

The fact is, the attempt is made in this section to crowd too much into a small space, with inevitable confusion as a result.

PART X.

Impeachment and Other Legal Proceedings in Respect of Patents.

28. A patent shall be void, if any material allegation in the petition or declaration of the applicant hereinbefore mentioned in respect of such patent is untrue (*a*), or, if the specifications and drawings contain more or less than is necessary for obtaining the end for which they purport to be made, when such omission or addition is wilfully made for the purpose of misleading (*b*); but, if it appears to the Court that such omission or addition was an involuntary error, and if

it is proved that the patentee is entitled to the remainder of his patent *pro tanto*, the Court shall render a judgment in accordance with the facts, and shall determine as to costs, and the patent shall be held valid for such part of the invention described, as the patentee is so found entitled to; and two office copies of such judgment shall be furnished to the Patent Office by the patentee, one of which shall be registered and remain of record in the office, and the other of which shall be attached to the patent, and made a part of it by a reference thereto. 35 V., c. 26, s. 27 (*c*).

NOTE.—(*a*) See section 28. The patent shall be void, if for instance the statement in the petition be untrue, that the invention was "not known or used by any other person before his invention thereof," or "that it had not been in public use or on sale with the consent or allowance of the inventor thereof for more than one year previous to his application in Canada," or if in the declaration or oath (the term "declaration" in this section by the Interpretation Act covers "oath"), he stated that he verily believed he was the inventor, when, in fact, he was not "*the first inventor*," or if by taking a false oath the patentee had surreptitiously obtained a patent for the invention of another, or if it had been printed or described in some public work. The term "untrue" need not mean that the allegation was fraudulently untrue to the knowledge of the applicant: *Vide* notes, section 7, *Kennedy* v. *Hazleton*, 19 Brodix, 118 (1888).

(*b*) Sub-sec. 2, sec. 27, Con. Stat. Can. C., 34 (1859), makes a provision similar to this paragraph marked (*b*) in section 28, *supra*, which follows word for word section 15 of the U. S. Act of 1836, viz.: "If at the trial in any such action it is made apparent to the satisfaction of the Court that the specification filed by the patentee does not contain the whole truth relative to the invention or discovery to which it refers, or that it contains more than is necessary to produce the described effect (such concealment or addition fully appearing to have been made for the purpose of deceiving the public), etc., etc., the patent shall be declared void." This part (*b*) of the section was doubtless taken from the said sec. 27, Con. Stat. Can. (1859), and the section appears almost in its present state in the Patent Act of 1869, where instead of being pleadable as a defence, it is as now stated. The present section provides for "more or less," making a deficiency of information as to the specifications and drawings equally as reprehensible as a surplusage. It is somewhat difficult to see how it is to be shown that such addition or omission was wilfully made for the purpose of mis-

leading, for this is *the crucial point* for determining whether the patent is to be declared void, or not, by the Court. The real point at issue is, whether the specifications and drawings contain sufficient information (even though it be *more*) to enable a person, skilled in the art to which the invention relates, to construct the machine or device claimed as the invention; if the deficiency or redundancy in description be such as may be readily detected, and the remedy be known by such skilled artizan, it is immaterial: *Kendrick* v. *Emmons*, 2 Ban. & Ard., 210 (1875).

The omission of anything absolutely material to the utility is a fatal defect in a description: *Carr* v. *Rice*, 1 Fish., 204; *Sewell* v. *Jones*, 10 Brodix, 336 (U. S. Sup. Ct., 1875); and no excess of description is fatal to validity unless the redundant matter be introduced with fraudulent intent: Curtis, 4th ed., sec. 250.

The reference in this section to "specifications and drawings" may lead to the assumption that it does not refer to a patent for a process or composition of matter, of which drawings form no part.

Judicial Disclaimer.

(*c*) See section 28. If the Court then be satisfied that such addition or omission be an "involuntary error," the Court, in its judgment, shall declare what the patentee is found entitled to; in other words the Court makes in effect "*a disclaimer*" of the addition, or what amounts to "*a reissue*" as to the omission, the judgment of the Court taking the place of that described under Reissue, Part 7, and Disclaimer, Part 8.

The term "involuntary error" is intended to cover the same ground as "inadvertence, accident or mistake," in treating of reissue and disclaimer.

This is an additional power as to Disclaimer and Reissue not contained in the U. S. Act, although in the Eng. Act of 1883, secs. 19 and 20, the Court may deal with the question of Disclaimer, as already referred to in Part 8. In England, when leave to amend is made in pursuance of the order of a Court or a Judge, an official or verified copy of the order shall be left with the re-

quest at the Patent Office. In Canada the office copy of the judgment is registered and an office copy is attached to the patent and made part thereof by reference, in the same manner as a disclaimer, is attached to the patent.

Should this *judicial disclaimer* be made during the progress of a suit, the Court doubtless would deprive the plaintiff of costs; nothing is said as to "*damages*," which would be dealt with in the way usual in the case of ordinary "*reissue*" and "*disclaimer*."

29. Every person who, without the consent in writing of the patentee, makes, constructs or puts in practice any invention for which a patent has been obtained under this Act or any previous Act (*a*), or who procures such invention from any person not authorized by the patentee or his legal representatives to make or use it, and who uses it (*b*), shall be liable to the patentee or his legal representatives in an action of damages for so doing; and the judgment shall be enforced, and the damages and costs that are adjudged shall be recoverable, in like manner as in other cases in the Court in which the action is brought (*c*). 35 V., c. 26, s. 23.

NOTE.—(*a*) Ever since our first Patent Act of 1826 it was necessary that the consent of the patentee should be in writing; this consent may take the form of a license to use or manufacture, or an assignment of a part interest.

The party giving the consent need not necessarily be a patentee, for we have seen under section 7, note (*a*), that one of several joint owners, or owners of undivided interests in a patent, or an assignee of a part owner, may bring an action in his own name to restrain infringement or for damages, without joining his co-owners, and may deal with the patent as he chooses: *Sheehan* v. *Great Eastern R. W. Co.*, 16 Ch. D., 59; *Steers* v. *Rogers*, L. R. (1892), 2 Ch. (App.), 13.

If the patentee merely sells the patented article, and receives the price in the ordinary course of business, as is very often the case, this should suffice without the necessity of a formal written document from the patentee: *Vide Dagleish* v. *Conboy*, 26 U. C. C. P. R., 254 (1876); and parol evidence might be admissible of such sale, and of the receipt of the stipulated price by the assignee: in the event of the purchase of an expensive patented

machine, it would be well to have some written evidence of the transaction.

This first part of the section is aimed at the illicit manufacturer or user of a patented article—for *the putting in practice* means use of the article itself for the practical purpose for which it is intended.

(*b*) See section 29. In the event of obtaining the patented article from a person not authorized to make or use it; to render a person liable to an action for damages, it would appear to be requisite that he use the article so obtained, for this section expressly says, "*and who uses it.*" This is the case when a person procures a patented article from a manufacturer or dealer who has the article in stock for sale, and who apparently *bonâ fide* purchases the same. But where an alleged infringer gives direct instructions to a manufacturer to construct an infringing device, this, then, is the act of the party giving the instructions, "*qui facit per alium facet per se,*" and the mere manufacture and the possession of the infringing article, without proof of actual use, would constitute an infringement, and would, it is conceived, render the person so ordering and procuring the machine liable to an action.

Outside the question of manufacturing without the written consent of the proprietor of the patent, which is alone sufficient to found an action for infringement, *the gravamen* of the infringement, for which damages are recoverable, would appear to be the use without *written leave* of the patented article.

As to Use.

Then the question is, what constitutes a use within the meaning of this section: does it mean merely a use in any way for profit, or would an experimental use or an offering for sale of the patented article, by the alleged infringer, suffice to make him liable? *Vide* Note (*e*), sec. 7; and Frost, p. 413, where a mere making for sale or use suffices in England; but, *contra*, where mere possession and exposure for sale, without sale being effected, was no infringement: *Minter* v. *Williams*, 1 Web. P. C., 135.

In England the working must be by way of using, and not *experimenting*, so as to operate as an infringement: *James* v.

Pearce, 1 Web. P. C., 122; *Muntz* v. *Foster*, 2 Web. P. C., 93-96; *Frearson* v. *Lee*, L. R., 9 Ch. D., 48.

Storage of dynamite in England for the purpose of transhipment amounted to infringement: *Nobel's Explosive Co.* v. *Jones*, L. R., 17 Ch. D., 721.

NOTE.—This case was reversed on appeal, but not as to this point.

A sale would certainly be an illicit use to put a patented article to, as would also, it is conceived, a public offering or advertising for sale; why should not also an "*experimental*" use, without the written authority of the proprietor or proprietors, or one of the proprietors, of the patent, come also within this category?

There is not in the U. S. Act or the British Act of 1883, a provision similar to our section, and we have no judicial decisions on points which might possibly arise on the question of what may constitute an infringement under this section.

In the United States, as afterwards appears, if there be no use of one patented machine manufactured, only nominal damages are recoverable (*vide* sec. 1212, Sedgwick); but in England (see *United Telephone Co.* v. *Walker*, 56 L. T., 508), where it did not matter whether the article had or had not been in actual use during any portion of the period.

The Right to Use Implies a Right to Repair.

The right to use one machine implies a right to repair its parts and to keep it in order, but not to use more than one machine at a time.

If a license to use *one* machine covers the whole term, and is not limited to any particular machine then sold, the licensee can repair or rebuild the machine, but he is restricted to the use of *one* machine at one time: *Steam Stone Cutter Co.* v. *Sheldon*, 5 Fish., 477, 10 Blatch., 1; *Wilson* v. *Stolley*, 4 McLean, 275.

A purchaser of machines from the patentees may repair and perfect them, and their use is not an infringement; but such purchase does not authorize the use of machines containing patented inventions unless they are the identical machines pur-

chased: *Union Metallic Cartridge Co.* v. *United States Cartridge Co.*, 2 Ban. & Ard., 593; 8 Fed. Rep., 446.

Damages.

By sec. 23, Con. Stat., Can., c. 34 (1859), consolidating 14 and 15 Vic., c. 79, sec. 7 (1851-52), any person infringing the patent "shall be liable to an action for the same, in which, besides such damages as may be awarded by the jury, the party injured shall also recover '*treble costs*,' to be taxed according to the course and practice of the Court in which the action is brought."

This golden section for the lawyers disappeared in the Patent Act of 1869, as well as the provision for assessment of damages by a jury. Since 1869, at least, there does not appear to have been any jury trials in patent cases.

(*c*) By section 29, in Canada, the infringer shall be liable to the patentee or his legal representatives in an action of damages, and by section 30 "any action for the infringement of a patent may be brought in any Court of record having jurisdiction, to the amount of the damages claimed," and by section 31, the Court, if sitting, or any Court if the Judge is not sitting, may, in an infringement suit, make order for an account. So in Canada we have an inquiry into damages and account of profits provided for.

In England You Cannot Have Both an Account of Profits and Damages.

In England, in addition to the jurisdiction as to an injunction, inspection or account in an infringement suit, provided for in section 30 of the Patent Act of 1883, the Courts have power under Sir Hugh Cairns' Act (21 and 22 Vic., c. 27) to order an account as to profits or an inquiry into damages. A patentee cannot have both, but he must elect which form of relief he will adopt: *Vide de Vitre* v. *Betts*, L. R., 6 H. L., 319; *Neilson* v. *Betts*, L. R., 5 H. L., 1; *Hills* v. *Evans*, Goodeve, p. 251.

Lord Cairns' Act.

By Cairns' Act, compensation can be claimed not only up to the date of the writ, but up to the hearing of the action or expiry of patent, whichever shall first happen: *Fritz* v. *Hobson*, 14 Ch. D., 542.

License Fee as a Measure of Damages.

In England, the measure of damages is estimated from the amount which the plaintiff has been in the habit of receiving for license fees, and damages were fixed as if defendant had been working under a license: *Penn* v. *Jack*, L. R., 5 Eq., 81.

Unfair Commercial Competition.

In estimating damages, with respect to the infringement of a manufactured article, where the patentee is the manufacturer, and no licenses have been granted, consideration should be had, as to the damage sustained, by reason of the commercial competition to which he has been subjected: *Vide* Terrell, 1st ed., p. 177; and *Carter* v. *Fisher*, 4 Fish., 409; *Goodyear* v. *Bishop*, 2 Fish., p. 154. Where there is no license fee, it is proper to inquire how many customers were diverted from the plaintiff to the defendant; whether the plaintiff was ready to supply the market, and was prevented by defendant; whether, by the competition of the defendant, the plaintiff was interfered with in his business, etc., in a sum equal to the profits which he could have made if he had made and sold the goods made and sold by the defendant, over and above what he, the plaintiff, did in fact make and sell.

Where the defendants had, from time to time, lowered the original prices, and plaintiffs had to reduce prices to meet the competition: *Held* (reversing Kekewich, J.), that the plaintiffs were entitled to recover all the profits which would have been made by them if all the sales made by the defendants and the plaintiffs had been made by the plaintiffs at the original prices; after making an allowance for the increased sales, attributable to the connection and exertions of the defendants and to the reduction in the prices: (*The United Horse Shoe Nail Co.* v. *Stewart*, 13 App. Cas., H. L., 401 (1888), distinguished, where plaintiffs were not entitled to damages for reduction in price; they had made the reduction themselves and it was not the direct consequence of the infringer's act): See *American Braided Wire Co.* v. *Thomson*, L. R., 44 Ch. (App.), 274 (1890).

The plaintiff must show that reduction in prices was due solely to the acts of defendant, or to what extent it was so due;

there must be some data in order to estimate damages: *Boesch* v. *Graff*, 20 Brodix, 167, 133 U. S., 697 (March, 1890).

The same rule, as to damages being measured by the amount of an established license fee, prevails also in the States, as enunciated by the Sup. Ct. in *Seymour* v. *McCormick*, 19 Wall., 611, hereafter set out, and applies also in Canada.

License Fee in a Foreign Country Not Taken as a Criterion for Canada.

In *Wisner* v. *Coulthard*, the Master-in-Ordinary took as the measure of damages a license fee paid by a Canadian manufacturer of $2.25 per machine with respect to a certain improvement in part of a seeding and drilling machine, and disregarded a license fee of $1 per machine paid with respect to the whole of the device patented in the States, the amount of license fee paid in a foreign country not being taken as a criterion of the value of a license fee in Canada.

Royalty Not Payable by Both User and Manufacturer.

Where the user of an unlicensed machine has paid royalty to the patentee, no further royalty is payable by the manufacturer; a license fee cannot be claimed from both, although either may be looked to: *Penn* v. *Bibby*, L. R., 5 Eq., 81.

Royalty Payable Even Though Non-user.

In the case of a rental or royalty, the measure of damages is the rental, and it did not matter whether the article had or had not been in actual use, during any portion of that period Damages for infringement against a manufacturer from whom defendant bought in a previous suit, is not to be taken as a set-off unless the sum recovered represented the full royalty: *Vide United Telephone Co.* v. *Walker*, 56 L. T., 508.

Interest Allowed on Royalties from the Time They Were Payable.

And in the event of a license fee or royalty being taken as the measure of damages, interest is allowed in *the States* from the time these royalties should have been paid; the damages are

liquidated at such time as the royalty would have been due: *Vide* Walker, sec. 571; *Seymour* v. *McCormick*, 3 Blatch., 222 (1854); *Locomotive Safety Truck Co.* v. *Penn R. Co.*, 2 Fed. Rep., 682 (1880); *Tilghman* v. *Proctor*, 17 Brodix, 552; 125 U. S., 136 (1888).

But no interest is due on damages otherwise measured, damages being unliquidated till ascertained by an action: *Gilpin* v. *Consequa*, 3 Wash., 194.

The same rule, as to allowing interest on license fees from the time they should have been paid, would prevail probably in Canada, although we have no reported judicial decisions on this point.

English Practice More Analogous to Ours Than That of the States.

Hitherto we have mainly considered the question of damages and profits from the English standpoint, and in the main English cases may furnish better analogies than those in the States, for in the latter country there are special enactments bearing on damages and profits in infringement suits. In the U. S. Courts there is not the same fusion of law and equity as prevails in England and Canada, and patent suits are triable both at law by a jury, and also in equity by a Judge, with statutory remedies appropriate to each class; and other differences prevail, which makes it necessary to consider the applicability of certain American decisions to the state of the law in Canada. In the States also there is no obligation to manufacture, and a patentee may keep or assign a close monopoly; whereas, in Canada, the close monopoly to use only exists for two years.

In the States, in an action at law, under sec. 4919, Rev. Stat., damages are recoverable by plaintiff on verdict, and the Court may enter judgment thereon for any sum above the amount found by the verdict as actual damages, not exceeding three times the amount of such verdict, together with the costs.

Damages were recoverable by the U. S. Patent Act of 1790, sec. 4, together with forfeiture of the infringing article to plaintiff.

And by the U. S. Patent Act (1793), sec. 5, a penalty of three times the sale or licensing price was payable.

By U. S. Patent Act (1800), sec. 3, three times the actual damage sustained was recoverable.

By U. S. Patent Act (1836), sec. 14, a provision similar to the present revised section 4919 existed.

And by sec. 55 of the Patent Act of 1870, all actions relating to infringements were cognizable both at law and in equity, and a provision similar to that in section 4921, hereafter referred to, was enacted.

In the United States there are two sections (4919, 4921) which bear on the question of damages and profits.

We have not in Canada or in England any such provision as this, whereby a Judge has a discretionary power to treble the actual damages found by a jury.

Under sec. 4921, Rev. Stat., U. S., a Court of Equity may assess *damages* in addition to the defendant's *profits*, and in estimating damages, under these circumstances, the Court follows the rules of law applicable to the assessment of damages already discussed.

The Supreme Court, U. S., has often refused to measure plaintiff's damages by defendant's profits in an action at law: *Seymour* v. *McCormick*, 16 How., 480 (1853); *Packet Co.* v. *Sickles*, 19 Wall., 611 (1873); the express ground taken being that profits, and not damages, were the only subject of enquiry and recovery in equity: *Elizabeth* v. *Pavement Co.*, 97 U. S., 140 (1877).

There is no recovery of interest on infringers' profits: *Vide* Walker, secs. 736, 737, as finally decided in *Tilghman* v. *Proctor*, 102 U. S., 707 (1880).

The profits which defendant derives from his infringement is not relevant to the question of the plaintiffs' damages. Sometimes the profits may be much larger than the plaintiffs' loss: *Packet Co.* v. *Sickles*, 19 Wall., 611 (1873); *New York* v. *Ransom*, 23 How., 487 (1859); and where smaller, it is no answer to plaintiffs' right to recover full damages: *Emerson* v. *Simon*, 6 Fish., 201 (1873); *Dental Vulcanite Co.* v. *Van Antwerp*, 2 Ban. & Ard., 225 (1876).

Mode of Assessing Damages.

One method of assessing damages is, by using the plaintiffs established royalty as the measure, according to the rule in *Seymour* v. *McCormick*, 19 Wall., 611, and this corresponds with the English practice (see *Penn* v. *Jack*, *ante*), as well as with the practice in Canada.

And another method of assessing damages is, by ascertaining what the defendant's interference with the plaintiff's monopoly prevented the latter from deriving profit therefrom: *Zane* v. *Peck*, 13 Fed. Rep., 475 (1882).

The royalty to be deemed an established royalty, must be uniform; the sale of a single license is not sufficient: *Judson* v. *Bradford*, 3 Ban. & Ard., 549 (1873); *Rude* v. *Westcott*, 19 Brodix, 518; 130 U. S., 152 (October, 1888); but it does not follow that a patentee may never vary the rate of royalty, when sufficient licensees pay and acquiesce in the change: *Vide* Walker, sec. 557.

In the case of *Seymour* v. *McCormick*, 19 Wall., 611, the U. S. Sup. Ct., on full consideration and without dissent, laid down the proposition that in suits for infringement, at law, where the sale of licenses by the patentee had been sufficient to establish a price for such license, that price should be taken as a measure of his damages against the infringer. The rule thus declared has remained the established criterion of damages in cases to which it was applicable, ever since: Section 1220, Sedgwick.

It is only where from peculiar circumstances of the case no other rule can be found that the defendant's profits become the criterion of the plaintiff's loss: *S. C.*, 19 Wall., 611.

Established license fees are the best measure of damages, and special damages beyond this for expense, trouble, etc., are allowances by the Court in U. S. A., under authority *by statute, to increase damages*: *Clark* v. *Wooster*, 16 Brodix, 426, 119 U. S., 322 (1886).

The proof of a license fee for two improvements in fruit driers, is not competent in order to show the damage sustained by infringement of one of those improvements: *Philp* v. *Nock*, 17 Wall., 460; *Seymour* v. *McCormick*, 16 How., 480.

In estimating damages, an inquiry as to how many customers were diverted, may be relevant: *Vide* section 1228, Sedgwick on Damages.

In *Whittemore* v. *Cutter*, 1 Gallison, 478, Story, J., charged the jury, that where the only proof of infringement was that defendant had made one of plaintiff's machines, but was not shown to have used it, only nominal damages could be recovered: *Vide* sec. 1212, Sedgwick; and *Curtis* v. *Baker*, 4 Fish.; but *contra*, *United Telephone Co.* v. *Walker*, 56 L. T., 508, where it was held that royalty was payable whether there was actual use or not.

Evidence Not to be Conjectural.

The evidence of damages must be reasonably definite, conjecture will not perform the office of proof, nor can imagination take the place of calculation in this behalf; actual damages must be calculated, which cannot be done without certain *data*: *Carter* v. *Baker*, 4 Fish., 419 (1871); *New York* v. *Ransom*, 23 How., 487 (1859), affirmed, 19 Brodix, 517; *Rude* v. *Westcott* (Sup. Ct., U. S., March, 1889), but this rule is not to be used to defeat the ends of justice, and all points of uncertainty should be resolved against the defendant: *Vide* Walker, sec. 565.

The burden of proving damages is upon the plaintiff, and he must establish his damages by competent evidence, and they must not be left to be surmised or arrived at by conjecture, by the jury: *Garretson* v. *Clark*, 111 U. S., 120; *Blake* v. *Robertson*, 11 O. G., 877, 94 U. S., 728.

In U. S. Cir. Ct. of App., 9th Cir., *Hunt Bros., Fruit Packing Co.* v. *Cassidy*, 62 O. G., p. 1965 (decided October 24th, 1892), in which nominal damages were allowed, as they could only be arrived at by conjecture, the following cases were cited:—The authorities are full upon the point that a party cannot recover, as damages, the profits to be derived from the manufacture of the whole of a machine, when only a portion of the same contains a patented feature, unless the entire value of the whole machine, as a marketable article, is properly and legally attributable to the patented feature: *Garretson* v. *Clark*, 15 Brodix, 194, 111 U. S., 120, 27 O. G., 524; *Dobson* v. *Carpet Co.*, 31 O. G., 787, 114 U. S., 440; *Philp* v. *Nock*, 17 Wall., 460.

Where the same result is produced, with equal facility and cost, by other methods, open to the public, and in the absence of an established license fee as a criterion of damages the damages must necessarily be nominal: *Black* v. *Thom*, 15 Brodix, 201, 111 U. S., 122 (1884).

A royalty established in one State of the Union is not to be taken as a standard for all the other States: *Vide* Walker, 558.

Money paid in settlement of a suit for an infringement does not establish a royalty; for various elements enter into a compromise of an action: *Greenleaf* v. *Manufacturing Co.*, 17 Blatch., 253 (1879); *Matthews* v. *Spangenburg*, 14 Fed. Rep., 350 (1882); *Cornely* v. *Marckwald*, 19 Brodix, 577 (May, 1889); nor money reserved, as the whole or part price of a patent: *La Baw* v. *Hawkins*, 2 Ban. & Ard., 564 (1877); *Rude* v. *Westcott*, 19 Brodix, 517, 130 U. S., 152 (March, 1889).

A royalty in a license "*to make and use*" is no criterion for a royalty "*to make and sell*": *Vide* Walker, sec. 561.

Actual Damages.

The term "*actual damages*" in United States mean such damages as can actually be proved in contradistinction to vindictive damages; these are the damages which the United States Statute contemplates as being trebled: *Vide* Curtis, 4th ed., sec. 337. In Canada, actual, and not exemplary, damages will be awarded: *Vide Lanier* v. *Collette*, 5 L. N., 412, *S. C.* (1882); as to meaning of actual damages: See *United States* v. *McKeever*, 14 Brodix (p. 414).

Where there is no established license fee, general evidence of the utility and superiority of the invention may be submitted to the jury, who are to estimate therefrom the damages during infringement, and recovery does not vest in infringer the right to continue to use: *The Suffolk Co.* v. *Hayden*, 3 Wall., 315.

In the second method of ascertaining damages in the absence of a license fee, it is necessary to show that the plaintiff *could have supplied the demand*, and that, but for the infringer, he might have made the sales: *Vide Magic Ruffle Co.* v. *Douglas*, 2

Fish., 340 (1863); *Sargent* v. *Manufacturing Co.*, 17 Blatch., 247 (1879); and it is also necessary to show what profit the plaintiff would have derived from the trade so divested, and this is a question of fact, and not a judgment of law: *Seymour* v. *McCormick*, 14 How., 480; Walker, sec. 563; these damages may be supplemented by whatever reduction in price the patentee was compelled by defendants competing infringement to make even on goods which he did sell: *Vide American Braided Wire Co.* v. *Thompson*, 44 Ch. D., 274.

There is a presumption in law in the United States of America that the plaintiff would have had the patronage so diverted by the defendant, and the profits thus lost are a criterion of the damages: *Vide Le Roy* v. *Totham*, 14 How., 156, and cases referred to on Bump., 2nd ed., p. 318.

In *Pitts* v. *Hall*, 2 Blatch., 229 (referred to in Robinson on Patents, vol. 3, p. 336, note 10; also in Curtis, 4th ed., p. 457, sec. 338), Nelson, J., says: "One mode of arriving at the actual damages is to ascertain the profit which the plaintiff derives from the machines which he manufactures and sells, and which have been made and sold by the defendant, etc."; this rests on the foregoing presumption.

Estimating a Reasonable Royalty.

Where damages cannot be assessed on the basis of a license fee, nor that on lost sales, where the plaintiff is not a manufacturer, nor on defendant's profits, the proper mode is to ascertain what would have been a reasonable royalty for an infringer to have paid and the claimant to accept: *Vide United States* v. *McKeever*, U. S. Sup. Ct. (decided November 20th, 1882), 14 Brodix, 414.

In this case it was stated in evidence that twenty per cent. of the manufacturers' selling price is ordinarily considered by manufacturers and patentees a fair royalty where the patent substantially covers the article sold, and the royalty was estimated on this basis (p. 424). In the judgment of a competent expert, twenty-five cents a box was deemed a fair and reasonable royalty.

And in discussing estimate of damages, the Supreme Court (p. 425) laid them down, in patent cases, under two headings:

(1) That the plaintiff may recover *in equity* the profit which

the infringer has made from the use of the invention; the infringer being treated as a trustee of the patentee; or

(2) That he may recover *at law* the profits which he (the plaintiff) has lost by reason of the defendant's infringement; and that these profits lost, where it can properly be done, will be considered as simply the fee which would have been charged if the infringer had procured a license.

N. B.—The distinction between law and equity Courts still prevails in the United States of America.

In *Suffolk Co.* v. *Heyden*, 3 Wall., 15, Nelson, J., says: "With a knowledge of these benefits (over the old modes) to the persons who have used the invention, and the extent of use by the infringer, a jury will be in possession of material and controlling facts that may enable them, in the exercise of a sound judgment, to ascertain the damages."

The plaintiff's loss, not the defendant's gain, should be the standard as to damages: *Cowing* v. *Rumsey*, 8 Blatch., 36.

The royalty paid is usually the standard: *Vide Phelp* v. *Nock*, 17 Wall., 450; *Wooster* v. *Simondson*, 28 O. G., p. 918.

Actual Damages Not Always to Be Proved Strictly.

And on p. 427, *U. S.* v. *McKeever*, 14 Brodix, the Supreme Court stated: "It is not to be supposed that those decisions, which hold a patentee to the proof of his actual damages, were ever intended to be pushed to the extreme result, otherwise the patentee might be without redress, for an infringer might say: 'The patentee cannot recover our profits for we made none; he cannot recover a license fee for he has not established a license; he cannot recover his own profits as a manufacturer, for he does not manufacture, nor seek to manufacture the patented article'; he is without legal redress, and we are free to pirate his invention and forestall him in the market, until we render his patent, practically, worthless." *Vide* also Walker, sec. 563–4, as to a reasonable license fee being determined by evidence.

In making such an estimate as just intimated, every point of uncertainty ought to be resolved against the defendant, for he had it in his power to give accurate data on which to compute. The statutory provision which enabled a Court of Equity to assess damages in a patent case in U. S. A., originated in 1870: See Walker, sec. 572.

The foregoing cases in England and U. S. A., may be considered, when considering the question of damages under the Canadian Act:

In *Smith* v. *Goldie*, 11 Prac. Rep., Ont., p. 24, the decree of the Supreme Court declared that the plaintiff was entitled to an enquiry, and to be paid the amount found due upon such inquiry for damages sustained from the making, constructing, using, selling or vending to others to be used, by the defendants, *and by the persons to whom they have sold, given or let the same* of any of the machines since the filing of the bill and six years before, etc. Appeal from judgment of the Master-in-Ordinary (January 12th, 1885), who excluded evidence as to persons who had bought from the defendants.

The Master held that the royalties charged by the plaintiffs was the true measure of damages; and pointed out that in the States, in addition to damages, profits were accountable by the defendants, but there was nothing like it in our Act.

Proudfoot, J., on appeal from the Master-in-Ordinary (January 3rd, 1885): *Held*, that the decree went much beyond what was asked, giving damages as well as an account of profits, and that there does not appear to be anything in the judgment to warrant such a decree; and states: "No case was cited, nor have I found any in which this extreme relief was given against a manufacturer; and I am at a loss to conceive on what principle it can be based. Damages in patent suits are actual damages, not imaginary or vindictive ones. The damage done by the manufacturers was complete when the machine was manufactured and sold. Any damage done after that was by the purchaser, and for that he is responsible.

"If the manufacturer never used the machine, he could make no profit, and by Curtis, sec. 338, he would be exonerated. I cannot find from that judgment that the Justices in the Supreme Court intended to make a decree in this form."

Here there appears to be a not well-founded view by Proudfoot, J., that there was "*continuing damage*," and that damages might be awarded against both manufacturer and user: this view arises out of a dictum of Wood, V. C., in *Penn* v. *Jack*, a manufacturer, and other suits against users (cited by Proudfoot, J.): *Vide* Goodeve, p. 371 (L. R., 3 Eq., 308, A. D. 1866), in which Wood, V. C., expressed the view above referred to; but in *Penn* v. *Jack* (*vide* Goodeve, p. 372, 5 Eq., 81, 1867), Wood, V. C., next year, had apparently reconsidered the matter, and declared that the defendant Jack should pay as damages the usual license fee

of two shillings and sixpence per horse power for every ship he built with plaintiff's improvement, and plaintiff's claim for loss of profits as manufacturer was disallowed with costs of hearing.

If the manufacturer pays the recognized royalty, neither in the United States nor in England, nor in Canada, can the user be called on to pay any more.

NOTE.— This case of *Smith* v. *Goldie*, establishes nothing as to damages, and the decree may not be taken as a precedent; there was nothing to warrant the form of decree. In Canada no double remedy exists, and, the same as in England, you must elect whether you will go for damages or for the profits made by the infringer; you cannot have both, as may be the case in the States, in equity, under their statute: See sec. 4921, Rev. Stat. U. S.

In *Pinkerton et al. and Coté*, Montreal Law Rep., 3 Q. B., p. 133 (1886).

This was an appeal to the full Court of Queen's Bench (June 30th, 1886) from a judgment of the Superior Court, Montreal, which latter Court directed an account of the articles manufactured by the infringing machine, and the profits realized by reason of such manufacture for two years before the 22nd August 1883; and in default of so doing, condemning defendants in the sum of $2,000 damages and interest.

On appeal to the full Court: *Held*, that the damages in the Court below were held to be the profits arising from all the appellant manufactures, and that is not in any sense true. That there was no authority for holding that the value of the machine is the measure for that which they were obliged to sell at a "*reasonable price.*"

"What measure then is the Court to adopt. The rule to award damages is to some extent arbitrary; in a case like the present we have to consider the case of protection to the patentee, at the same time we cannot overlook the fact that the respondent has quietly contemplated the violation of his patent for years, and that the defendants do not appear to be in bad faith, and only bought what was commonly sold and used openly in the trade."

Lump Sum Awarded.

The Court further appeared to consider in *Pinkerton* v. *Coté*, that there was a further remedy over against the manufacturer, and

varied the judgment of the Superior Court, Montreal, by awarding a lump sum of $750.

In *Morin* v. *Berger*, 6 L. N. (Que.), 236, *S. C.* (1883), a lump sum of five hundred dollars was awarded as damages; in *Collette* v. *Lanier*, 9 L. N., 171 (1885), one hundred dollars; and in *Pinkerton* v. *Coté*, Montreal Law Rep., 3 Q. B., seven hundred and fifty dollars.

Civil Code of Quebec as to Damages.

In this case of *Pinkerton* v. *Coté* it will be noticed that the Queen's Bench Court, Montreal, held that defendants' profits were not the measure of damages, and in support of this view the Civil Code was cited: "That damages consist in the loss the creditor has sustained, and of the profits of which he has been deprived."

If the Civil Code in the Province of Quebec be brought into the question of determining damages in a suit for infringement, it may be that there is one mode of estimating damages in Quebec, and another in the English speaking Provinces of the Dominion.

Laches.

In this case the Court further found that there had been *laches* on the part of the plaintiffs, which in itself may of course materially affect the question of damages even to the extent of depriving one thereof, and that the defendants were not in bad faith.

Damages on Account of Threats in England and in Canada.

In England, by section 32 of the Act of 1883, if groundless threats of legal proceedings are made by a patentee by circulars, advertisements or otherwise against an alleged infringer, an action for damages will lie at the suit of the latter, and an injunction may be obtained against the continuance of such threats, if the alleged infringing manufacture or article was not in fact an infringement; with a proviso, that the section should not apply, if the person making such threats, with due diligence, commences and prosecutes an action for infringement of his patent.

We have not in Canada a similar provision, so that here, even if the patentee did commence and prosecute an action for in-

fringement with *due diligence*, he would yet be liable to an action for damages if he fails in his action and had previously threatened suit by circular or advertisement, and had thereby diverted trade from the alleged infringer, and caused damage which could be proved.

As to an action for damages and to restrain threats in England: *Vide Johnson* v. *Edge*, L. R., 2 Ch. App. (1892); and what constitutes "*due diligence*" under sec. 32 of British Act of 1883: *Colby* v. *Hart*, 44 Ch., 179 (1890); and *Combined Weighing Co.* v. *Auto-Weighing Co.*, 42 Ch. D., p. 665. Assignees making threats are not entitled to the benefit of the proviso in section 32 as to a suit pending started by patentees: *Kensington Electric Lighting Co.* v. *Lane Fox Electrical Co.*, L. R. (1891), 2 Ch., 573.

This Act of 1883 (England) introduces a novel feature. We, in Canada, stand on the same footing as to an action for damages as in England before this Act of 1883.

In *Halsey* v. *Brotherhood*, L. R., 15 Ch. D., 519, referring to *Wren* v. *Wield* (L. R., 4 Q. B., 730), the Master of the Rolls stated as to the latter case, that Bradburn, J., considered that to support an action for damages against a patentee for threats, "the statement must not only be untrue, but that it must be without reasonable and probable cause"; that is the judgment of the full Court. For slander of title: See *Axmann* v. *Lund*, L. R., 18 Eq., 330; *Rollers* v. *Hinks*, 13 Eq., 355; *Sellers* v. *Dickenson*, 5 Exch., 312; *Evans* v. *Harlow*, 5 Q. B., 624; the foregoing cases, decided in England previous to the Act of 1883, are applicable to the present state of the law in Canada.

Where a warning circular was issued and an action begun to restrain the circulation, a cross-action being begun by defendants for infringement: *Held*, that there being no evidence of bad faith by defendants, they ought not to be restrained from issuing their circular till the action was disposed of, but that they must prosecute their action without delay: *Household* v. *Fairburn* 51 L. T., 498.

No Damages Against a Workman.

In *Woodward* v. *Clement*, 10 Ont. Rep., p. 348, an action for infringement against manufacturer and his workman: *Held*,

that damages were only assessable against the master: *Delano* v. *Scott*, 1 Gilpin, 489, being cited. Injunction against both: See also *Betts* v. *De Vitre*, L. R., 3 Ch. App. Cas., 441.

Remote consequential damages must be disregarded: *Carter* v. *Baker*, 4 Fish.

As to Damages in the Province of Quebec.

In *Dery* v. *Hamil*, 13 Review Legal (Que.), 50, 11 Q. L. R., 24 Q. B. (1884).

The purchaser of a patent for things which are of public domain for a number of years, can recover damages from vendor, if he proves that the article is not fitted for the use for which it was intended, and that it is and was worthless at the time of the sale in question, and that it is of no practical utility.

This decision is directly opposed to the principle in *Hall* v. *Conder*, 2 C. B. N. S., 22, 3 J. N. S., 963, and other standard cases; in the absence of fraud, and where each party was acting on his own judgment, it is difficult to conceive why the purchaser, in the absence of any warranty, should recover damages.

Vide also *Vermilya* v. *Canniff*, 12 Ont. R., 164, as opposed to this Quebec decision.

Profits.

When considering the question of account of profits made by the defendants as a measure of damages, which is another form of relief open to Canadian patentees, another class of cases should be considered, of which the following relate:—

In illustration of the practice of the English Courts in ordering an account of profits or an inquiry into damages: *Vide Holland* v. *Fox*, 23 L. J. Q. B., 357; *Bacon* v. *Spottiswoode*, 1 Beav., 382.

Where defendant submits, the plaintiff may be deprived of costs if he insists on an account and nothing be found due over the amount offered: *Nunn* v. *D'Albuquerque*, 34 Beav., 595.

An account of profits was deemed the equitable relief, and before the Judicature Act was incident to the right for an injunction, while damages was the legal remedy.

Account of Profits for Six Years Before Action.

The account of profits extends over six years immediately preceding the action, and there must be no delay in applying for the same: *Kernot* v. *Potter*, 3 de G. F. & J., 447; *Davenport* v. *Rylands*, L. R., 1 Eq., 302; and an account of profits may be taken, notwithstanding the pendency of an appeal: *Saxby* v. *Easterbrook*, 7 Exch., 207.

If the plaintiff be an assignee of a patent the account will only be taken from the date of the assignment to him: *Ellwood* v *Christy*, 5 N. R., 312.

Stay of Proceedings to Account Pending Appeal.

Proceedings under an order directing an account of profits will, on appeal, be stayed till the hearing of appeal, when the discovery given by the account would enable plaintiff to take proceedings against the customers of defendants; and the defendants, supposing them to be ultimately successful, would thus sustain irreparable injury in their business: *Adair* v. *Young*, 11 Ch. D., 136. But *vide* contra *Saxby* v. *Easterbrook*, L. R., 7 Exch., 207.

Before an order for an account of profits to be taken will be granted, a case must be established that a defendant has made profits by the infringement: *Lister* v. *Eastwood*, 2 Higgins' Pat. Digest; *Bacon* v. *Spottiswood*, 1 Beav., 387.

The account is one of profits made by the infringer, and not of the loss which the plaintiff has sustained by the infringement: *Ellwood* v. *Christy*, 18 C. B. (N. S.), 494.

If there be judgment for an account, the defendant must file an affidavit giving the number of articles sold by him, and the names and addresses of the purchasers: *Murray* v. *Clayton*, L. R., 15 Eq., 115.

A patentee in England may prove, under bankruptcy, an account of profits: See *Watson* v. *Halliday*, 46 L. T. (N. S.), 878; and in Canada also if an assignment be made.

Defendant Treated as Trustee of Profits Made.

In *Holland* v. *Fox*, 3 El. & Bl., 977, Goodeve, p. 258, Lord Campbell, C. J., says: "The defendant having admitted that, after notice,

he would be held liable to account for profits, he did make large profits by continuing to infringe the plaintiff's patent, and as no part of such profits could have been awarded by way of damages to the plaintiff, we think that the defendant may be considered as a trustee of these profits for the plaintiff; and as part of our final judgment we order that the defendant render an account of these profits and pay over the amount to the plaintiff.

Definition of "Profits," etc.

The profits are the difference between the sale price and the cost of making and selling.

As to the cost—(1) The market value of materials on hand at the time infringement began, and the actual cost of materials subsequently purchased, are elements: *Rubber Co.* v. *Goodyear*, 9 Wall., 803 (1869). (2) Money paid to employés in making and selling, even when they are officers or stockholders of the infringing corporation: *S. C.*, 9 Wall., 803. (3) Remuneration for the labour of one who conducts the infringement. (4) Interest on borrowed money: *S. C.*, 9 Wall., 803, but query as to capital stock. (5) Expenses of selling and advertising: *Garretson* v. *Clark*, 15 Blatch., p. 70 (1878); *Kirby* v. *Armstrong*, 19 O. G. (1881): *Vide* Walker, sec. 718.

In estimating profits the use of tools, machinery power, and other facilities employed in the manufacture, should be taken into account as well as material, labour, wastage, and expenses of marketing: *Vide Gould Manufacturing Co.* v. *Cowing*, 14 Brodix, 1 (March, 1882).

Allowance for Defendant's Salary.

In *Seabury* v. *Am. Ende.* (decided April 2nd, 1894, in Sup. Ct., U. S.), reported in P. O. News, vol. 1., p. 33, when it was not shown what sum, or that any sum was actually paid to the president of defendant company, the Supreme Court *held* that no salary was allowable, stating: "To have allowed salaries which had never been paid would have been, as was said in *Rubber Co.* v. *Goodyear*, 9 Wall., 804, to permit a dividend of profits under the guise of salaries."

The profits must be those which result directly from the infringement of the patent, and do not include those which result indirectly: *Vide Piper* v. *Brown*, 1 Holmes, 198 (1873); and Walker, sec. 711.

Profits Without Deduction for Loss is Recoverable.

Where part of the infringement resulted in profits and part in loss, the plaintiff is entitled to recover the profits without any deduction as to the loss: *Steam Stone Cutter Co.* v. *Manufacturing Co.*, 17 Blatch., 27 (1879).

Interest Allowable.

Interest would appear allowable on infringer's profits at the legal rate from the end of each year till the date of the final decree: *Vide* Walker, sec. 738; *Tilghman* v. *Mitchell*, 9 Blatch., 17 (1871); *Gould's Manufacturing Co.* v. *Cowing*, 105 U. S., 257.

But Contra: *Railroad Co.* v. *Turrill*, 15 Brodix, 140 (January, 1884), where profits are regarded as unliquidated damages; and *Littlefield* v. *Perry*, 21 Wall., 207; *Rubber Co.* v. *Goodyear*, 9 Wall., 804.

If the unauthorized use of a patented process produce a definite saving in the cost of manufacture, the infringer must account to the patentee for the amount so saved; it is a measure of profits: *Tilghman* v. *Proctor*, 17 Brodix, 552, 125 U. S., 136 (1887).

Effect of Acquiescence by Plaintiff.

A plaintiff will not be allowed to claim an account if he has tacitly permitted defendant to infringe his patent, and by his silence or acquiescence induced another to go on spending his money and incurring risk: *Vide Crossley* v. *Derby Gas Co.*, 1 Web. P. C., 120.

Before the Judicature Act in England, in Courts of Equity no damages or account could be claimed unless an injunction could be granted: *Vide Price's Patent Candle Co.* v. *Bauwen's Patent Candle Co.*, 4 Kay. 727.

In taking an *account* of profits, the account must show what was the costs of the defendant's forgings both previous to and during the user of the plaintiff's invention: *Siddell* v. *Vickers* (No. 2), 61 L. T., 233; W. N. (1889), p. 134.

Where a patentee, in order to compete with an infringing manufacturer, reduces his prices, a claim for loss of profit by rea-

son of such reductions is to be rejected: *United Horseshoe Nail Co.* v. *Stewart*, R. P. C., vol. 5, p. 260 (1888).

Segregation of Profits.

Profits do not attach to entire machine unless plaintiff show that the feature patented gave the entire commercial value, but should separate the profits made on that feature from the profits on the machine as a whole: 45 Fed. R., 205, affirmed; also Sup. Ct., U. S., *Keystone Manufacturing Co.* v. *Adams* (decided January 8th, 1894), when nominal damages only were awarded: See *Mosher* v. *Joyce*, U. S. Cir. Ct. of App. (1892), 61 O. G., p. 153.

The defendant, by proving how much profit was due to other features than those covered by the patent, may confine the recovery to the residue of those profits, and the burden of proof is on the defendant: *Rubber Co.* v. *Goodyear*, 9 Wall., 803; *Carter* v. *Baker*, 4 Fish.; *Elizabeth* v. *Pavement Co.*, 97 U. S., 141 (1877); and when profits cannot be separated, apportionment may be made by dividing the aggregate profits in proportion to the respective cost of the parts: *S. C.*, 9 Wall., 803.

Where the infringed article has been used on certain articles, the measure of damages is not the profits on the entire article sold, but the defendant's savings from the use of the infringed device over what was known and open to the public before: See *Sessions* v. *Romaski* (1892), Sup. Ct., U. S., 59 O. G., p. 939.

The Rule in Whitney v. Mowry.

The rule laid down by the Sup. Ct., U. S., in *Whitney* v. *Mowry*, 14 Wall., 620, was: "What advantage did the defendant derive from using plaintiff's invention, over that which he had in using other processes then open to the public, and adequate to enable him to obtain an equally beneficial result? The fruits of that advantage are his profits."

Exceptions to the Rule in Whitney v. Mowry.

The rule in *Whitney* v. *Mowry*, is not of universal application, and has no application in the case of making and selling the patented article itself (*vide Goodyear Rubber Case*, the patent for the product, the process patent being invalid): *Vide* Walker, sec. 729.

In *Elizabeth* v. *Pavement Co.*, 97 U. S., 141 (1877), the defen-

dants sought to have profits determined under this rule by setting up other pavements as standards of comparison, but the Supreme Court would not permit this.

The rule was also unsuccessfully invoked in *Burdett* v. *Estey*, 3 Fed. Rep., 569 (1880), where defendant might have sold another device at nearly or quite the same profit: *Vide* Walker, sec. 735.

The standard of comparison must be one known at the time of the infringement: *Knox* v. *Quicksilver Mining Co.*, 6 Sawyer, 436; and need not be absolutely the next best thing known: *Vide* Walker, sec. 734.

In Walker, secs. 725, 726, 727, 728, this rule is fully discussed, and the advantage referred to in this rule may be either an affirmative gain or in a saving from loss, or in both of these elements, and the fruits of that advantage constitute the recoverable profits in either event.

This is the Supreme Court rule in *Whitney* v. *Mowry*, 14 Wall., 620, already mentioned.

And in *Collette* v. *Lasnier*, 13 S. C. R., 563 (March, 1886), in estimating damages, in which originally the Supreme Court (Quebec) confirmed the Court of Queen's Bench appeal side, assessing the damages at a lump sum of $600.

Mr. Justice Gwynne refers to this rule in *Whitney* v. *Mowry*, and states: "The evidence fails to furnish us with any means of accurately measuring plaintiff's damages. It is only when from peculiar circumstances no other rule can be found that defendant's profits become the criterion of the plaintiff's loss, and we have no evidence before us to determine what rule shall govern, the plaintiff has set no value on his license. The estimate of profits is not made by showing that made by plaintiff's machine over a modern precedent and the best known mode; but a very old mode, which has been improved upon by other modes before the plaintiff obtained a patent for his improvement."

Assessment of Damages Not Usually Appealable.

Mr. Justice Taschereau, as to damages in the same case, states: "That a Court of Appeal will not, as a general rule, entertain an appeal from an order assessing damages, but it will do so when shown that the Court below acted on a wrong principle" citing *Ball* v. *Ray*, 30 L. T., N. S., 1 and *Bank U. C.* v. *Bradshaw*, L. R., 1 Priv. C., 479.

"There is nothing to show that the plaintiff would have made all the candles had not the defendant infringed. The defendant might have obtained one of plaintiff's machines. Plaintiff's business, notwithstanding the infringement, went

on increasing; there is no evidence of the cost or value of the plaintiff's machine or what would be a fair royalty on it, so that it is impossible to assess damages."

In this case the original claim for damages was $13,200 damages and $10,000 for exemplary damages, and the Supreme Court (Can.) varied the judgment of the Queen's Bench, Appeal side, fixing the damages at a *lump sum* of $100.

Note.—This Supreme Court judgment affirms the principle that when no license fee has been established, and no other rule can be found, that defendant's profits are the criterion of plaintiff's loss, and that they must be measured by the advantage defendant derived from the use of plaintiff's invention over that which he had in using other processes and the best known mode then open to the public, to obtain a like beneficial result (the rule in *Whitney* v. *Mowry*), and that you cannot refer it to an antiquated mode.

And that in the absence of direct evidence bearing on the matter the Court will assess a sum for damages in the same way as a jury.

In *Carter* v. *Rose*, tried at Toronto, April 30th, 1890, before Boyd, C., the Chancellor adopted the novel method, where damages were troublesome to estimate and apparently of no great extent, of getting plaintiff's counsel to fix a sum which he claimed as damages, and then sending it to the Master, and let the costs depend on the result. If, on a reference, they turned out less, plaintiff would have to pay the costs of reference, if more would obtain costs.

When the entire profit of a business results from the use of the invention, the patentee will be entitled to recover the entire profits if he elects that remedy: *Carter* v. *Baker*, 4 Fisher's Pat. Cas.; *Hurlburt* v. *Schillinger*, 19 Brodix, 542 (1889); *Sayre* v. *Scott*, U. S., Cir. Ct. of App., 3rd Circuit (May 23rd, 1893), 63 O. G., p. 1818.

If there be no advantage gained by use of an invention, there can be no profits, and the plaintiff's only remedy in U. S. A. is an action at law for damages: *Tilghman* v. *Proctor*, 17 Brodix, 552. In Canada, if no advantages be gained by the use of the invention, it is difficult to see how any damages could be recoverable.

Ante-Mortem Profits Not Recoverable.

In *Leslie* v. *Calvin*, 9 Ont. R., 207 (1885), an action by plaintiff against the executors of D. D. C. for an account of all the profits accrued to estate of D. D. C. by user of a patented machine which consisted in the saving of expense to D. D. C. :—

Held, on demurrer to the statement of claim, that plaintiff had no remedy against the executors in respect of such profit accrued to him prior to his death, and that the doctrine "*actio personalis cum persona moritur*" applies: Ferguson, J., March 30th, 1885.

Phillips v. *Homfray*, 24 Ch. D., 439, was deemed decisive; in that case it was held on appeal, "that a remedy for a wrongful act done by a deceased person cannot be pursued against his estate, unless property or the proceeds or value of property belonging to another person have been appropriated by the deceased person and added to his estate."

Semble (also following *Phillips* v. *Homfray*), that if the statement of claim could be read to mean that by reason of the wrongful act complained of property of a tangible character passed from the plaintiff's estate to that of D. D. C., as distinct from the saving of expense, the conclusion might be different.

Treble Costs as Damages.

The Patent Act of 1826 for Upper Canada provided for the trial of an infringement suit by a jury for damages and the recovery of treble costs, and section 7 of the Patent Act of 1851 (Can.) made the party making, manufacturing or using the patented article without the written consent of the patentee, liable to damages and treble costs as taxed as previously provided.

Since Consolidated Statute (Can.), c. 34 (1859), this provision as to treble costs has been dropped out; and there is now no special provision for the trial by a jury of an infringement suit, and a jury is now invariably dispensed with.

30. Any action for the infringement of a patent may be brought in any court of record having jurisdiction, to the amount of damages claimed, in the Province in which the infringement is alleged to have taken place, and which is also that one of the said courts which holds its sittings nearest to the place of residence or of business of the defendant; and such court shall decide the case and determine as to costs. 35 Vic., c. 26, s. 24, *part*.

NOTE.—Actions for infringement of a patent, as they always involve questions of injunction and account or damages and relate to matters of more than Provincial interest, are, in Canada, Superior Court actions; as appears to be also the case in the United States and Great Britain. An injunction or execution, however, in a Provincial Court relates only to the Province in which the action has been brought.

Exchequer Court Jurisdiction, Since 30th Sept., 1891.

By 54, 55 Vic., c. 26 (1891), "An act to amend the Exchequer Court Act," assented to 30th September, 1891, the Exchequer Court Can. obtained concurrent jurisdiction with the Provincial Courts "in all cases in which a remedy is sought respecting the infringement of any patent of invention, copyright, trade mark, or industrial design": *Vide* section 4, sub-section (*c*), of said Act 1891, quite irrespective of the amount of damages claimed.

Appeal to Supreme Court (Can.).

And by section 8 of said Act of 1891, amending paragraph (*b*) of sub-section 1 of section 52 of the Supreme and Exchequer Court Act (1887), an appeal lies on any question relating *to a patent of invention, copyright, trade mark, or industrial design*, to the Supreme Court Can., irrespective of the amount of damages involved.

The advantage of bringing an action in the Exchequer Court is, that an injunction or execution sued out is enforceable throughout the whole of the various Provinces and territories of the Dominion of Canada.

The procedure in Provincial Courts varies according to the Province in which the action may be brought.

Procedure in Exchequer Court (Can.).

But in the Exchequer Court no writ of summons is issued and the action is commenced by statement of claim, which by Rule 9, if over three folios in length, must be printed, and if under three may be either printed or written, or partly both, the same rule applies to all other pleadings. *By Rule 63*, pleadings may be amended by written alterations, unless over 100 words in any one case.

The statement of claim and other pleadings are to be signed by counsel, and the original statement of claim having been duly stamped with a $2 law stamp and under the seal of the Court, is filed of record in the Registrar's Office, at Ottawa.

Certified Copy of Statement of Claim in Lieu of Writ.

Certified copies of the statement of claim, certified to be true copies of the original on file, under the seal of the Court and hand of the Registrar, and with a $2 law stamp affixed, are then to be obtained from the Registrar for each of the parties to be served.

Endorsement.

On the back of the statement of claim or information is the form of endorsement of notice to defendant: (*Vide* Form 34, Appx. II.)

The form of pleadings may be those in use in the Province of Ontario in similar actions.

By Rule 12, a party printing any pleading shall, on demand, supply the opposite party with any number of printed copies of pleading not exceeding ten, at five cents per folio for the first copy, and three cents for every other copy.

By Rule 15, service of the office copy of statement of claim to be personal, the original need not be produced at the time of service.

By Rule 27, if the defendant resides in either of the Provinces of Ontario, Quebec, Nova Scotia, New Brunswick or Prince Edward Island, the statement of defence or demurrer must be filed with the Registrar at Ottawa within one month after service.

If the defendant resides in either of the Provinces of Manitoba or British Columbia within two months after service.

Every application for an order in Chambers, *by Rule 225*, is by way of summons; for form of summons (*vide* Form 27, Appx. II.), and for form of warrant for particulars, *vide Form 28, Appx. II.*

After defence filed, *by Rule 86*, parties to the suit may be examined for discovery, for which purpose, *by Rule 89*, a subpœna may issue to enforce attendance; *by Rule 55*, pleadings are closed with joinder of issue by either party, and, *by Rule 53*, there can be no subsequent pleading without the order of the Court or a Judge.

By Rule 40, joinder of issue shall operate as denial of every material allegation of fact in the pleading upon which issue is joined.

And any person filing an affidavit to be used on a motion may, *by Rule 135*, be cross-examined thereon before the Registrar or any other specified person; *by Rule 137*, such affidavit is to be filed before the summons is served.

Præcipe orders for discovery, *by Rule 95*, may be issued by the Registrar to either party after defence filed, and the opposite party must specify which, if any, of the documents he objects to produce, following the usual form in use in Ontario in ordinary suits.

By Rule 131, in the absence of special agreement, issues of fact shall be triable according to the laws of the Province in which the cause originated, including the laws of evidence, or by order of the Judge any special fact may be proved by affidavit, or a commission may issue for examination *vivâ voce*, or by interrogatories.

By Rule 220, notice or summons is to be served two clear days before hearing.

In the Exchequer Court, *by Rule 250*, months are calendar months, unless lunar months are specified.

By Rule 251, Sunday, or a public fast or thanksgiving day, or any other non-juridical day or legal holiday, shall not be counted in the computation of time, when the time for doing any act or taking any proceeding is less than six days.

By Rule 252, when the time for taking any proceeding expires on a Sunday or a day on which office is closed, the time for doing shall be extended to the day on which the office shall next be open.

Rule 116 as to trials, was repealed 12th January, 1891, and a new one substituted, whereby a day might be fixed for trial on summons, or ten days notice of trial given as stated, and the case regularly set down, and *Rule 120* was repealed on the same date, and a new one substituted, whereby, if the Judge is unable to attend at the sittings, they shall stand adjourned till he is able to attend.

Sittings of Exchequer Court (Can.).

The Judge holds sittings of the Court at Toronto, at Ottawa, at Montreal, P. Q.; at Sydney, Cape Breton; at Halifax, Nova Scotia; at St. John, New Brunswick; at Charlottetown, Prince Edward Island; at Winnipeg, Manitoba; at Vancouver, British Columbia, and other places, and at such dates as may be fixed by General Order published in the *Canada Gazette*.

General Rules and Orders of Exchequer Court (Can.).

The general rules and orders of the Exchequer Court of the 4th March, 1876, of which there were of the latter 261, (*vide* Cassel's Manual, 1877), as modified by subsequent general rules and orders (which may be found in the Appendices of the printed volumes of the Exch. Ct. Rep., Can.), are those still in force.

Subject to such general rules and orders, the practice and procedure, from time to time in force, in H. M. High Court of Justice, England, in respect of like actions taken in the Exchequer Court by virtue of the Exchequer Court Amendment Act of 1891 shall apply: *Vide* General Order, 13th November, 1891, dated at Ottawa, Geo. W. Burbidge, *J. E. C.*—Form 51, Appx. 2.

Cost of Writing Out Evidence.

In the Exchequer Court of Canada, where judgment is reserved and a copy of evidence is ordered by the Judge, one of the parties to the suit is charged with the cost of writing out the evidence; a special order also has to be obtained to obtain exhibits off the file even though consent of opposite party be obtained, which seems like putting parties to $4 or $5 unnecessary expense.

Retrospective Jurisdiction of Exchequer Court (Can.).

As the Court of Exchequer only acquired jurisdiction in the matter of infringement of any patent of invention on 30th September, 1891, it may be questioned whether it now has jurisdiction with respect to causes of action arising prior to that date. It would appear from the following, that a retrospective effect was given.

In Maxwell, on Interpretation of Statutes, p. 199, the presumption against a retrospective construction has no application

to enactments which affect only procedure and practice of the Courts: *Wright* v. *Hale*, 6 H. & N., 227; 30 L. J. Exch.

"A law which alters procedure may with perfect propriety be made applicable to past as well as future transactions": Macaulay's History of England, vol. 3, 715; vol. 5, 43.

With respect to a lease made before the Act was passed, the Act was retrospective: *Vide Page* v. *Beamish*, 29 L. J. Ch., 398.

And on p. 200, Maxwell, two admiralty cases indicated the same view: The Alexander Larsen, 1 W. Rob., 288; The Ironsides, Lush., 458; *Brooks* v. *Becket*, 9 Q. B., 847; *Scadding* v. *Eyles*, 9 Q. B., 858.

See also Wilberforce's Statute Law; *The Operation of Statutes*, p. 162.

The Bankruptcy Acts were applied to debts contracted and settlements executed before these Acts were passed: *Ex parte* Somers, 2 De G. M. & G., 263, p. 166. Statutes which do not interfere with the rights of parties, but merely regulate the practice and procedure of the Courts are retrospective: See *Rathbone* v. *Munn*, 9 B. & S., p. 712, 713; *Kimbroy* v. *Draper*, L. R., 3 Q. B., 160.

The Supreme Court of the United States has laid down the same rule, and has remarked "how absurd it would be for a litigant to claim as a vested right the right of delaying justice": See *People* v. *Tibbets*, 4 Cowen, Sup. Ct., 384, 392.

In *de Kuyper* v. *Van Dulken*, 3 Exch. Ct. R., Can. and *S. C.*, 4 Exch. Ct. R., Can., Burbidge, J. E. C., intimated that the Exch. Ct. (Can.), had retrospective jurisdiction in respect of the infringement of trade marks.

Process.

Prior to the jurisdiction given to the Exchequer Court, the action for infringement had to be brought in that Province where the infringement had taken place. So that where the plaintiff lived in Ontario and the infringement took place in Quebec, or some other Province, it was very awkward to institute a suit—particularly if the defendants were Government contractors moving from one Province to the other, as has been the case in one suit at least.

Now the Exchequer Court gives greater facilities in such a case, and its process reaches every part of the Dominion.

Patric v. *Sylvester*, 23 Grant (1876), was an instance of a suit brought in Ontario on a patent, granted by the Province of New Brunswick in respect of infringement in Ontario.

There is no sense in the reference to the Court "having jurisdiction to the amount of the damages claimed" in this section; for damages might be nominal merely, the infringement being promptly stopped and the damages be for an amount within the jurisdiction of the County or Division Court, while the infringement might be with respect to a very valuable patent; besides that, damages are always unknown at the outset of a suit, and at the best, at the close of a successful suit are extremely difficult to arrive at.

The amount of damages endorsed on the writ of summons or claimed in the statement of claim is pure guess work, the intention always being to claim much more than you expect to get, so as to avoid the awkward position of being found to have suffered greater damages than you make claim for.

Venue.

The following cases bear on the question of venue:—

In *Goldsmith* v. *Walton*, 9 Prac. R. (Ont.), 10 (1881), the Master in Chambers held that the provisions of the Judicature Act, Ont., Rule 254 (present Rule 653), abolishing *local venue* in Ontario, except in actions of ejectment superseded this section 30 of the Dominion Act; but held on appeal to Osler, J., that under the Judicature Act the Judge had discretion without discussing the question of "*ultra vires*," and the *venue* was laid at Toronto, where defendant resided.

In *Aitcheson* v. *Mann*, 9 Prac. R. (Ont.), 253, the Master in Chambers having found that above sec. 35 Vic., c. 26, was repealed by Rule 254, O. J. A. (now Rule 653), made an order changing the *venue* from the county where alleged infringement occurred, ordering defendants to pay plaintiff $134.95, the costs of bringing his witnesses to Brockville.

On appeal to Boyd, C., October 10th, 1882: *Held*, that the plaintiff took his patent subject to the conditions in the Act which

prescribed where the *venue* is to be laid; under Rule 254 (*supra*), plaintiff might have *the venue* at Belleville if the defendant did not object.

S. C., on appeal to Div. Ct., Q. B. D. (Ont.), *Held*, that this section as to laying *venue* was not *ultra vires* of the Dominion Parliament, and that the word "*may*" as governed by the context was obligatory and not merely permissive, and that the *venue* should be laid at the place for holding Court nearest the place of residence of the defendants.

The section lays the *venue* "nearest to the place of residence *or* of business of the defendant" in the alternative; the defendant might reside near a branch office of his business, in which case the *venue* might be laid at the county town nearest the head office, which might be in a distant county.

Foreign Commission.

Smith v. *Greey* (June, 1885), Can. L. T., vol. 5, p. 330, to obtain the issue of a foreign commission it is not necessary that the case should be technically at issue; it is sufficient that some issue be raised on the pleadings, which must infallibly be tried, if the action be tried at all.

An action for infringement and for an injunction and damages lies *for any cause of action arising during the term granted by the Letters Patent, and within the territory covered thereby*: See Walker, on Patents, sec. 434.

An action for infringement is not barred by the lapse of six years in Ontario, or say five years in Quebec, from the time of last act of infringement, although possibly no more than six years' arrears of interest on royalties due, when royalty is the measure of damages, may be recovered in Ontario (see *Wiley* v. *Ledyard*, 10 Prac. R., Ont., 182), or five years' interest on arrears in Quebec.

When Right of Action Expires in Canada.

In the States between July 8th, 1870, and January 22nd, 1874, there was a National Statute of Limitations, whereby "all actions shall be brought during the term for which the Letters Patent shall be granted or extended, or within six years after the expiration thereof": Sec. 55, U. S. Act of 1870.

This was done away with when the U. S. Statutes were revised in June, 1874, and has no application to any infringement committed since June 22nd, 1874, in U. S. A.

Judging from the analogy of the patent law in the United States, it would appear that the right to institute an infringement suit in Canada expires with the patent. We have no Statute of Limitation (as was at one time the case in the States) with respect to Letters Patent of Invention, extending the time, within which suit may be brought, beyond the expiration of the patent.

The Ontario Statute of Limitations of certain actions (c. 60, R. S., Ont., 1887) has obviously no bearing on the subject of the infringement of Letters Patent of Invention.

In France.

In France infringements cannot be proceeded against unless committed within three years of the date of commencement of the lawsuit, but if the infringements have been continuous or repeated over a lengthened period, and a part of them have been committed within the three years, an action can be brought for the entire series.

In Germany.

The same three years' prescription after an Act of infringement also prevails in Germany.

In Switzerland.

In Switzerland action must be brought within two years of the date of the last infringement, and in the Canton where the infringement took place.

As to Jury Trials.

In the Patent Act of 1826, suits for infringement were to be tried by a jury; this continued to be the practice for a number of years. The Patent Act of 1869 was made paramount to Consolidated Statutes of Canada, c. 34 (1859), (which consolidated the Patent Acts of 1849 and 1851) which latter Act of 1859 was repealed, so far as inconsistent with the Patent Act of 1872.

Neither the Act of 1872 nor any subsequent Act has specific-

ally defined how a suit for infringement is to be tried, and trial by jury has not been specifically abolished in patent suits: *Bonathan* v. *Bowmanville*, 31 U. C., Q. B. R. (1871), tried at Whitby Spring Assizes, in 1870, is the last reported case of a jury trial of an infringement suit in Ontario. In *Beam* v. *Merner*, 14 Ont. R., 412, we have an action to recover royalties tried before a jury at Berlin, August, 1886.

Jury Notice Struck Out.

In *Vermilyea* v. *Guthrie*, 9 Prac. R., 267 (9th October, 1882), a transfer from the Chancery Division to Common Pleas Division was not allowed, and a jury notice was struck out: *Held*, by Boyd, C., that an action for infringement of a patent should not ordinarily be tried by a jury.

If the action be brought in the Chancery Division, H. C. J. (Ont.), it would not, under any circumstances, be triable by a jury. Since the Ontario Judicature Act (1881) it has been immaterial whether suit be brought in the Queen's Bench, Common Pleas or Chancery Division of the High Court of Justice (Ont.), as a matter of fact, patent suits are usually tried at the Chancery sittings, no matter what division they may be brought in, owing to the usually crowded state of the Assize dockets, except in the country districts.

No Jury in England Unless Court so Directs.

In England by section 28, Patent Act (1883), the action shall be tried without a jury unless the Court shall otherwise direct, and the Court may, at the request of either of the parties, if it see fit, call in the aid of an assessor specially qualified to try and hear the case, *wholly* or partially, with his assistance: *Vide Badische Anilin and Soda Fabrik* v. *Levinstein*, 24 Ch. D., 156; 48 L. T. (N. S.), 822, where a scientific chemist was called in by the Judge to make experiments personally, each party choosing a chemist to be present at the experiments made in the matter of the validity of a patent for making dyes.

This English section might well be incorporated into our Patent Act to avoid the possibility of a case of the blind leading the blind, which is quite likely to occur in the case of a suit involving a knowledge of electrical or chemical science.

In Quebec, Experts Called.

In Province of Quebec, in *Dansereau* v. *Bellemare*, 12 L. N. 76 (afterwards in appeal, 16 Sup. Ct. Rep., Can.), although there is no provision in our Act, the Judge appointed two experts, who reported that there was an infringement, and on their report, he awarded $100 damages and enjoined the defendant.

In the U. S. A., in many States patent suits are still triable, either at law or in equity. If a trial be at law, a jury is called; if in equity, the Judge tries the case without a jury; but in U. S. A. there is not the fusion of law and equity which prevails in Canada and England.

Suggested Addition.

The words "*and damages*" might be added to the end of this section 30 to make it conformable to section 29, and the first portion of the section.

Parties to Suits.

In the U. S. the plaintiff in an infringement action may be the patentee or sole assignee; or any grantee may sue alone for infringement within his territory: *Wilson* v. *Rosseau*, 4 How., 646, Rev. Stat., sec. 4919.

And an action may be brought by executors or administrators: *Vide Rubber Co.* v. *Goodyear*, 9 Wall., 791 (1869); *Wilkins* v. *Elliott*, 108 U. S.

Licensees under patents cannot bring actions in their own names for infringements: *Wilson* v. *Chickering*, 14 Fed. Rep., 917 (1883), and cases cited in Walker, sec. 400; but in equity, in the States, should be joined with the owner: *Hammond* v. *Hunt*, 4 Ban. & Ard., 113 (1879); *Birdsell* v. *Shalliol*, 15 Brodix, 354 (1884), and grantees of interests in districts, from which the grantor is excluded, should join the grantor as party to the suit.

In the U. S., where a patentee has assigned undivided interests, the joint owners must sue jointly for infringement: *Moore* v. *Marsh*, 7 Wall., 515 (1868); *Otis Manufacturing Co.* v. *Crane Manufacturing Co.*, 27 Fed. Rep., 558 (1886), which does not seem consistent with the view that each may deal with the patent as he chooses without liability to account: *Vide* note (*a*), sec 7.

Expert Evidence.

The evidence of experts as to the construction of a specification is inadmissible, and except as to the meaning of scientific terms, or as to the working of mechanical appliances or as to what such working will bring about, expert evidence should not be admitted: *Gadd* v. *Mayor, etc., Manchester*, R. P. C., vol. 9 (1892), p. 530.

The opinions of experts are to be taken into consideration but are in no wise binding on the Court, per Lord Esher, M. R.: *Leadbeater* v. *Kitchin*, R. P. C., vol. 7, p. 247 (1890).

Parties to Suit in England.

In England, however, one of several joint owners may bring an action in his own name: *Sheehan* v. *Great Eastern R. W. Co.*, 16 Ch. Div., 59; and this would appear to be the more logical view, for under note (*a*), sec. 7, we have seen that it has been settled both in U. S. and England that one of several joint owners of a patent can deal with it as he chooses, without liability to account to any of his co-owners.

Defendant has no right to force plaintiff to sue the manufacturer also: *Moser* v. *Marsden*, R. P. C., vol. 9 (1892), p. 214.

The assignee for a district may bring an action for infringement, but the infringement must be within his district: *Dunnecliff* v. *Mallett*, 7 C. B., N. S., 209.

But a mere licensee can maintain no action against any one else for the infringement of a patent: *Derosne* v. *Fairie*, 1 Web. P. C., 155; *Renard* v. *Levinstein*, 2 Hem. & M., 528.

But an exclusive licensee, that is, exclusive within an area, may use the name of his grantor in an action: *Renard* v. *Levinstein* (*supra*), but is liable to give his licensor security for costs: *Evans* v. *Rees*, 2 Q. B., 334.

A licensee, who has the exclusive right to manufacture and sell a patented article, can maintain a suit in equity against the patentee, if the latter infringes by making and selling himself: *Waterman* v. *Shipman* (decided April 18th, 1893), U. S., Cir. Ct. of App., 2nd Circuit, 64 O. G., U. S., p. 713.

Mortgagors of a patent can sue to restrain infringement without joining their mortgagees whose names appear on the register: *Van Gelder & Co.* v. *Sowerby Bridge Flour Society*, R. P. C., vol. 7, p. 208 (1890), 44 Ch. D., 374.

The assignees in insolvency as well as executors and administrators, may bring an action in their own name: *Bloxam* v. *Elsee*, 6 B. & C., 169.

An action may be brought against the manufacturer and the user, or either of them, as well as employer and employee, though damages are not recoverable against the latter: *Woodward* v. *Clement*, 10 Ont. R., 368.

An objection to the validity of a patent, on the ground of the expiration of a foreign patent for the same invention, cannot be taken at the hearing, unless raised in the answer: *Bovell* v. *Goodier*, L. R., 2 Eq., 195.

A licensee cannot sue in his own name without joining the patentee as co-plaintiff, the exclusive license being simply an authority to do lawfully that which would otherwise be unlawful, and not being a license coupled with or equivalent to a grant: *Heap* v. *Hartley*, 42 Chy. D., 461.

N. B.—The meaning of a grant may be taken to be the same here as in United States, being a conveyance of an interest in a territory from which the patentee is excluded.

Where a patent had been established in a previous action the suspension of injunction and account pending appeal was refused: *Otto* v. *Steel*, R. P. C., vol. 3 (1886), p. 121.

Jurisdiction of County Court.

A County Court (Eng.) has no jurisdiction to try a patent case in which the validity of the patent is disputed: *Held*, by the Court of Appeal, that the right put in issue was a franchise: *Regina* v. *County Court Judge of Halifax*, R. P. C., vol. 8, p. 338.

Appeals to the Privy Council.

There is an appeal to the Privy Council from the judgment of the Supreme Court of Canada, but not of right. By section 71 of the Supreme Court Act, 49 Vict., c. 135 (1886), "the judgment of the Supreme Court shall in all cases be final and conclusive, and no

appeal shall be brought from the judgment or order of the Supreme Court to any court of appeal established by the Parliament of Great Britain and Ireland, by which appeals to Her Majesty-in-Council may be ordered to be heard: saving any right which Her Majesty may be graciously pleased to exercise by reason of her royal prerogative. 38 V., c. 11, s. 47."

In a patent case, the first step is to apply for "*leave to appeal*," for *primâ facie* there is no right to appeal to the Privy Council, and it is a matter of some difficulty to obtain the requisite leave. In *Smith* v. *Goldie*, 9 Sup. Ct. R., Can., 46, special leave to appeal was refused: See p. 1549, Ont. Dig. (1880-1890), this is the only patent case in which leave was applied for. The Privy Council considered there was only a question of fact in dispute, and as to the construction of a document, and on these grounds declined to interfere.

The cases go to show that the Privy Council will not advise Her Majesty to admit an appeal from the Supreme Court, Can., save where the case is of gravity, involving matters of public interest or some important question of law, or affecting property of considerable amount, or where the case is otherwise of some public importance, or of a very substantial character: *Prince* v. *Gagnon*, 8 App. Cas., 103; *Johnston* v. *St. Andrews*, 3 App. Cas., 159; *Valen* v. *Langlois*, 5 App. Cas., 115.

It is not enough that the questions involved are of great importance to the parties, or calculated to attract public attention: *Dumoulin* v. *Langtry*, 57 L. T. N. S., 317.

Special leave to appeal was refused in a case involving only an issue of fact: *Canada Central R. W. Co.* v. *Murray*, 8 App. Cas., 574.

In *Prince* v. *Gagnon* (*supra*), special leave to appeal from the Supreme Court of Canada was refused, the case depending on a disputed matter of fact where there had been a gift or sale of goods to the value of £1,000.

Johnston v. *St. Andrews* (*supra*): It is Her Majesty's prerogative to allow an appeal. The Privy Council declined to advise its exercise where the amount at issue was only $300, and where the question was the construction of a particular contract.

Dumoulin v. *Langtry* (*supra*): Where the case will not be decisive of any principle of law, the Privy Council will not give

leave to appeal from the *unanimous* decision of the Courts below (nine Judges being unanimously against plaintiff), on the ground that the questions involved are of great consequence or calculated to attract public attention.

Canada Central R. W. Co. v. *Murray* (*supra*): The petition must state fully and succinctly the grounds upon which it is based, the record not being before their Lordships until forwarded by the proper authorities.

The Privy Council expect parties to confine themselves to the petition, and will not allow them to wander into extraneous matter, such as the record and proceedings, over which the Board, until an appeal is permitted and papers are sent to England by the proper authorities, have no control, and which they cannot accept as correct on an "*ex parte*" statement, which an application for leave to appeal is.

There are no fixed dates for the sittings of the Privy Council; there are sittings early in the year, during July and August, and the Fall Sittings usually commence the first Tuesday in November. The date of sittings is known two or three weeks before they commence, and the usual practice for the Board is to hear on the first Saturday of the sittings, all petitions for leave to appeal which up to that time have been deposited.

It is not necessary in applying for special leave to appeal to go to the expense of having a *certified* copy of the record forwarded by the official of the Court below, to the Registrar of the Privy Council. It seems to be a mistake commonly made in this country, that a *certified* copy is required. A *certified* copy is only required to be forwarded after special leave to appeal has been granted.

For the purpose of preparing the petition for leave to appeal, the solicitors in England require an uncertified copy of the entire proceedings in the Supreme Court of Canada, a similar copy of the formal judgment of that Court, and a similar manuscript or typewritten copy of the reasons given by the Judges of that Court.

Two copies of the appeal book and factums in the Supreme Court should be sent for the use of the English solicitors and of the counsel employed on the case.

An application for leave to appeal is *ex parte*, no notice being required to be given to the other side. But if the other side get wind that an application is to be made, and give notice of opposition at the Privy Council Office, London, England, their solicitors in England, who give the notice, are entitled to be served with a copy of the petition, and to attend and oppose at the hearing. If an application for *special leave* is unsuccessful, the opposing parties are entitled to their costs.

There is no minimum limit of the amount which the Privy Council take cognizance of in case of an application from Canada for leave to appeal, Her Majesty exercises her royal prerogative. It is only in the case of an "*appeal of right*," where no special leave is wanted, that the Privy Council refuse to take cognizance of matters involving trivial sums.

The minimum limit has been fixed by Order-in-Council or Colonial Statute at a different figure for different colonies. In Ontario the limit *is $2,000* where there is "*a right to appeal*," but this has no applicability in the case of Letters Patent of invention.

The counsel who is to hold the brief at the argument settles the petition, which has to be signed by the solicitors, and not by the parties themselves.

The rule is, that the material facts should be stated succinctly, and the grounds for contending that the judgment of the Court below is wrong, should also be stated shortly and concisely—it is not proper to set out the judgment, in a petition, in full.

The reason why the petitioner feels aggrieved should be stated, also the grounds upon which he conceives himself entitled to have special leave to apply, also the points on which the Judges of the Supreme Court (Can.) have gone wrong in point of law.

Form of Petition.

The petition is addressed to "The Queen's Most Excellent Majesty in Council," and is entitled, "In the matter of an action lately depending in the Supreme Court of Canada." Between A B and C D (set out style of cause in Supreme Court). The

humble petition of ——— showeth ——— (1) Here set out the judgments below and state shortly the grounds on which the Supreme Court gave judgment. (2) Here state reasons why the petitioner feels aggrieved. (3) Here state the ground upon which the applicant conceives himself entitled to have special leave to appeal; and that the petitioner is able and willing to enter into the required securities for the costs of an appeal herein.

The petition concludes as follows:—

"Your petitioner therefore most humbly prays that Your Most Excellent Majesty in Council will be graciously pleased to order that your petitioner shall have special leave to appeal from the said judgment of the said Supreme Court of Canada, and that the said Supreme Court may be ordered to transmit forthwith the transcript of the pleadings and evidence and other proceedings in the said matter to the Privy Council Office, and that the said judgment of the said Court dismissing, etc., be set aside, and that Your Majesty may be graciously pleased to make such further or other order as to Your Majesty in Council may appear just and proper. And your petitioner will ever pray.

Bond in $2,000.

If leave to appeal be allowed, the petitioner must give a personal bond to the respondent or respondents, such bond to be executed by the appellant or appellants, or one or more of them, and by two sufficient sureties, in the penal sum of $2,000.

The cost of obtaining leave to appeal, if no Canadian lawyer makes a special journey to England, so as to be present, may be put at from $800 to $1,000, the English solicitors' charges are about £60, and counsel fee from £50 to £100, and more, besides the costs of the Canadian solicitor.

If the appeal be allowed, all the printing has to be done over again in England, the printing is on both sides of the pages and the book is differently gotten up from that in Canada.

In re Smart, the printing had been done in Canada by mistake, but had to be all done over again, at much expense, in England.

Besides *re Smart*, there have been several Ontario cases where leave to appeal has been allowed, notably, in the matter of the *Baldwin Estate*; *Duggan* v. *London and Canadian Loan and Agency Co.*; *Cameron* v. *Bickford, etc., etc.*

The costs of an appeal after leave has been obtained are very considerable; counsel fees are regulated by the number of folios in the case.

Further particulars as to appeals may be obtained in Mr. Lattey's work and Macpherson's work, to be seen in Osgoode Hall Library, Toronto.

31. In any action for the infringement of a patent, the court, if sitting, or any judge thereof if the court is not sitting, may, on the application of the plaintiff or defendant respectively, make such order for an injunction, restraining the opposite party from further use, manufacture or sale of the subject matter of the patent, and for his punishment in the event of disobedience of such order, or for inspection or account, and respecting the same and the proceedings in the action, as the court or judge sees fit; but from such order, an appeal shall lie under the same circumstances, and to the same court, as from other judgments or orders of the court in which the order is made. 35 V., c. 26, s. 24, *part.*

NOTE.—This and the preceding section formed together section 24 of the Act of 1872.

Infringement.

The question of infringement is a very broad one, and it is impossible to lay down any universal rule, each case must be dealt with by itself.

Infringement of patents for machines usually takes place by the substitution of "equivalent parts"; we have dealt with the question of "mechanical equivalency" under *section 16, note* (*a*). If indeed there be substantial identity between the patented article and the alleged infringing device, which is not often the case, no difficulty can arise in determining the matter; but usually it is a matter of prime importance to determine the question of infringement; admissions of infringement in the pleadings, or the unequivocal admission or the determining of infringement by preliminary examination of the parties, alleged to be guilty of infringement, may settle the question before the day of trial; in which case the plaintiffs may be in position to file their patent and close their case without going into evidence, leaving it to the opposite side to attack the patent so as to bring up the question

of validity, which may be a mixed question of law and fact; of law, as to the sufficiency of the specification, and of fact, as to the question of anticipation. This has already been largely dealt with under section 16, as well as when treating of "double use," "aggregation," "mechanical skill," "omission of an element," "change of form," "duplication," "substitution of material," etc., etc., "anticipation" and "publication" as bearing on validity: See notes to section 16.

It is not infringement to make use of or sell anything which is described but not claimed: *Waterbury Brass Co.* v. *Miller*, 9 Blatch., 93 (1871); *Toohey* v. *Harding*, 4 Hughes, 253 (1880).

Machines and manufactures, being both of a tangible nature, are subject to the same rules and conditions with respect to the question of infringement; change of function, or substantial difference in the result produced are evidence of a new combination such as may avoid the charge of infringement.

Any person may accomplish a result performed by a patented device, provided he employs means substantially different from those shown in the patent: *O'Reilly* v. *Morse*, 15 How., 62 (1853).

When the improvement is in a well-known machine for effecting an old object, the plaintiff must be confined to the particular details invented by him: *Boyd* v. *Horrocks*, 6 R. P. C. (1889), p. 152; *Bovill* v. *Pimm & Rands* (1856), 11 Exch. R., p. 718.

A patent for a combination is not infringed by a combination which dispenses with one of the elements, and substitutes therefor one that is substantially different in construction and operation, but serving the same purpose: *Crompton* v. *Belknap Mills*, 3 Fish., 536; Curtis, 4th ed., p. 401.

Omission of an Element.

Complainant's patent is not infringed, since the defendant does not employ one of the specified elements—the cards—of the complainant's construction: See *Vincent* v. *Rigby*, 64 O. G., p. 861 (1893); and this principle prevails even where the patentee has claimed more than is necessary to the successful working of his device: *McClain* v. *Ortmayer*, 141 U. S., 415.

See also *Iusk* v. *Miller*, New Brunswick R. (1872), where it was held no infringement to use part of the combination.

Infringement—Essential Differences.

A patent for a water condensing engine is not infringed by an air condensing engine, although the latter involved water condensation as a secondary part: See *Downes* v. *Falcon Works*, R. P. C., vol. 2 (1885), p. 197.

Immaterial Variations.

Patent for *pavement lights*, having for its object lights so constructed as to divert the light in an inclined direction into the rooms which it is desired to light, by using glass moulded so as to consist of an angle or series of angles. The defendants used lights of glass moulded so as to consist of a curve: *Held*, that the defendants had infringed: *Haywood* v. *Pavement Light Co.*, R. P. C., vol. 1, p. 207 (1884).

Mere Making an Infringement.

The mere making of an article for the purpose of sale or use is an infringement, although no actual sale or use has taken place: *Vide* Frost, p. 413; *Muntz* v. *Foster*, Web. P. C., 101; *Jones* v. *Pearce*, 1 Web. P. C., 125; it is also provided in section 29 of our Patent Act, that every person who, without the consent in writing of the patentee, *makes, constructs or puts in practice* the patented invention, is guilty of an infringement.

Infringement of One Claim Suffices.

The infringement of one of several claims infringes the patent in Canada, U. S. A. and England: *Colt* v. *Arms Co.*, 1 Fish., 108; *Pitts* v. *Wemple*, 2 Fish., 10 (1855); *McComb* v. *Earnest*, 1 Woods, 195 (1871), and a number of cases under sec. 339, Walker, 2nd ed.; Terrell, 1st ed., p. 149; Bump., 2nd ed., p. 296; *Hunter* v. *Carrick*, 28 Grant, 489, *et al.*

In England, a patent since the Patent Act, 1883, may have more than one claim (and provided every claim is valid), a patent may be infringed by infringing any one claim: *Gillett* v. *Wilby*, 9 Car. & P., 336; *Smith* v. *L. & N.-W. R. W. Co.*, 2 El. & Bl., 76.

In Canada it does not matter whether all the claims be valid or not, provided the one sued on is.

English Cases as to Infringement of Essential Feature, etc.

The following recent English cases apparently point to the doctrine novel in Canada, that there may be infringement, even though the whole of a claim be not pirated, provided the "essential" part of the invention be taken. In the United States and Canada, the strict rule is, that if an element can be dropped out of a claim, infringement of that claim is avoided. In England, however, the trend of cases go to show that claims are not so strictly treated or scrutinized as in the States, or indeed as in Canada, while the general scope of the invention, as treated in the body of the specification, is considered in England as material. Since the British Act of 1883, providing for claims, they have been held not to be absolutely essential.

In a case where plaintiff's invention consisted of several items, it was held that the defendants had not taken a sufficient part of the combination to constitute an infringement: *Garrard* v. *Edge*, 6 R. P. C. (1889), p. 375.

In *The Automatic Weighing Machine Co.* v. *The National Exhibitions Association, Limited*, 8 R. P. C., p. 345 (1891); *The Automatic Weighing Machine Co.* v. *Knight*, 6 R. P. C., 297 (1889), previously tried, was followed as determining the "essential feature" of plaintiffs' invention, which the defendant, in that case, had not taken.

In this *Knight Case*, it was held, on appeal, that the *essential part* of the plaintiffs' automatic weighing machine was the introduction of the brake in the weighing, and indicating part of the mechanism, so that the index did not operate to show the weight on the dial till the coin was inserted.

And held by Williams, J., "that the decision in *Knight's Case* was, that the essence of the invention consisted in the separation of the indicating and weighing parts of the machinery by means of separate spindles, that this showed a distinct essence or line of thought independently of the combination described; that in such a case there might be infringement, even though the arrangement of parts in the alleged infringing machines was different and new parts substituted, which were not 'mechanical equivalents,' and even though there might be valu-

able improvements, and that in the present case the same separation between the weighing and indicating parts had been adopted, and defendants had infringed."

Lister v. *Leather*, 8 El. & Bl., 1033, commented on. It was argued there that "if a patent be taken for a combination of A, B and C, it could not be infringed by using a combination of B and C only; we are of opinion that the answer to this depends upon what A, B, and C do, how they contribute to the object of the invention and what relation they bear to each other. Cases may possibly be suggested where the use of B and C might not be an infringement; but more easily cases may be put where the use of B and C would be an infringement."

To infringe a combination it is not necessary, in England, that every element should be taken, per L. Halsbury: *Miller & Co.* v. *The Clyde Bridge Steel Co.*, R. P. C., vol. 9.

The essential part of an automatic weighing machine held to have been taken and the invention infringed: *Automatic Weighing Co.* v. *National Exhibition's Association, Ld.*, R. P. C., vol. 9 (1892), p. 41.

In *Thomson* v. *Moore*, 6 P. O. R. (Eng.), 426, the question was whether the defendant had taken the pith and substance of the invention underlying the invention. It was held that defendant had so taken it, and that there was infringement, the difference only being in non-essentials.

In *Flower* v. *Lloyd* (1877), W. N., 132, it was held by the Court of Appeal that in order to constitute an infringement of a patent for a combination, there must be an adoption of that which constitutes the essence of the invention: See also to same effect *United Telephone Co.* v. *Harrison* (1882), 21 Ch. D.; *Sellers* v. *Dickinson*, 5 Exch., 324.

The foregoing English cases show that the question of infringement is differently regarded in England. In Canada and U. S. A., if an element is dropped out from a claim, infringement is avoided.

This mode of viewing "*infringement*" in England, based on these foregoing decisions cited, has apparently not been reversed on appeal, and if this be the law, it certainly makes it much harder to evade a patent in England than in the States or Canada where the whole invention and its subsidiary parts are centered in the claim or claims. In the case, 8 R. P. C., 345, *ante*, there is

nothing in the claims to indicate what was held to be the "essential feature" of the invention. To find this it would be necessary to look to the specifications and drawings. This would not answer in the States nor hitherto in Canada. A startling feature also of this decision is that there may be infringement although new parts be substituted which are not "mechanical equivalents." This has never been so held in Canada or in the States. It appears of doubtful correctness.

Infringement.

A combination of known mechanical contrivances producing a new result held to be infringed by a machine producing the same result by use of "mechanical equivalents" with some alterations and omissions which did not prevent the new machine from being one which took the substance and essence of the patented invention: *Foxwell* v. *Bostock*, 4 DeG. J. & S., 298.

As to this case however Lord Cairns, L. C., in *Harrison* v. *Anderston Foundry Co.*, L. R., 1 App. Cas., at pp. 577-588, said:

"It is said to have been determined in that case, that where there is a patent for a combination, there must be a discovery or explanation of the novelty, and the specification must show what is the novelty and what is the merit of the invention. I cannot think that, as applied to a patent for a combination, that is or was meant to be the effect of the decision in *Foxwell* v. *Bostock*. If there is a patent for a combination, the combination is itself ex-necessitate the novelty, and the combination is also the merit, if it be a merit, which remains to be proved by evidence."

In *Moore* v. *Bennett* (1884), 1 P. O. R., p. 143; Edmunds, on Patents (1890), pp. 137, 138, *Foxwell* v. *Bostock* is positively interpreted to be shortly "where you have a claim for a patent resting upon a combination, you must have that so clearly made out on the specification that the public can know that what you claim is in truth the combination, not the specified things which make up the combination, but the combination itself." See also *Rowcliffe* v. *Morris* (1886), 3 P. O. R., p. 24; Edmunds, p. 139.

From these English cases, it may be inferred that claims have not the same significance or prominence in England as in Canada or the U. S.

But *vide contra*, *Clark* v. *Adie*, L. R., 10 Ch. App. Cas., 674.

Use by defendant's pupils for experimental purposes, is infringement of a patented device: See *United Telephone Co.* v. *Sharples*, R. P. C., vol. 2 (1885), p. 28.

It is no defence to an action for infringement that before the patent was obtained the plaintiff had employed defendant to manufacture a certain number of the articles, if defendant, after he had notice of the patent sold the articles without the authority of the plaintiff: *Clark* v. *Griffiths*, in Appeal, vol. 24 New Brunswick R., p. 567.

The directors of a company, whose servants infringe an invention, are personally liable: *Betts* v. *De Vitre*, L. R., 3 Ch. App. Cas., 441.

The assignees of a patent may bring suit for infringement against the original grantee: *Walton* v. *Lavater*, 8 C. B. N. S., 162, in which case the grantee could not set up the validity of the patent.

It is immaterial whether the defendant was aware that the thing was patented or not: *Stevens* v. *Keating*, 1 Mac. & G., 659; approved in *Heath* v. *Unwin*, 25 L. J., C. P., p. 19; *Curtis* v. *Platt*, L. R., 3 Ch. D., 135.

If the invention be for a combination, whereby an already well-known object is produced, it is no infringement to make another combination to attain the same object. The patent is for the method of combining old and well-known materials, and if another method is adopted there is no infringement: *Curtis* v. *Platt* (H. L.), 35 L. J., Ch., 852.

Certificate in Infringement Suit, England.

In England, if a plaintiff in an infringement suit be successful, the Judge may (under section 31, Patent Act of 1883) certify that the validity of the patent came in question then in any subsequent suit, if successful, the plaintiff shall have full charges as between solicitor and client unless the Court or Judge certifies that he ought not to have them.

We have no such provision here in Canada, and indeed the difference between taxable party and party costs here and taxable solicitor and client costs is not of much moment in favour of the latter.

As to Costs.

In England, also, costs are apportioned according to the issues in which the plaintiff was or was not successful.

And as to the particulars of objections the Judge is to certify to the successful party whether they were reasonable and proper otherwise no costs are taxable in respect of them.

Where defendants denied infringement but did not impeach the validity of the patent and issue was joined; on defendant applying for leave to amend so as to impeach validity, *Held*, that leave must be granted on payment of all costs by the defendants: See *United Telephone Co.* v. *Bussey*, R. P. C., vol. 2, (1885), p. 70.

In *Knickerbocker Co.* v. *Rate*, Prac. R. (Ont.), vol. 16, p. 80, an action by plaintiffs against defendant for infringement of a patent. The defendant was, before action, notified of the infringement but denied it. In the action the defendants, besides denying the allegations in the statement of claim, set up that they had not used the machine alleged to be an infringement and did not intend to use it again, and offered to give a covenant against further use, and paid $10 into Court as damages. This the plaintiffs accepted, and moved in Chambers for the costs of the action, which the Master gave them, November 8th, 1893; but, Robertson, J., on appeal, ordered that the parties should pay, each, their own costs, up to the time of motion (which the defendant had previously offered), and that the plaintiffs should pay the costs of the motion and appeal. Upon a further appeal a Divisional Court composed of Boyd, C., and Meredith, J., there was a division of opinion, January 22nd, 1894, and the appeal was dismissed without costs.

Boyd, C., held that there was nothing to take this case out of the ordinary rule, that the person in the wrong shall answer in costs: *Fennessy* v. *Day*, 55 L. T., N. S., 161 (1886); *Burgess* v. *Hill*, 36 Beav., 244.

Meredith, J., thought the Court could not properly entertain the appeal.

Dismantled Machine Held an Infringement in England.

Where defendants dismantled the telephone machine by taking out the Blake elements, and kept the separate parts stored in a storehouse: *Held*, to be an infringement of the Blake transmitter patent, of which the plaintiffs had obtained an assignment.

The Court refused to order the destruction or delivery up of the infringing machine: *United Telephone Co.* v. *London and Globe Telephone and Maintenance Co.*, 26 Ch. D., 766.

N. B.—It is difficult to see how, under our section 29, this would be considered an infringement in Canada.

Doubts concerning infringement are resolved by Courts in favour of the defendant, although a Court may be satisfied that defendant may have infringed, yet if it have any real doubt it will find defendant not an infringer: *Roper* v. *Manufacturing Co.*, 20 Fed. Rep., 853; *Mallory Co.* v. *Hickok*, 25 Fed. Rep., 827.

Infringement in most foreign countries is an offence punishable by fine, and in case of repetition by imprisonment, and is considered also a wrong, which may be redressed by damages.

In Canada, United States and Great Britain infringement is merely the subject for civil proceedings, and no suit in Canada or U. S. A. can be maintained with respect to infringements occurring prior to the date of Letters Patent, nor in the United Kingdom before the final acceptance of the complete specifications which occurs within ten or twelve weeks before the sealing of the patent.

As to Sale, etc., of Single Element With Intent to Use With Other Elements.

The manufacture and sale of a single element of a combination with intent that it shall be united to the other elements, and so complete the combination, is an infringement: *Saxe* v. *Hammond*, Holmes, 456; *Wallace* v. *Holmes*, 9 Blatch., 65; *Barnes* v. *Strauss*, 9 Blatch., 553; *Schneider* v. *Pountney*, 21 Fed. Rep., 399.

The Supreme Court, U. S., in *Morgan Envelope Co.* v. *Albany Perforated Paper Co.* (decided *March 19th, 1894*), reported in P. O. News, vol. 1, p. 25, was of opinion that these last named cases have no application to one where the element *made* by the alleged infringer is an article of manufacture perishable in its nature, which it is the object of the mechanism to deliver, and which must be removed periodically whenever the device is put to use. The Court was referring to an oval roll of toilet paper used on a fixture, and the question to be decided was whether,

conceding the combination of the oval roll with the fixture to be a valid combination, the sale of one element of such combination with the intent that it shall be used with the other element, is an infringement. The Supreme Court, U. S., held this to be no infringement, and added: "Of course, if the product itself is the subject of a valid patent, it would be an infringement of that patent to purchase such product of another than the patentee; but if the product be unpatentable, it is giving to the patentee of the machine the benefit of a patent upon the product, by requiring such product to be bought of him."

He who owns a territorial right under a patent for a machine may sell the products of the machine outside his territory without being an infringer: *Simpson* v. *Wilson*, 4 How., 709.

A patentee of a car brake licensed a railway company to use his device; a creditor of the company operated the railway and used the brake, the creditor was held not an infringer: *Emigh* v. *Chamberlain*, 1 Biss., 367.

The use of infringing articles made during the life of the patent will be enjoined after the patent expires: *Boving Co.* v. *Sheldon*, 18 Blatch., 50.

Members of a partnership can be sued individually as infringers, but the secretary of a partnership association is not individually liable: *Tyler* v. *Galloway*, 21 Blatch., 66.

As a rule absence of *intent* to infringe is no excuse: *Hawes* v. *Washburne*, 5 O. G., 491; *McCormick* v. *Gray*, *Newell* v. *Elliott*, and *Curtis* v. *Platt*, referred to in Higgins' Digest, p. 400.

Mere changes in *form*, *number* and *size* or location do not avoid infringement unless it brings with it a change of function, so as to establish a substantial difference: *Werner* v. *King*, 96 U. S., 218.

In a recent suit relating to the Edison patent for the incandescent lamp, it was held that what was known as the "Novak" lamp, which required a much less attenuated atmosphere (a part being bromine vapor), was an infringement; this was affirmed in the Circuit Court of Appeals sitting in New York, which decided against the Waring Electric Company; thus holding that the use of an inert gas in a partial vacuum was an infringement of the Edison patent.

In a suit brought by the *General Electric Co.* v. *The Davis Electrical Co. of Springfield, Mass.*, it was held by Colt, J., that the repairing of incandescent lamps by the renewal of the burnt-out or broken carbon filaments constituted an infringement of the Edison patent. This finding was affirmed in the Appellate Court: But see *Morgan Envelope Co.* v. *Albany Perforated Paper Co. ante.*

Jurisdiction of U. S. Courts.

An injunction against infringement of a patent in U. S. A. can only be obtained in a Federal Court: *Store Service Co.* v. *Store Service Co.*, 31 O. G., 1561.

State Courts in U. S. A. may foreclose a mortgage of a patent: *Iron Works* v. *Montague*, 108 Mass., 248, or a suit relating to licenses: *Merserole* v. *Collar Co.*, 6 Blatch., 356; or to enforce a contract to assign a patent: *Binney* v. *Annam*, 107 Mass., 94; although Federal Courts only have jurisdiction in infringement suits.

In U. S. A. all suits for infringement or to annul a patent, must be brought in a United States Circuit Court, of which the Supreme Court of the District of Columbia is one, and in the district in which the defendant is an inhabitant: See U. S. Stats. at large, c. 866, p. 433.

Circuit Courts of Appeal (U. S.).

An Act to establish Circuit Courts of Appeal, approved March 3rd, 1891, provides that all appeals and writs of error from a United States Circuit Court must be taken to a Circuit Court of Appeals, but cannot be taken to the Supreme Court, U. S.; though any such Circuit Court of Appeals "may certify to the Supreme Court, U. S., any questions or problems of law concerning which it desires the instructions of that Court for its proper decision," and "it shall be competent for the Supreme Court to require by *certiorari* or otherwise any such case to be certified to the Supreme Court for its review and determination."

Now, practically, the U. S. Supreme Court takes no cognizance of patent suits, except those relating to inventions of *national importance*, and then only by *certiorari*. The press of business was such that the U. S. Supreme Court was at one time about

five years in arrears with its judgments, and Circuit Courts of Appeal were instituted ts relieve the pressure.

There are some eight Circuit Courts of Appeal for the whole of the States, each Court having jurisdiction within specified districts.

Design Patent (U. S.)—Damages.

For infringement of a design patent in the States by Act approved February 24th, 1887, $250 is recoverable, and in case defendant's profit exceed this amount he shall be liable for the surplus.

N. B.—In Canada designs are registered in the office of the Minister of Agriculture, Trade Mark and Design Branch, and are not put through the Patent Office as patents.

Interim Injunction.

This section 31 follows somewhat the wording of section 30 of the English Patent Act of 1883, as to injunction, inspection and account; it also specifically refers to a Court motion or trial as well as to a motion in Chambers. The Court deals with the question of a final order for injunction, whereas an interlocutory judgment may be obtained from a Judge on motion before trial.

The way this section is framed it would appear that the defendant, as well as the plaintiff, was entitled to an injunction, inspection or account. The defendant might possibly get an order for "inspection," but it is not clear what he would have to do with an injunction or account.

On a motion for interlocutory judgment, instead of granting an injunction, an account is sometimes ordered. In some recent unreported cases, among them *Carter* v. *Oldfield* (1st June, 1892, Toronto, Ont.), an order was made for account instead of injunction, requiring the defendant to give security for a stated amount until trial.

An interlocutory judgment will only be granted when there is a fair *primâ facie* case of validity made, this may be by (1) long undisturbed enjoyment: *Penn* v. *Bibby*, 3 L. J., Eq., p. 308; *Muntz* v. *Foster*, 2 Web. P. C., 95; *Betts* v. *Menzies*, 3 Jur., N. S. 358; or (2) by the validity of the patent having previously been

determined in a Court of law: *Vide Dudgeon* v. *Thompson*, 22 W. R., 464; Terrell, 1st ed., p. 191; or (3) by the admission of the defendant as to the validity of the patent; or (4) by being so placed in relationship to the patentee as to be estopped from denying validity: See cases collected in Higgins, p. 97.

As to *primâ facie* evidence of validity: *Vide Gardner* v. *Broadhurst*, 2 Jur., N. S., 1041; *Renard* v. *Levinstein*, 10 L. T., N. S., 177.

Material to be Used on Motion for Interlocutory Injunction.

In applying for an interlocutory injunction, the affidavit should clearly point out in what the alleged infringement consists: *Hall* v. *Thompson*, 3 Mer., 624; *Betts* v. *Wilmot*, L. R., 6 Ch., 239.

If the plaintiff is the first inventor, he must distinctly swear to that fact, as also to the sufficiency of the specification: *Vide Hall* v. *Thompson* (*supra*).

If the plaintiff is an assignee, he must swear to the best of his belief: See *Gardner* v. *Broadbent* (*supra*).

The affidavits must state the facts at the time of swearing, to show the invention is new and useful *now*: See *Hall* v. *Thompson* (*supra*); *Swartz* v. *De la Rue*, 5 Russ., 322; *vide* Daniels, p. 1492; pp. 203, 204, Hindmarch.

The same requirements as to the affidavit also prevail in the States: *Vide Rogers* v. *Abbott*, 4 Wash., 574; Bump., 2nd ed., p. 393; Walker, sec. 662.

The affidavit should also show that the invention had been in active use. Where the plaintiff failed to prove active use, even when the patent had been in force eight years, interlocutory injunction was refused: *Plimpton* v. *Malcolmson*, 44 L. J., Ch., 257; also *Heugh* v. *Magill*, W. N. (1877), p. 62.

The plaintiff must make out his title clearly to the patent, and there must be also a presumption of validity as well as of infringement in order to obtain interlocutory infringement: *Vide* Walker, sec. 665.

Presumption of Validity.

The presumption of validity does not arise on the bare production of Letters Patent, but will always arise if the patent has been previously adjudicated on: *Vide Atlantic Giant Powder Co.* v. *Goodyear*, 3 Ban. & Ard., 167; *Kerby Bung Manufacturing Co.* v. *White*, 5 Ban. & Ard., 263 (1880); *Goodyear* v. *Rush*, 3 Fish., 456 (1868), or by public acquiescence in the patentee's rights in the following case, it was for two years: *Vide Sargent* v. *Seagrave*, 2 Curt., 557 (1855); if the acquiescence stops the presumption also ceases: *Vide Wollenseck* v. *Sargent*, 33 Fed. Rep., 843 (1888).

When the defendant admits or does not deny in his pleadings the validity of the patent, a sufficient presumption arises: *Vide New York Grape Sugar Co.* v. *American Grape Sugar Co.*, 10 Fed. Rep., 835 (1882).

A decree *pro confesso* in one case does not raise a sufficient presumption in another case to grant an interlocutory injunction: *Everett* v. *Thatcher*, 3 Ban. & Ard., 437 (1878).

No acquiescence in an original patent gives rise to presumption of validity in case of a reissue, unless the claim infringed in the reissue be also in the original: *Vide Grover Sewing Co.* v. *Williams*, 2 Fish., 144 (1860); *Poppenhusen* v. *Falke*, 2 Fish., 181 (1861).

Infringement or danger of infringement must be clearly shown in order to entitle to a preliminary injunction; a moderate probability that defendant intends to do something in infringement would suffice: *Vide* Walker, sec. 676.

Suits "quia timet" are rare, and Courts do not generally interfere unless rights have been violated, yet where defendant evinces an intention and claims a right to interfere, the Court may grant an injunction, although no actual infringement may be shown: *Frearson* v. *Lee*, L. R., 9 Ch. D., 48; *Crossley* v. *Beverley*, 1 Web. P. C., 119.

Bonds Taken in U. S. to Secure Damages.

In the United States bonds may be taken instead of the interlocutory injunction if the plaintiff has been in the habit of

receiving royalties for licenses instead of making and selling or using himself, while permitting no one else: *McMillan* v. *Conrad*, 16 Fed. Rep., 128 (1883); *New York Grape Sugar Co.* v. *American Grape Sugar Co.*, 10 Fed. Rep., 837 (1882); but in Canada after two years, under section 37, there is no such thing as an exclusive use of a patented article, as is the case in the States, so the cases are not directly applicable.

Where an infringing machine contains costly parts not covered by plaintiff's patent, bonds may be given: *Baldwin* v. *Bernard*, 4 Fish., 447 (1872); or where an action is pending against a manufacturer from whom defendant received the articles: *Irwin* v. *McRoberts*, 4 Ban. & Ard., 414 (1879); or where the prior judgment on which the right to a preliminary injunction has been appealed to the Supreme Court, which appeal is still pending: *Wells* v. *Gill*, 6 Fish., 93 (1872); or where an injunction would be very damaging to defendant and of no great benefit to plaintiffs: *Hoe* v. *Boston Daily Advertiser*, 14 Fed. Rep., 914 (1883); *Dorsey Harvester Rake Co.* v. *Marsh*, 6 Fish., 387 (1873); or where a discontinuance would be against public policy: *Gaudet* v. *Palmer*, 10 Blatch., 220 (1872).

But a bond can be required from defendant, only where an interim injunction would go if the bond be not given: *American Milling Co.* v. *Atlantic Milling Co.*, 3 Ban & Ard., 173 (1877).

In *Edison Electric Light Co.* v. *Columbia Incandescent Lamp Co.* (decided April 21st, 1893), U. S. Cir. Ct., E. Dist., Missouri, 65 O. G., p. 133, an interim injunction was refused and a bond was required from defendants in $20,000.

In the States if defendant submits to an injunction, whereby serious injury may be caused him, the complainant may be called on to give bonds: *Consolidated Fruit Jar Co.* v. *Whitney*, 1 Ban. & Ard., 361 (1874); *Shetley* v. *Brennan*, 4 Fish., 198 (1870); *Brummer* v. *Jones*, 3 Fish., 340; *Allis* v. *Stowell*, 15 Fed. Rep., 242.

On application for preliminary injunction, where infringement was plain, the patent was presumed valid and injunction granted, unless defendant gave sufficient bond to secure damages which might be decreed: See *Palmer* v. *Mills*, June 29th, 1893; 65 O. G., p. 1069.

In patent cases, the infringement, upon which a preliminary injunction will be granted, must be without reasonable doubt and the rights of the patentee clear, and failing in prior adjudication in favour of the validity of a patent, there must be shown such continued public acquiescence in the exclusive right asserted as raises a presumption of validity of the patent.

Dissolving Interim Injunction.

An "interim injunction" may be dissolved at any time by proving facts which would have been fatal at the hearing of the motion, if good excuse is shown for the delay in adducing these facts: *Young* v. *Lippman*, 5 Fish., 230 (1872); *Hussey* v. *Whitley*, 2 Fish., 125 (1860); or if the granting of the preliminary injunction was erroneous in point of law: *Steam Gauge Co.* v. *Miller*, 11 Fed. Rep., 719 (1882); or if plaintiff, during suit, assigns all his interest in the patent to another: *Kinsman* v. *Parkhurst*, 18 How., 289.

Laches.

No interlocutory injunction will be granted if the patentee has not proceeded with reasonable speed to prosecute infringers: *Losh* v. *Hague*, 1 Web. P. C., 201; *Bacon* v. *Jones*, 4 My. & Cr., 438; *Bridson* v. *Benecke*, 12 Beav.

Where plaintiff knew of infringement in August, wrote letters of complaint in November, and commenced suit following July, an interlocutory judgment was refused: *Bovill* v. *Conte*, L. R., 1 Eq., 388.

Knowledge of infringement in August, 1835, existed, and an application for interlocutory injunction in 1839 was refused: *Bacon* v. *Jones*, 4 My. & Cr., 433 (*supra*).

Vide also Walker, sec. 684, where eighteen months' delay in one case, and two years' delay in another was held to constitute *laches*, but where three months' delay did not.

Where there was a delay of two months after filing bill, during which time defendant had filled up his stock of infringing articles with plaintiffs' knowledge, interim injunction was refused: *Ney Manufacturing Co.* v. *Superior Drill Co.*, U. S., 64 O. G., p. 1133 (May 27th, 1893).

Undertaking as to Damages.

And in Ontario, where an interlocutory injunction is granted, the plaintiff, in the order, is required to give an undertaking to abide any order the Court may make as to the payment of damages by him to the defendant in respect of injury sustained by the reason of the injunction, following the English practice: *Wakefield* v. *Duke of Buccleugh*, 11 Jur., N. S., 523; *Plimpton* v. *Spiller*, 4 Ch. D., 286.

The form of undertaking in the order is as follows, viz.: "The plaintiff by his said counsel hereby undertaking to abide by any order the Court may make as to damages, in case it should hereafter be of opinion that the defendant has sustained any, by reason of this injunction, which the plaintiff ought to pay."

In cases of emergency, the order may be made *ex parte* in Ontario by Rule 1134, when to proceed on notice, might entail serious or irreparable mischief.

Age of Patent Material to Right.

Where the patent in England was ten years old, and its novelty had not previously been challenged, it must, for the purpose of an interlocutory motion, be treated as a good patent, and infringement having *primâ facie* been established, plaintiffs were entitled to an interlocutory injunction: *Shillito* v. *Larmouth*, R. P. C., vol. 2 (1885), p. 1.

Undisturbed enjoyment of a patent for six years entitles to an interlocutory injunction: *Rothwell* v. *King*, R. P. C., vol. 3 (1886), pp. 379, 380.

Interlocutory injunction applied for on a patent three years old, injunction refused: *Lister* v. *Norton*, 1 R. P. C., p. 114 (1884).

Must be Free from Doubt.

The Court is not bound to decide doubtful and difficult questions of law on a motion for a preliminary injunction, and where there is doubt as to complainant's title or defendant's infringement: *Vide Zinseer* v. *Coolidge*, 17 Fed. Rep., 538 and Bump., 2nd ed., p. 408.

To warrant the exercise of the extraordinary power of the Court in granting a preliminary injunction, the case presented

should be *free from ambiguity or confusion*: See *Poppenhusen* v. *Folke*, 2 Fish., 181; *S. C.*, 4 Blatch., 493.

Balance of Convenience.

Interlocutory injunctions may be granted, or an account may be ordered to be kept, and in adopting either course, the Court will be influenced by the balance of convenience, and the probability of injury to either side: *Neilson* v. *Thompson*, 1 Web. P. C. 278; *Bredson* v. *McAlpine*, L. R., Ch. D., 289.

In *Plimpton* v. *Spiller*, L. R., 6 Ch. D., 412, the difficulty to be determined is keeping things in *statu quo* till trial, and the principle recognized in this case is, that if the defendants be an old and established trade an interlocutory injunction would not be granted, the Court will not stop a going trade; but if defendant's business were new and large sales were made of the infringing article, to stop irreparable damage an interlocutory infringement may be granted.

Balance of convenience where more harm would be done to defendant by granting it than to plaintiff by refusing it, the balance of convenience was in favour of refusing it: *Walker* v. *Clark*, R. P. C., vol. 4, p. 111.

Interlocutory injunction in balance of convenience: *Kensington, etc., Electric Lighting Co.* v. *Lane Fox Electrical Co.*, R. P. C., vol. 8 (1891), p. 277; see also *Plimpton* v. *Spiller*, 4 Ch. D., 286.

Injunction granted on the balance of convenience, the defendants being a new company with a very small capital and the patent being 12 years old: *Bracher* v. *Bracher, Dean & Co.*, R. P. C., vol. 7, p. 420 (1890).

Owing to the balance of convenience an injunction was not granted, though infringement was made out contrary to an undertaking given by the defendant: *Thompson* v. *Hughes*, R. P. C., vol. 7, p. 71 (1890).

In *Carter* v. *Oldfield* (an unreported case, Ont.), an application was made before Robertson, J., for an Interim Injunction to restrain the alleged infringement of Letters Patent for a black leaf check book, which patent had been sustained in *Grip* v. *Butterfield*, 11 Sup. Ct. R. (Can.), 291, previously referred to.

In the judgment delivered June 1st, 1892, Robertson, J., states "I do not think I could grant the 'interim injunction' asked for here, on the ground that I am not satisfied that the defendant has not met the plaintiff's case sufficiently to create a grave doubt, not only to the validity of the plaintiff's patent, but whether she has infringed upon it," and he ordered the defendant merely to keep an account until the matter was disposed of at the trial, and give security in a bond with two sureties, in a penal sum not exceeding $200.

In the reasons for judgment he refers to the rule laid down in *Plimpton* v. *Spiller*, 4 Ch. D., 286. James, L. J., states: "There will always be, no doubt, the greatest possible difficulty in determining what is the best mode of keeping things in *statu quo*, for that is really what the Court has to do—to keep things in *statu quo* until the final decision of the question;" and then the Court says: "We will not stop a growing trade; we will not adopt a course which will result in any great difficulty in giving compensation on one side or the other." And Brett, J. A.: "There will be a hardship on the one side or on the other, and the question is on which side does the balance appear to lie? Now, if the trade of the defendant be an old and established trade, I should say the hardship upon him would be too great if an injunction were granted. But where as here the trade of the defendant is a new trade, and he is the seller of goods to a vast number of people; it seems to me to be less inconvenient and less likely to produce irreparable damage to stop him from selling than it would be to allow him to sell and merely keep an account, etc. Therefore, as a rule of conduct, I think that in such a case as this, it is better where a trade of the defendant is a new one, and not an old established trade, and where there are likely to be many customers in the new trade, to say that you will act against the new trader by injunction, whereas, if he were carrying on an old trade you would act the other way."

Besides having grave doubts as to the validity of the patent, notwithstanding the decision in *Grip* v. *Butterfield*, and as to infringement; as an additional reason for merely ordering an account, Robertson, J., states: "And besides (as suggested by Baggally, J. A., in his dissenting judgment in the Plimpton case), it may be that some new combination or invention may be discovered which will make the defendant's book if it should be found to be no infringement on the plaintiff's patent useless in the course of some months. If, therefore, the defendant has not infringed the plaintiff's patent how will it be possible to ascertain the measure of damage which she will have sustained by reason of the injunction—but if the injunction is not granted and the defendant is required to keep an account of all the books she may sell and the profits she has made by them in the meantime, the means will be afforded for ascertaining the loss which the plaintiffs will have sustained by the continuance by the defendant of that which may have been an improper business."

After considering a number of American cases, as well as English authorities, he states, "the fact being in my judgment that the practice in England in motions of this kind is the more logical and correct, and consequently the more equitable."

Final Injunction.

By Con. Stat. Up. Can., c. 23, sec. 12 (1859), the Court or a Judge was empowered to grant writs of Mandamus or Injunction after action brought, and they might be applied for "*ex parte*," and as to keeping account, giving security or otherwise.

In *Huntington* v. *Lutz*, 13 U. C. C. P. R., 168, it was held that this Act did not give the Court power to order an account of profits or to order the defendant to pay.

By sub-sec. 8, sec. 53 of the Ontario Judicature Act, the Court may grant *interlocutory*, as well as *final* injunctions, and by sub-section 9, where the Court may grant an injunction, it may also award damages.

By this section 31, the Court or a Judge may grant an order for inspection or an account, both of which are generally preliminary to the trial, although a final account is taken before a referee, usually after the plaintiff has established his right.

In the event of an injunction being disobeyed, proceedings for contempt of Court may be instituted in Ontario.

Suspension of Injunction.

Where an injunction is ordered in Ontario and the parties enjoined give the security required, pending an appeal to the Court of Appeal (Ont.), all proceedings on the injunction are stayed and a writ of sequestration cannot be obtained pending the appeal: *McGarvey* v. *Town of Strathroy*, 6 Ont. R., 138; *City of Toronto* v. *Street Railway Co.*, 12 Prac. R., 361, Court of Appeal.

But query? In the case of the infringement of a patent, where a reference for an account or damages has been granted but not yet ascertained, would the defendant be allowed to go on with his infringement by barely giving security for $400, the costs of appeal, and security for the taxed costs of the Court below; the damages might far exceed in amount the costs, and

the defendant might be worthless, so as to render it impossible to recover damages when ascertained, and thus for two or three years defendant might be enabled to profit by his own wrong-doing without redress to the plaintiff.

In England an injunction will not be suspended pending an appeal: *Flower* v. *Lloyd*, 36 L. T. R., N. S., 444.

In a suit for injunction the plaintiff must not only prove that the alleged infringing article was not made at his own factory, but also that it was not made at any of his factories abroad: *Betts* v. *Wilmot*, L. R., 6 Ch., 239.

If at the trial the plaintiff succeeds, he will not only be entitled to an injunction restraining the defendant from infringing, but also to recover damages, or to have an account of the profits made by defendants from the infringement.

In England the Court may order the destruction of the infringing article, as indeed the Court also may in Canada: *Betts* v. *de Vitre*, 34 L. J., Ch., 289, 291; *Needham* v. *Oxley*, 8 L. T., N. S., 604; *Plimpton* v. *Malcolmson* (Seton on Decrees, 4th ed., p. 354).

An injunction granted to restrain the sale of a complete machine will be violated by the sale of the component parts of the machine in such a way that they can easily be put together by anyone: *United Telephone Co.* v. *Dale*, 25 Ch. D., 778.

A plaintiff may be enjoined from selling or using, after the expiration of the patent those specimens of the patented thing which he unlawfully made before that expiration: *Root* v. *Railway Co.*, 105 U. S., 210 (1881); *American Diamond Rock Boring Co.* v. *Marble Co.*, 2 Fed. Rep., 353 (1880); *Crossley* v. *Beverley* 1 Web. P. C., 119.

Where Injunction is Refused.

An injunction in the States will be refused if the infringing defendant should die before decree, even though the suit be revived against the legal representative, who does not continue the infringement: *Draper* v. *Hudson*, 1 Holmes, 208 (1873). But damages may be recoverable in Canada if property or the proceeds or value of property belonging to plaintiff has been

appropriated by the deceased and added to his estate: *Leslie* v. *Calvin*, 9 Ont. Rep., 207.

A preliminary injunction will not go to enforce a forfeiture of a license for non-payment of royalty if the royalty be paid within a time fixed by the Court: *Goodyear* v. *Rubber Co.*, 3 Blatch., 455 (1856).

An injunction will not be granted when the only infringement has been long discontinued, and no probability is shown of its being continued; on appeal reversing the trial Judge. The Court having no jurisdiction in a Palatine Court under Lord Cairns' Act to grant damages, unless an injunction may also be granted, the action was dismissed, without costs, defendants getting costs of appeal: *Proctor* v. *Bayley* (C. A. Aug., 1889), 6 R. P. C. (1889), p. 538; 59 L. T., Ch. 12.

Where a threat to trespass had been abandoned no injunction was granted: *Stannard* v. *Vestry of St. Giles*, L. R., 20 Ch. Div., 190.

An action lies for an injunction to restrain threats against an alleged infringer, and for damages, which we have treated on under the head of damages.

In Canada actions for *damages* for infringement may be brought under secs. 29 and 30, and under sec. 31 for *injunction*, etc., the remedies are distinct or joint, as may be desired; in the Judicature Act, sec. 53, sub-sec. 8 and 9, an award for damages seems incident only to the right to an injunction.

Estoppel.

When a defendant has once submitted to an injunction, it is improper for him on being attacked for a second infringement, either directly or indirectly, to raise arguments against the validity of the patent: *Moore* v. *Thompson*, R. P. C., vol. 7, p. 325 (1890); but he may show that he has not infringed: *Canadian Mineral Wool Co.* v. *Montgomery* (unreported), tried before Ferguson, J., Toronto, Ont., Nov., 1893.

If once the thing complained of has been done the Court may interfere, notwithstanding any promise not to do the same thing again, while the defendant may revoke a threat: *Losh* v. *Hague*, 1 Web. P. C., 200.

Where a defendant had consented to an injunction in a previous suit, on a subsequent action for a new infringement, he was estopped by the consent injunction previously obtained from setting up the invalidity of plaintiff's patent: *Thomson* v. *Moore*, 23 L. R., Ir., 599 (C. A.).

Intent to Infringe.

Where there was intention to infringe, the Court held that although there was no actionable infringement and no damages could be awarded, there was evidence of intention to infringe, and following *Frearson* v. *Lee*, L. R., 9 Ch. D., 48, granted an injunction: *Dowling* v. *Billington*, R. P. C., vol. 7, p. 191 (1890).

Writ of Injunction.

In the writ of injunction a concise description of the particular thing which the Court forbade the defendant to make, use or sell should be inserted, so that if defendant continues to make, use or sell that thing after being served with the writ, a motion may be made to commit.

Inspection.

The inspection referred to is an inspection of the instrument manufactured, or machinery, or process with a view to evidence of infringement, and does not refer to an inspection of books: *Vidi* v. *Smith*, 23 L. J., Q. B., 342. The Canadian section refers also to the three classes of the English section, viz.: Injunction, inspection and account and the meaning is the same.

It must be shown, however, that the inspection is material for the purpose of proving the plaintiff's case: *Batley* v. *Kynock*, L. R., 19 Eq., 90; *Amies* v. *Kelsey*, 22 L. J., Q. B., 84. An application may be made as soon as the action is commenced and before statement of claim: *S. C.*

As to the form of affidavit necessary in England to support an application for inspection: See *Shaw* v. *The Bank of England*, 22 L. J., Exch. 26; *Meadows* v. *Kirkman*, 26 L. J., Exch. 9, 205.

Where the plaintiff and defendant are competitors in trade an order to inspect the defendant's works should be confined to scien-

tific men and not include the plaintiff himself: *Flower* v. *Lloyd*, W. N. (1876), p. 169, 230.

The order may direct that machinery inspected be put to work during inspection, and that a sample of goods may be taken: *Davenport* v. *Jepson*, 1 N. R. 307: as also samples for the purpose of chemical analysis: *Patent Type Founding Co.* v. *Walter*, John., 727: but a similar order was refused by the Court of Exchequer in *Patent Type Foundry Co.* v. *Lloyd*, 5 H. & N., 192.

Secret Process.

Where a process is a secret one, the publication of which might do irreparable damage, if it proved eventually to be no infringement: the Court probably would not order a disclosure of the process.

In *Badische Anilin und Soda Fabric* v. *Levinstein* (1883), L. R., 24 Ch. Div., 156.

The Judge, at the trial, called upon the defendant, after several days trial, to disclose the secret process or submit to an adverse judgment. Whereupon the trial was continued with closed doors, no one being present except the professional advisers but *vide contra*: *Piggott* v. *Anglo-American Telegraph Co.*, 19 L. T. R., N. S., 46.

In an action for an account against a licensee, on a plea of denial of user and of "secret process," the question of user being material to the issue. The patentee is entitled to ask to what extent defendant had used this or that particular process claimed and also to obtain the names of some of his customers; but he cannot compel disclosure of the secret process: *Ashworth* v. *Roberts*, 45 Ch. D., 623, 60 L. J., Ch. 27.

In an action of infringement defendants refused to answer as to the composition of an alleged infringing article, on the ground that the right to discovery depended on the validity of the patent, and that it was a trade secret: *Held*, that the question must be answered: See *Benno Jaffe, Etc., Fabric* v. *Richardson & Co.*, 62 L. J., Ch., 710, 10 R. P. C., 136.

No order for discovery may be made with respect to articles not in the possession of the defendants: *Garrard* v. *Edge*, 58 L. J., Ch. 397.

Where plaintiffs have obtained an order for inspection of process used by defendants. The defendants obtained a similar order, as the latter should be able to describe to the Court the actual process carried on by the plaintiffs under their patent: *Germ Milling Co.* v. *Robinson*, 55 L. J., Ch. 287, 34 W. R. 194.

Inspection of defendant's works refused on the ground that the validity of a contract was disputed and there was strong evidence by the defendant that he was not infringing: *McDougall* v. *Partington*, R. P. C., vol. 7, pp. 351, 472 (1890).

The right to inspection is not an absolute right but a right to be given at the discretion of the Court, to be exercised with judicial discretion: *S. C.*

Laches sufficient to defeat a right to an interlocutory judgment is no ground for refusing an order for inspection: *Patent Type Founding Co.* v. *Walter*, John., 727.

Inspection by plaintiff limited to processes as to which a *primâ facie* case of infringement is made out: *Cheetham* v. *Oldham*, R. P. C., vol. 5 (1888), p. 617; following *Germ Milling* v. *Robinson*, 1 R. P. C., p. 217.

Defendants may be allowed to inspect plaintiffs' processes: *Cheetham* v. *Oldham* (No. 2), p. 622.

The plaintiff allowed to inspect with his solicitor and two experts: *Cheetham* v. *Oldham*, p. 621, and to make experiments.

Account (Interlocutory).

We have already noticed under Injunction the alternative to an injunction, viz.: the keeping an account of the articles made or sold, and also an account of the profits arising therefrom, with or without giving bonds. If the action be found in favour of the defendant, the plaintiff will have to pay the expense of keeping such account: See *Vidi* v. *Smith*, 3 El. & Bl., 969.

The question of final account has already been fully dealt with under the head of *Profits* in this section.

The account may be taken, notwithstanding the pending of an appeal: See *Saxby* v. *Easterbrook*, L. R., 9 Exch., 207.

Discovery of names of customers ordered to be given in an action for an account against a licensee, though defendant denied

user, as the question of user was material to the question to be decided: *Ashworth* v. *Roberts*, R. P. C., vol. 7, p. 451 (1890).

Particulars of Breaches, Etc. (Can.)

In *Smith* v. *Greey*, 11 Prac. Rep., Ont., p. 174, on an appeal from a judgment of Proudfoot, J., to the Divisional Court Chancery Division, Ferguson, J., quoting the above section, held that the Court or a Judge has general power to make such order as may seem fit respecting *the proceedings in the action*, and had no doubt that the delivery of particulars is a *proceeding*; in *The London, Brighton, etc., R. W. Co.* v. *The London, Chatham, etc., R. W. Co.*, L. R. 3 Q. B., 170, the taxation of costs was held to be a *proceeding* within the meaning of the word as used in the section of the Act there in question.

No Specific Enactment as to Particulars in Canada.

We have no legislation bearing directly on the question of particulars in Canada, except as bearing on "*sci. fa.*" proceedings, which latter are regulated by the English practice under the Patent Act, 15, 16 Vic. (1852), c. 83.

By section 41 of that English Act "the place or places at or in which and in what manner the invention is alleged to have been used or published prior to the date of the Letters Patent shall be stated in such particulars."

By section 29 of the English Patent Act of 1883 the omission as to "*time*" is now corrected, and the defendant must state in his particulars on what grounds he disputes the validity of the patent, and if one of those grounds is want of novelty, must state *the time and place* of the previous publication or user.

In *Crossley* v. *Tomey*, L. R., 2 Ch. D., 533, and *Flower* v. *Lloyd*, 20 Solicitors' Journal, 860, under the Act of 1852, giving the places of *the user* merely did not suffice, without giving also *the names and addresses* of the persons alleged to have used the invention.

By the Act of 1883 (Eng.) the plaintiff must deliver with his statement of claim, or by order of the Court or the Judge at any subsequent time, particulars of the breaches complained of.

The particulars of breaches should give the defendant full notice of the matter complained of, so that the defendants shall

not be taken by surprise: See *Needham* v. *Oxley*, 1 Hem. & M., 248; *Curtis* v. *Platt*, 8 L. T., N. S., 657; *Batley* v. *Kynock*, L. R., 19 Eq., 231.

Particulars of Breaches and of Objections.

Where the patent consists of two or more processes, or distinct and severable inventions as indicated by the claims, the particulars of breaches should distinguish which of the processes or claims has been infringed, if these processes or claims are wholly distinct from each other: See *Talbot* v. *de la Roche*, 15 C. B. 310; *Electric Tel. Co.* v. *Nott*, 4 C. B., 462. See also *Perry* v. *Mitchell*, 1 Web. P. C., 269.

Particulars of breaches where the plaintiff had complained specifically with respect to three out of four claims: *Held*, that the particulars informed the defendant of what the plaintiff says he has done in infringement, and that it was not the office of particulars to answer an interrogatory as to the construction of the patent: *Wenham Co.* v. *Champion Gas Lamp Co.*, p. 22, R. P. C. 5, 63 L. T., 827.

Where a whole specification is relied on particulars are not to be given: *Nettlefolds* v. *Reynolds*, R. P. C., vol. 8 (1891), p. 410.

In Ontario the practice usually followed is that of the more general form of statement as to breaches in the United States; but on application the defendants may obtain particulars as to time and place of the matters complained of; the reference to the pages and lines, as well as the claims which are alleged to have been infringed.

In *Prouse* v. *Pagnuelo*, 2 S. C. R., p. 311 (1852). In an action for infringement of a Lower Canada patent the allegation of infringement "*in the County of Montreal*" was held sufficient indication of place. According to the present practice in Ontario further and better particulars would be ordered.

In defendants' particulars of objections a greater degree of particularity is required than in plaintiffs' particulars of breaches. The object is to limit expense to parties and to prevent patents being upset by some unexpected turn of the evidence: *Fisher* v. *Dewick*, 4 Bing., N. C., 706; 1 Web. P. C., 264.

"*Particulars of breaches*," must be distinguished from "*particulars of objection for want of novelty*." In the latter cases the particular instances may not be within the knowledge of the patentee, and must be specified. In the former the defendant must know whether and in what respect he has been guilty of infringement. Where the plaintiff was the owner of three patents relating to a kiln, the second and third being for improvements on the first, and his plaint indicated in the case of each patent the infringement of which he complained: *Held*, overruling the High Court, that this was a sufficient compliance with the Act. The whole object is to give the defendant fair notice of the case he has to meet, and it is immaterial whether it be on the plaint itself or a separate paper: *Ledgard* v. *Bull*, 11 App. Cas., 648 (P. C.).

As objections to the validity of the patent had not been delivered, evidence to show that it was invalid for want of novelty could not be read by defendant, and as leave to amend the particulars had never been made, leave ought not now to be given, and the appeal should be dismissed: *Cropper* v. *Smith* (No. 2), 26 Ch. D., 700.

It had previously been held in *Cropper* v. *Smith*, that the patent was invalid because the patentee had claimed a subsidiary combination as his invention, but particulars had not been rendered as required.

Particulars as to Publications.

In *Curtis* v. *Platt*, 8 L. T., N. S., 657, the names and places of residence of the prior users, as well as special reference to parts of books where prior publication was alleged, were ordered.

If prior publication is in books and newspapers, the plaintiff is entitled to know the name of the book or newspaper, and to get such details as will enable them to be found: *Jones* v. *Berger*, 5 Man. & G., 208; *Palmer* v. *Cooper*, 9 Exch., 231; see *London and Leicester Hosiery Co.* v. *Higham*, p. 91, Higgins on Patents.

In *Plimpton* v. *Spiller*, 20 Solicitors' Journal, 859, the defendant was required to set out the date of the United States patent, the name of the patentee, the page of publication and to identify

the drawings, and to state whether they were contained in books, and what books.

Defendants must point out distinctly, though not necessarily by page and line, where such anticipations were to be found, the object being to prevent surprise: *Holliday* v. *Heppenstall Bros.*, C. A., 41 Ch. D., 109.

In the United States the same rule prevails. The Supreme Court, in *Silsby* v. *Foote*, 14 How., 218, held that mere reference to the book, without defining the page where publication occurred, was insufficient.

In *Nettlefolds* v. *Reynolds*, 65 L. T., 699 (1891), on application for further particulars: *Held*, on appeal, that it was not necessary to give pages and lines of each alleged anticipating patent, or what use defendant meant to make of all the citations.

The plaintiff may be ordered to point out by reference to the pages and lines, the parts of the specification he alleges to be infringed: *Lamb* v. *Nottingham Manufacturing Co.*, Seton on Decrees, 4th ed., vol. 1, 349; *Wren* v. *Weild*, L. R., 4 Q. B., 213.

In the United States, infringement is stated in the declaration in general terms, and it is sufficiently specific if it plainly alleges that the defendant without the leave or license of the patentee did make or sell the patented article within the territory, and during the time covered by the plaintiff's patent; the time of the infringement is properly specified if stated to be on a certain day, or between specified dates. Walker, sec. 434.

In an unreported case, *The London and Lancashire Hosiery Co.* v. *Higham*, referred to on page 91, Higgins on Patents, Eng. The defendant had to give particulars, with reference to pages and lines, of alleged anticipating specifications, and also what portions of the plaintiff's inventions are alleged to have been published or used prior to the dates of plaintiff's Letters Patents, with reference to the claims.

As to particulars of objections, where reference to page and line of specification need not be given, because the claims alleged to be infringed had been pointed out: *Cheetham* v. *Oldham* (No. 3), R. P. C., vol. 5, p. 624.

For application for further particulars, see *Casella* v. *Levinstein*, 8 R. P. C., 473 (C. A.); *Boyd* v. *Farrer*, 57 L. T. R., N. S., 866; *Fowler* v. *Gaul*, 3 R. P. C.

Further Particulars.

If the particulars are not sufficiently full, the plaintiff should apply at Chambers for an order for fuller and better particulars, otherwise he cannot object to their generality at the trial, and the only thing will be to see whether the particulars delivered include the evidence tendered by defendant: *Neilson* v. *Harford*, 1 Web. P. C., 331; if the plaintiff has allowed such words as "*and elsewhere*" to stand until the trial, the defendant will be allowed to give evidence of prior user anywhere: *Hall* v. *Bolland*, 25 L. J., Exch.; *Sykes* v. *Howarth*, L. R., 12 Eq., 826.

Further and better particulars were ordered of an objection that an invention was published from 1832 to 1862: *Smith* v. *Lang*, R. P. C., vol. 7, p. 148 (1890).

As to Costs of Particulars in England and Canada.

In England the defendant will not, under section 29, Act 83, be entitled to the costs of his particulars of objections, even in case of a non-suit if the Judge has not certified to them as reasonable and proper: *Honiball* v. *Bloomer*, 10 Exch., 538; nor will the plaintiff be so entitled without a similar certificate. The certificate should be as to the determination of each objection.

It would be well in Canada if there were some similar provision as to particulars; as matters are now in Ontario, particulars are put in with reckless profusion, with little or no regard as to their bearing on the points at issue, thus adding to the expense and delay in the determining of the matter; a long period of the time of trial being occupied in showing that the citations have no bearing whatever on the subject matter of the suit.

In England by 5 and 6 Wm. IV., c. 83, sec. 41, the defendant, on pleading to an action for infringement, shall give the plaintiff notice of any objections on which he means to rely; this was supplemented by 15 and 16 Vic., c. 83, before referred to. The two provisions were very similar, and the same cases apply to both. These Acts dealt merely with the *validity* of the patent, and an objection to the want of registration of an assignment of the patent to the plaintiff might be taken, although not in the notice

of objections: *Chollet* v. *Hoffman*, 26 L. J., Q. B., 449. Under the Act of 1893 (Eng.), all objections must be stated.

It was not sufficient notice of an objection to say that the invention had wholly or in part been used before, but it ought to point out what parts were previously in use: *Heath* v. *Unwin*, 1 Web. P. C., 551; *Russell* v. *Ledsam*, 12 L. J., Exch., 439.

The Names of Prior Users and their Present Addresses to be Given.

The plaintiff ought to be put in possession of all the defendant knows himself, and to have such information as would enable him to make the necessary enquiries at the places named, and identify the instances alleged; the names of prior users and their present addresses should be given also: *Palmer* v. *Cooper*, per Parke B., 9 Exch., 236, this decision was under the English Act of 1852. See also: *Bulnois* v. *Mackenzie*, 4 Bing., N. C., 432; *Galloway* v. *Bleaden*, 1 Web. P. C., 268 (*n.*).

Names and addresses of prior users must be given: *Alliance Syndicate* v. *McIvor's Patents*, R. P. C., vol. 8 (1891), p. 321.

In *Carpenter* v. *Smith*, 1 Web. P. C., 268 (*n.*), the names and addresses of prior users was refused under the early practice.

Although it is a recognized principle that one litigant shall not be permitted to inquire as to what witnesses the other is going to call at the trial, still in a patent suit the more important principle is that neither party should be taken by surprise, and that the plaintiff should have the opportunity of examining critically each anticipation.

In foreign commissions, in ordinary suits in Ontario, it is not possible to conceal the names of witnesses before examination, although unnamed witnesses may be mentioned in the order for commission, still one named witness must be in the order, and some days' previous notice of the names of the other witnesses must be given to the opposite party: *Vide Nadin* v. *Basset*, 25 Ch. D., 21; *Armour* v. *Walker*, 32 W. R., 215, which cases are followed in this Province of Ontario.

Although it has become the practice in England to give the names and addresses of prior users, it is not required even now in the English Act of 1883.

As to Insufficiency and Sufficiency of Specification.

Where the notice of objection simply stated the specification to be insufficient, it was held that any objection to the sufficiency of the specification was admissible at the trial: *Neilson* v. *Harford*, 1 Web. P. C., 332.

If insufficiency of specification be pleaded, or given in particulars, the defendant may be called upon to state in what respect the specification is insufficient to direct a competent workman, so that the plaintiff may know the case he has to meet, if it be in the knowledge of the defendant. To set up at the trial insufficiency of the specification it should be specially pleaded. This is the practice in the States: See Walker, sec. 454; *Loom Co.* v. *Higgins*, 105 U. S., 580. In *Heath* v. *Unwin*, 10 M. & W., the objection that the specification was insufficient was enough without explaining why; the litigant not being expected to argue his case on paper before he went into Court, which seems reasonable ground, though not lately followed in Ontario.

If defendant knows of a particular defect in the specification as to the nature of the invention, and that it did not sufficiently describe how it was to be performed, he should point it out, that the plaintiff might not be taken by surprise: *Crompton* v. *Anglo American Brush Electric Light Corporation*, 35 Ch. D., 283.

In a patent action for infringement defendants denied the validity of plaintiffs' patent. In their particulars of objections, they said (*inter alia*) the plaintiffs' specification "does not sufficiently describe and ascertain the nature of the alleged invention, and the manner in which the same is to be performed, and does not sufficiently distinguish which of the matters and things therein described the plaintiff claims to have invented." *Held*, by North, J., that the particulars were *insufficient*, and that they ought to state the grounds on which the specification was alleged to be insufficient: *Heathfield* v. *Greenway* (1893), W. N., 170.

As to Amendments of Particulars.

Particulars are allowed to be amended in England on the terms that the plaintiff should be put into the same position as to costs as if the proposed amended particulars had been delivered

in the first instance: *Baird* v. *Maule's Patent Earth Closet Co.*, L. R., 17 Ch. D., 139 (*n.*); *Edison Telephone Co.* v. *India Rubber Co.*, L. R., 17 Ch. D., 137; or that the defendant be put on such terms as to costs as the Judge or Court seems just. The defendant should not be permitted to keep back his main objections, thus inducing the plaintiff to proceed, and then amend his particulars at the last moment. This method is aimed at in Ontario, and sometimes effected without any liability on the defendant as to costs or otherwise; but in one instance (unreported) where fresh objections were adduced on the day of trial, the trial was adjourned at defendant's expense, so as to give the plaintiff the opportunity to meet these new objections just sprung on him.

After examination of plaintiff in a patent action, the defendant applied to postpone the trial on the ground that he had discovered new facts, showing the alleged invention was not new at the date of the patent, and to amend the particulars. Application refused: *Moss* v. *Molings*, 33 Ch. D., 613.

Particulars as to First and True Inventor.

The English Act of 1883, sec. 29, sub-sec. 3, does not require more than general grounds of objection, and a statement that the plaintiff *was not the true inventor* may suffice: *Vide* Terrell, 1st ed., p. 208. In Ontario, however, it has of late been the practice to require the defendant to state who is so considered, although this may be difficult to arrive at; for where there are several anticipations, it may be difficult to say who was the first inventor out of the several anticipators, although all may be anterior in point of time to the plaintiff, and any one may suffice to cut out the plaintiff; besides that the prior invention may have been a secret one uncommunicated to any one and abandoned, and not sufficient to cut out the plaintiff as an independent inventor.

In England the Court will not require the defendant to say who was the first and true inventor: *Russell* v. *Ledsam*, 11 M. & W., 647; *Jones* v. *Berger*, 1 Web. P. C., 544, which is more reasonable than the recent Ontario practice.

Fraud.

If fraud be set up, the particulars of the fraud should be clearly set out: *Russell* v. *Ledsam*, 11 M. & W., 647.

Costs of Objections in England.

Where the plaintiff's case in England breaks down at the opening, on the ground that his invention was not a proper subject for a patent, the defendant is not entitled on taxation to his costs of particulars of objections since the Court will not go into these particulars merely to certify to their costs. Costs disallowed as to particulars not having certificate of the Judge. But if decided, on result of cross-examination of plaintiff's witnesses, and not on validity, the Court may look into particulars with a view of certifying. *Longbottom* v. *Shaw*, 43 Ch. D., 46.

The Court has discretionary power as to costs of objections: See *Parnell* v. *Most, Liddell & Co.*, 29 Ch. D., 325.

N. B.—In Canada the successful defendant would get his costs of particulars in any event; in England by sec. 29 of the Act of 1883, the Court or a Judge has specially to certify as to the cost of particulars without regard to the general costs of the case.

Privileged Communications—when and when not.

Communications between plaintiff and his solicitor are privileged and need not be divulged, but not so communications with his solicitor in the capacity of patent solicitor: *Moseley* v. *Victoria Rubber Co.*, 55 L. T., 482, R. P. C., vol. 3 (1886), p. 351.

Practice as to Particulars in U. S.

Under Revised Statute 4920, U. S., notice of want of novelty must state the names of prior patentees and the dates of their patents where prior patents are relied on, and the names and residences of the persons alleged to have had the prior knowledge, and where and by whom the thing patented was used. Nothing is said how prior publications are to be identified in the notice, but the title of the publication and page must be pointed out: See Sup. Ct. decision, *Silsby* v. *Foote*, 14 How., 218 (1852).

The word "where" and the word "residence" in the U. S.

statute refer to cities, villages or towns, and not to particular houses, factories and farms: *Wise* v. *Allis*, 9 Wall., 737 (1869).

By this section 4920, notice must be in writing, and must be served on the defendant or his attorney at least thirty days before the trial of the case; it is not the purpose of the statute to oblige the defendant to give notice of anticipating matter before taking *testimony*, and thus to enable the plaintiff to tamper with the witnesses. In the States the evidence is taken down and printed before the day of trial, in which respect the practice differs from that in England and in Canada, where the evidence is heard before the trial Judge on the day of trial.

Practice as to Particulars in England.

Defendants were entitled in an action to restrain threats to have the particular machines or parts of machines alleged to be an anticipation pointed out: *Law* v. *Ashworth*, R. P. C., vol. 7, p. 86 (1890).

In an action to restrain threats of legal proceedings, no defence can be based on the ground that what the defendant did was "*bonâ fide*," or that it was done on a privileged occasion, *e. g.*, in answer to a private enquiry: *Skinner & Co.* v. *Shaw & Co.* (1893), 1 Ch., 413.

There need be no particulars of objections of "*general public knowledge*," this must be proved by ordinary evidence with reference to well-known books: *Holliday* v. *Heppenstall*, R. P. C., vol. 6, p. 326 (1889).

Particulars allowed to be amended on the eve of trial on terms as to all costs occasioned: *Parker* v. *Magnan Filtre Rapide Co.*, 5 R. P. C., p. 207 (1888); also during trial on terms, the trial being adjourned to allow of the obtaining of reliable evidence: *Blakey & Co.* v. *Latham & Co*, 4 R. P. C. (1889).

The Patent Act, 1883 (Eng.), sec. 29, gives the Court at the trial of a patent action discretion to go beyond the particulars of objections, independently of the power of amendment of particulars. *Britain* v. *Hirsch*, R. P. C. V. 5, p. 226 (1888). Query, whether a Court in Canada would exercise such discretion.

The defendants must state which of the plaintiff's claims he

alleged to be anticipated by the specifications cited, and the alleged anticipating machines must be shown; but the defendants need not state which claims in particular he alleged to be anticipated thereby: *Boyd* v. *Farrar*, R. P. C., vol. 5, p. 33 (1888), 57 L. T., 866; and *Haslam & Co.* v. *Hall*, 4 R. P. C., p. 203.

Particulars must show as to which of the claims each of the objections was pointed: *Harris* v. *Rothwell*, R. P. C., vol. 3 (1886), p. 243.

In particulars of breaches the plaintiff may not be called on to give the names of the persons to whom he alleged the defendant had sold, and the dates of the sales, at the early stage of the action: *Russell* v. *Hatfield*, R. P. C., vol. 2, p. 144 (1885).

Where the claims infringed were specifically referred to, though the pages and lines were not, it was held that sufficient particulars had been given: *Church Engineering Co.* v. *Wilson*, R. P. C., vol. 3, p. 123 (1886.)

Defendant must point out what part of the specifications relied on were anticipations, and what parts were claimed by plaintiff's specification: *Fowler* v. *Gaul*, R. P. C., vol. 3, p. 247 (1886).

Particulars must be given showing, at which of the six claims each of the anticipating objections as to publication and user was pointed, and the parts of books and specifications must be indicated without relying on the whole: *Harris* v. *Rothwell*, R. P. C., vol. 3, p. 243 (1886).

Practice as to Particulars in Canada.

In *Smith* v. *Greey*, 10 Prac. Rep. (Boyd, C., November 10th, 1884), on a motion to commit defendants for unsatisfactory answers in their examination for discovery, it was held that where a party delivers particulars, he will be precluded from going outside them at the trial, but such is not the rule where he is examined, and knowledge of objections is acquired subsequent to his examination.

Benbow v. *Law*,16 Ch. D., was cited as governing "you are not entitled to see what evidence your opponent is prepared to give in support of his own case."

Birch v. *Mather* and *Crossley* v. *Tomey* (*supra*) were referred

to. There is no legislation in Ontario similar to that in the English Patent Acts as to particulars.

In *Smith* v *Greey*, 10 Prac. Rep., the Chancellor held that in Ontario the general law applicable to discovery governs in patent cases.

A defendant may be properly interrogated as to the grounds of attacking a plaintiff's patent, and there should be a fair and full disclosure of the particular lines of attack, but no such individualizing of the persons who are alleged to be prior users as would enable the plaintiff to fix upon the defendant's witnesses.

Prior to the foregoing decision, the practice in Ontario had been to obtain the names and addresses of prior users, but in *Smith* v. *Beaumwart* (16th May, 1885) followed the foregoing decision, *the names and addresses* were excluded.

However, on *15th May, 1885*, in *Smith* v. *Greey* (No. 2), on an appeal from an order of the Master in Chambers, Proudfoot, J., made an order whereby the names of *prior users*, as well as *the dates and occasions of such use*, were ordered to be given, reverting to the old practice.

This same question came up in *Smith* v. *Greey*, 11 Prac. R. Ont., p. 169, before the Chancery Divisional Court, Dec. 3rd, 1885, on an appeal from the judgment referred to of Proudfoot, J., on the part of defendants, and so far as giving the names of *the prior users* has settled the practice in Ontario.

In this case the defendants denied the novelty of the inventions, and that the plaintiff was the first and true inventor.

Held (Boyd, C., dissenting), that the defendants should deliver particulars under these defences, showing in what respect the defendants deny that the plaintiff's patent was for any new machine, etc., and the dates and occasions when, *and the places where*, the prior user of said invention or any material part took place, and also the names of the persons by whom the prior user was had.

Boyd, C., who dissented, was of opinion that in the absence of any legislation or Rules of Court upon the subject, the Judge has no power or right to prescribe so minutely what shall be disclosed in particulars, and that the statute, 35 Vic., c. 26, sec. 24

(Can.), now sec. 31, Patent Act, goes no further than to justify such general order for particulars as is usual in other cases.

[NOTE.—The order should have been extended to the present addresses of the prior users, and the headnote in *Smith* v. *Greey*, 11 Prac. R. (Ont.), is defective in that no reference is made to the places where the *prior user* took place, for insertion in the order.]

Apart from special legislation the Court can prevent surprise and misadventure by regulating the proceedings: *Electric Tel. Co.* v. *Nott*, 4 C. B., 462.

Boyd, C., held that the matter of practice was settled here in *Mills* v. *Scott*, 5 U. C., Q. B. R., 360 (1850), that the defendant was not bound to give the names of prior users, and that there had been no change since.

Ferguson, J., held that sec. 24 of the Patent Act of 1872, which first appears in the Patent Act of 1869, gave jurisdiction; and as in Canada we had no special legislation as in England, the enactments and practice in England should guide, and the order of Proudfoot, J., was not too comprehensive.

In making an order for particulars of the defence the better practice is to provide merely for exclusion of evidence in case of no particulars or insufficient particulars being delivered, and not to order the excision of the defence if good *per se*.

And when both excision of the pleading and exclusion of the evidence were provided for in an order,

Held, that the decision of a Judge in Chambers in striking out the provision for excision was rightly exercised: See *Noxon* v. *Patterson*, Can. L. T., vol. 14, p. 36, 16 Prac. R., Ont., p. 40; the judgment is reported at length in 16 Prac. R., Ont.

The Master in the first instance ordered both. Meredith, J., on appeal, 11th Dec., 1893, struck out that part of the order relating to the excision of defence. On appeal to the Divisional Ct. Chy. on 22nd Jan., 1894, judgment was given upholding Meredith, J., costs to defendants in any event.

Boyd, C., states in effect, that the practice as to particulars is of Common Law origin, and that the usual form was to stay all

proceedings till they were delivered, and that Rule 458, Forms 132, 133, apply to plaintiffs in Ontario, but no form is given applicable to defendants. By 15, 16 Vic., c. 83, sec. 41 (Imp.), particulars are to be given of breaches complained of, and by defendants of objections relied on: *Palmer* v. *Cooper*, 9 Ex., 231; *Lister* v. *Leather*, 2 E. & B., p. 1030, in which the penalty for default was that no evidence should be allowed, and that in Chitty, 11th ed., pp. 210, 211 there was an alternative order either to exclude evidence or strike out defence, but this does not obtain in patent cases.

In Canada we should have legislation bearing on the question of particulars in patent suits in the same way as in England and the United States. The names and places of residence of prior users were required to be furnished in the States by the Patent Act of 1836. In England now by the Act of 1883 both time and place of prior user is required to be furnished, but the names are overlooked in the Act, though they are *also* required by numerous judicial decisions.

Our Con. Stat., Can., c. 34, sec. 20, sub-sec. 2, enacts that in "*sci. fa.*" proceedings the practice of the Queen's Bench in England shall prevail, whereby particulars of objections had to be delivered with the pleas. This is still the practice.

In *Ball and Socket Fastener* v. *Kraitzer* (decided Nov. 6th, 1893), Sup. Ct., U. S., 65 O. G., p. 1591, where the appellee had encumbered the record with copies of some fifty immaterial patents, he had to pay half the cost of printing the record, following *Railway Co.* v. *Stewart*, 95 U. S., 279-284, and the 10th Rule of Court.

In Ontario we should also have a Rule of Court on this question.

The objection that the plaintiff is not "the first and true inventor," should not be introduced, unless it is intended to raise the question whether he or somebody else was in fact the first and true inventor: *Thompson* v. *Macdonald*, R. P. C., vol. 8 (1891), p. 9.

32. Whenever the plaintiff, in any such action, fails to sustain his action, because his specification and claim embrace more than that of which he was the first inventor, and it appears that the defendant used or infringed any part of the invention justly and truly specified and claimed as new, the court may discriminate, —and the judgment may be rendered accordingly. 35 V., c. 26, s. 25.

Disclaimer by the Court.

NOTE.—This section is in effect again giving the Court the power of "disclaimer" already referred to under section 28, notes (*b*) and (*c*); so a patentee, in Canada, has unlimited chances of amendment under sections 24, 28 and 32; this section may have had its origin in 12 Vic., c. 24.

It refers to a case where the specification and claim are too broad; and to a specification with only *one claim;* if it were referable to a specification with *several* claims, one might understand readily how the plaintiff might be held entitled to succeed as to the valid claims which had been infringed, while as to the invalid claims sued on they might be abandoned, and a set-off with respect to costs incurred by bringing them into suit, might be made by the Court.

It is a rare case, when a patent includes a number of claims, that all of them are included in an infringement suit, infringement, as a matter of fact, generally takes place with respect to one or two out of half a dozen or more claims.

The only case in which a specification with one claim may embrace more than that of which the patentee was the first inventor, and yet after elimination of the old, leave something for the defendant to infringe, which remnant has been justly and truly claimed as new, would be in such a case as *Tuck* v. *Bramhill*, 6 Blatch., 95 (1868), referred to under note (*e*), sec. 24, where the claim was for "*a packing for pistons*" so cut that the thread or warp shall run in a diagonal direction from the line or center of the roll of packing and rolled into form either in connection with the India rubber core or other elastic material, *or without*, as herein set forth.

Here such a thing without a core was old which the patentee disclaimed, leaving the rest of the claim valid and effectual.

Now the Patent office here as well as in the U. S. object to a

claim in the *alternative* form, such as stated, and it would almost surely be rejected; possibly the section 32 did not contemplate this case, what then did it contemplate? for it is of Canadian origin and unlike anything in England or the States.

This section is also contradictory, for if the specification and claim embraces more than that of which the patentee was the first inventor, how could the defendant use or infringe any part of the invention justly and truly specified and claimed as new, except in the very rare and obsolete *alternative* form of claim referred to in *Tuck* v. *Bramhill* (*supra*), from the context it would appear that it should be read in the plural, *claims*, which would make the section intelligible. This is the fourth method we meet with in our Act to cure or avoid the effects of a defective specification, which, then as now, are very numerous; the section might be made to meet modern wants by putting "claims" in the plural, and as each claim, as we have shown, stands for a separate invention and may be viewed in the light of a separate patent, the Court is then in position to discriminate with respect to any of these claims which are valid and have been infringed: *Hunter* v. *Carrick*, 28 Grant, Ch. R., Ont., 489 (1881), is a case in point.

This section 32 provides no method for correcting the defective specification and claim, as is the case in sections 24 and 28.

33. The defendant, in any such action, may plead specially as matter of defence, any fact or default which, by this Act, or by law, renders the patent void; and the Court shall take cognizance of that special pleading and of the facts connected therewith, and shall decide the case accordingly. 35 V., c. 26, s. 26.

NOTE.—This is the same as in the Patent Act of 1872, only that "would render" now becomes "renders." The defences to a suit for infringement of a patent are very numerous, and most of them peculiar to this branch of the law.

Defences in a Patent Suit Enumerated.

The defendant may plead (**1**) that the subject matter of the Letters Patent was not the statutory subject of a patent; or (**2**) that it was not an invention; or (**3**) that it was not novel at the time of its alleged invention; or (**4**) that it was not useful at

that or any time; or (**5**) that the inventor had actually abandoned the invention before application was made therefor; or (**6**) that the inventor had constructively abandoned it by allowing it to be on public use or on sale *with his consent or allowance for* more than one year before such application; or (**7**) that the invention claimed in the original patent is substantially different from anything indicated, suggested or described in the original application therefor; or (**8**) that the patentee surreptitiously or unjustly obtained the patent for that which was in fact the invention of another who was using reasonable diligence in adapting and perfecting the same; or (**9**) that the invention was made by another jointly with the sole applicant; or (**10**) that it was made by one only of two or more joint applicants; or (**11**) that for the purpose of wilfully misleading the public the specification and drawings contain more or less than is necessary for obtaining the end for which they purport to be made; or (**12**) that some material allegation in the petition or declaration of the applicant was untrue; or (**13**) that the description of the invention in the specification is not in such full, clear, concise and exact terms, as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected to make, construct, compound and use the same; or (**14**) that the claims of the patent are nebulous and indistinct, and do not embrace operative combinations or processes; or (**15**) that the patentee unreasonably delayed to enter a needed disclaimer; or (**16**) that the original patent was surrendered and reissued in the absence of every statutory foundation therefor; or (**17**) that the claims of the reissue Patent are broader than those of the original, and that the reissue was not applied for till a long time had elapsed after the original was granted; or (**18**) that the reissue Patent in suit covers a different invention from any suggested, indicated or described in the original specification and drawings; or (**19**) that the patent had been repealed by "*sci. fa.*," or that proceedings were pending; or (**20**) that the patent legally expired before the alleged infringement began; or (**21**) that the plaintiff has no title to the patent, or no such title as can enable him to maintain the action; or

(**22**) that the defendant has a license, which authorized part or all of the things which constitute the alleged infringement; or (**23**) that the defendant has a release discharging him from liability on account of part or all of the alleged infringement; or (**24**) that the defendant is not guilty of any infringement of the patent on which he is sued; or (**25**) that the plaintiff is estopped from enforcing his right of action or setting up cause of estoppel; or (**26**) that the plaintiff has not within two years of the date of the patent, or of an authorized extension, commenced to manufacture in Canada, and after commencement, continuously carry on the construction of the invention patented in such a manner that any person desiring to use it may obtain it or cause it to be made for him at a reasonable price at some manufactory or establishmeut for making or constructing it in Canada; or (**27**) that after the expiration of twelve months from the granting of the patent or any authorized extension of such period for one year, the plaintiff had imported or caused to be imported into Canada the invention for which the patent is granted; or (**28**) that the patent had not been applied for in Canada within one year from the date of the issue of the first foreign patent for the same invention; or (**29**) That more than three months after the date of issue of a foreign patent for the invention, the defendants had commenced the manufacture of the article so patented abroad, and that the Canadian patentee had not given the notice required under sec. 8 of the Patent Act; or (**30**) that the patented invention had been described in a book, or other printed publication before the date of the application therefor; or (**31**) that the patented invention had been previously described, or described and claimed in Canadian or foreign patents; or (**32**) that the alleged infringing article was the specific article manufactured prior to the issue of the Canadian Patent; or (**33**) That the patent on which the action is brought is not properly signed or countersigned, or sealed with the seal of the Patent Office; or (**34**) That the action was brought after the expiry of the Letters Patent; or (**35**) that a prior foreign patent limiting the life of the Canadian patent had expired prior to the act of infringement complained or of the bringing of the action

as the case may be; or (**36**) that the patent on which the suit is brought does not claim and cover an art, machine, manufacture or composition of matter, or any improvement thereon, but does claim and covers an abstract principle; or (**37**) that the said alleged invention had been known or used prior to the alleged invention thereof; or (**38**) that the said patent on which the action is brought has an illicit object in view (setting out the illicit object); or (**39**) that the alleged invention is merely the result of mechanical skill; or (**40**) that the alleged invention was merely the substitution of a known "mechanical equivalent" or "equivalents" for a part or parts of an existing machine, or the substitution of a known "chemical equivalent" as the case may be; or (**41**) that it is not a combination but a mere "aggregation" of elements; or (**42**) that it was merely a duplication of parts without change of function; or (**43**) that it was merely the omission of an element without any new mode of operation of the parts retained; or (**44**) that it was merely a change in form or size without the production of any new mode of operation.

The first fourteen defences relate to original patents and any one of them if maintained might void the patent; as to the effect of unreasonably delaying to enter a needed disclaimer: *Vide* disclaimer; there is great latitude in Canada with respect to disclaimers; the first fourteen also relate to reissue patents, for many of the original faults are retained in reissue patents, although patents are surrendered and reissued for the purpose of curing faults occasional through inadvertence, accident or mistake.

As to the first six defences: *Vide* notes sub-secs. 1 and 2, sec. 7 and sec. 16.

As to the defence under number 6, *ante*, it may be specially noted that in the Court of Appeals, District of Columbia:

In re Daniel Drawbaugh, 67 O. G., p. 928, (decided May 7th, 1894), with reference to the words of the U. S. Act, "not in public use or on sale for more than two years prior to his application," they were held to mean the creation of a limitation of two years within which a patent of invention must be applied for after it has gone

into public use, *either with or without the knowledge, consent or allowance of the applicant.*

The original U. S. Act of 1793 was interpreted by the Supreme Court in *Pennock* v. *Dialogue* (2 Peters, 1), as if the words "*with the consent or allowance*" had been included therein, and the U. S. Act of 1836 inserted the words "*with the applicant's consent and allowance.*"

In *Andrews* v. *Hovey*, 123 U. S., 267; 124 U. S., 694, the patent had issued under the Act of 1839, when the words "*with the consent or allowance*" had been omitted; after full consideration and motion for rehearing, it was held, all the Justices of the Sup. Ct. U. S. concurring, that two years public use of an invention, before the application was made, whether *with or without the consent* of the patentee rendered the patent invalid.

As the present U. S. section 4886, like the Act of 1839, has no reference to *the consent* of the applicant, and is held to mean "*with or without the consent, etc.,*" *re Daniel Drawbaugh, supra,* it is a question whether the provision of our section 7 "*with the consent or allowance of the inventor thereof*" is to be read like the U. S. section as "*with or without the consent*" so as to make one year's use prior to the application for the patent in Canada, even though *without* the consent or allowance of the inventor fatal to the validity of the patent.

Following the maxim "*expressio unius exclusio alterius*" the wording of our section "with the consent or allowance of the inventor thereof" may be taken to exclude the converse, so that an *unauthorized use* for more than one year prior to the application should not be fatal to the validity of a Canadian patent.

It may also be noted that the U. S. Act of 1836 refers to "*the consent of the applicant,*" while section 7 of the Canadian Act refers *to the consent of the inventor*; as the applicant may not be the inventor the term "*applicant*" is much better, being more comprehensive, and our section should be amended in this respect.

As to defences numbers 9 and 10: *Vide* Part IX, Assignments.

As to defences numbers 11 and 12: *Vide* notes to sections 10 and 28.

As to defence 13: *Vide* note (*a*), sec. 13.

Defences 16, 17 and 18 directly assail reissues as reissues: *Vide* Part VII., Reissue of Patents, p. 172–194.

Defence 19, if "*sci. fa.*" proceedings were pending, a stay of action might be obtained until the "*sci. fa.*" proceedings were determined: *Vide* section 34.

Defence 20 will be available when the patent has expired through non-payment of fees, or after having lived its full term.

Defence 21, as to the question of title: See Part IX, "Assignments."

Defence 24: See "infringement" under section 31.

Defence 25: See "estoppel" under notes to section 26.

Defence 26 and 27: See notes under section 37. Even before the jurisdiction of the Minister of Agriculture, and his Deputy was taken away, it was held by Mr. Taché in the *Telephone Manufacturing Co. of Toronto* v. *The Bell Telephone Co. of Canada*: See Appx. 2, vol. 2, Exch. Ct. R. (Can.), p. 18, Revue Legal 463 and 9 Legal News (Que.) 27, that under section 33, "any fact or default which by this Act or by law would render the patent void" includes that of non-manufacture and "importation" under the 37th section, which might be pleaded, though the question was to be decided at that time exclusively by the Minister of Agriculture or his Deputy. The section was, however, at that time somewhat inconsistent, seeing that the Minister had "*exclusive*" jurisdiction; now, although in the same words, as then, it is quite consistent.

Defences 28 and 29: See notes (*a*), (*b*), (*c*), under sec. 8.

Defences 30 and 31: See notes (*d*) and (*e*), section 16.

Defence 32: See note to section 46.

Defence 33: See section 21 of Patent Act.

Defence 35: See note (*d*), section 8.

Defence 36: See sub-sec. 2, sec. 7.

Defences 37 and 38: See note (*d*), section 7.

For defences 39 to 44 inclusive: See note (*a*), section 16.

34. Any person who desires to impeach any patent issued under this Act, may obtain a sealed and certified copy of the patent and of the petition, affidavit, specification and drawings thereunto relating, and may have the same filed in the office of the prothonotary or clerk of the Superior Court for Lower Canada in Quebec, or of any of the divisions of the High Court of Justice for Ontario, or

of the Supreme Court in Nova Scotia, or of the Supreme Court in New Brunswick, or of the Supreme Court of Judicature in Prince Edward Island, or of the Supreme Court in British Columbia, or of the Court of Queen's Bench in Manitoba, or of the Supreme Court in the North-West Territories, according to the domicile elected by the patentee, as aforesaid, or in the office of the Registrar of the Exchequer Court of Canada,—which courts, respectively, shall adjudicate on the matter and decide as to costs; and if the domicile elected by the patentee is in the District of Keewatin, the Court of Queen's Bench of Manitoba shall have jurisdiction until there is a superior court in such District, after which such superior court shall have jurisdiction. 35 V., c. 26, s. 29; 37 V., c. 44, s. 1; 38 V., c. 14, s. 8; 49 V., c. 25, s. 14. The Patent Act (1886). 53 V., c. 13, s. 1.

2. The patent and documents aforesaid shall then be held as of record in such courts respectively, so that a writ of *scire facias* under the seal of the court, grounded upon such record, may issue for the repeal of the patent, for cause as aforesaid, if, upon proceedings had upon the writ in accordance with the meaning of this Act, the patent is adjudged to be void. 35 V., c. 26, s. 29; 37 V., c. 44, s. 1; 38 V., c. 14, s. 8; 49 V., c. 25, s. 14.

This sub-section 1 was substituted by the amending Act of 1890 for sub-sec. 1, sec. 34, of the Patent Act of 1886, Revised Statutes (Can.). The only difference being that in addition to the Courts named in the Act of 1886, the Exchequer Court of Canada was indicated wherein proceedings might be taken for the repeal of a patent.

Section 29 of the Act of 1872 had a similar provision, and contained both sub-sections 1 and 2 of this Act; but the Courts only in Quebec, Ontario, Nova Scotia, New Brunswick, Manitoba and British Columbia were alluded to; the ten Courts mentioned in the present section indicate the expansion of the Dominion since 1872.

Sci. fa. First in 1849 in Canada.

Proceedings for the repeal of a patent by *sci. fa.* were first introduced by sec. 17, 12 Vic., c. 34, the Patent Act of Canada, 1849, and were required to be instituted within two years of the date of the patent, or in the term of Court next after said two years, and not after. This provision again appears in sec. 20 of the Consolidated Statute of Canada, c. 34 (1859).

Besides the provision of the Consolidated Statute of Canada (1859), c. 34, by Consolidated Statute of Upper Canada, c. 21,

22 Vic. (1859), "An Act respecting the practice and procedure in suits instituted on behalf of the Crown in matters relating to the revenue and the repeal of Letters Patent" was passed, which provided that Superior Courts in Upper Canada might issue writs of "*scire facias*" to repeal Letters Patent, and that the practice shall be the same as in England, and that the *fiat* of the Attorney-General was to be obtained and that an exemplification of the Letters Patent was to be filed, on which the writ of "*scire facias*" was to be founded.

The writ derives its name from the fact that the sheriff by his warrant to his bailiffs directs them to make known (*scire facias*) to the defendant that he appear in the Exchequer Court within days of the service of the writ on him.

In *Regina* v. *Patee*, 5 Ont. Prac. Rep., p. 292, Jan. 5th, 1871, a "*sci. fa.*" to set aside a patent was issued at the instance of a private relator without the fiat of either the Attorney-General of the Dominion or of Ontario having been first obtained: *Held*, that a fiat was necessary, and the Attorney-General of Ontario was the proper party to grant it.

This decision has not been followed in Ontario in the only case we have subsequently reported; the fiat was that of the Attorney-General for the Dominion, dated Jan. 23rd, 1885: *Regina* v. *Smith*, 7 Ont. R., 440; *Regina* v. *Patee*, probably followed the Upper Canada Act, 22 Vic., c. 21, just referred to.

In *Attorney-General and Bate*, 27 L. C., Jurist, and 6 L. N., 271, Sup. Ct. R. (1883), (Taschereau, J.) "*Sci. fa.*" to set aside a patent under 35 Vic., c. 26. Proceedings had been taken in the name of the Attorney-General of the Province of Quebec, and objection was made that action could only legally be brought in the name of the Attorney-General of Canada. The action was dismissed. Confirmed in the Court of Review.

Since the Patent Act of 1869, the two years limit within which "*sci. fa.*" proceedings were to be instituted, has been dropped out.

Proceedings for the repeal of patents by "*sci. fa.*" have hitherto been rare; the new jurisdiction of the Exchequer Court, hereafter referred to, will, however, add to the number of reported cases.

First "Sci. fa." Case in Canada.

The earliest case reported in Upper Canada is *The Queen* v. *Hall*, 27 U. C., Q. B. (1867).

Held, that the effect of Consol. Stats. (Can.), c. 34, sec. 20, sub-sec. 2, enacting that the proceedings, on "*sci. fa.*" to repeal a patent shall be according to the law and practice of the Court of Queen's Bench in England, is to introduce the Imp. Act, 15 and 16 Vic., c. 83, of 1852, the Consol. Act taking effect 5th Dec., 1859, and that leave to deliver particulars of the breaches, which should have been delivered with the declaration, could only be granted as if the declaration were delivered "*de novo*," that as a jury had been sworn in, this, therefore, could not be done, and a verdict was properly directed for the defendant. The Court on a motion for a new trial allowed the plaintiff to deliver particulars on terms. The patent related to improvements on lumber waggons, and it was suggested that the defendant was not the true inventor, but that one Thompson Smith was.

This decision still holds good, and it is necessary to file particulars along with the declaration in *sci. fa.* proceedings, the English practice laid down in the Imp. Act of 1852 being still followed.

By the Imp. Patent Act of 1883, sec. 26, the proceeding by "*scire facias*" to repeal a patent is abolished in the United Kingdom, and revocation of a patent may be obtained on petition to the Court.

Common Law Right of Crown to Repeal (Eng.).

If it appears that the Crown, in granting Letters Patent, has been deceived in any material particular by a false representation or suggestion of the grantee, the Crown had by common law a right to proceed by "*scire facias*" to repeal and cancel the patent: *Rex* v. *Butler*, 3 Lev., 220, 221; it was also available for any subject who could show that a void or illegal patent operated to his prejudice: *Rex* v. *Aires*, 10 Mod., 354, and as every one was assumed to be prejudiced by an illegal patent, all were entitled to institute an action on obtaining the fiat of the Attorney-General: *Vide* Form 42, Appx. 2, giving leave to sue in the

name of the Crown. The fiat is only granted on condition that the prosecutor provided a sufficient bond: *Vide* Form 43, Appx. 2, to secure the defendant his taxed costs as between attorney and client, in the event of the patent not being annulled.

The writ is in the nature of a pleading and sets out the effect of the patent and the suggestions upon which the prosecutor seeks the repeal of the patent (*vide* Appx. 2, Form 44), and may include anything which shows the patent was originally void, or that it had become so since it was made.

The writ is directed to the Sheriff to summon the defendant to appear in any of the Courts mentioned, to show cause why the said Letters Patent should not be repealed.

Upon the return of the writ the defendant enters an appearance. The prosecutor then files and delivers his declaration: *Vide* Form 47, Appx. 2, along with his particulars of objections: *Vide* Form 48, Appx. 2, and the defendant his pleas: *Vide* Form 49, Appx. 2, or demurrer if the matters alleged in the writ are not sufficient to repeal the patent.

Stay of Proceedings in a Suit while "Sci. fa." Pending.

In *Smith* v. *Upton*, 6 Mac. & G., 251 (Tyndall, C. J.), the Court stayed proceedings in an action for infringement, to await the result of a motion pending on a "*scire facias*," upon the terms that the plaintiff should pay the defendant any costs which he may have incurred in preparing for trial, and the costs of the motion in the event of the patent being annulled.

Repeal in Great Britain by Proviso in the Grant.

In the United Kingdom under a proviso contained in the grant, the Crown has the right to annul the Letters Patent for cause shown without any proceedings by petition, or otherwise, this is also by common law an old prerogative of the Crown (4 Inst. 88).

Grounds for Repeal.

Most of the matters which may be set up as a defence to an action of infringement: *Vide* notes to section 33 are grounds upon which patents may be sought to be repealed.

The person who is the patentee, and has the custody of the patent itself, must be made defendant; and where interests have been assigned, the assignee or assignees must also be joined; or where there are joint interests, the joint patentees must be defendants. In case of the death of a patentee or assignee, the legal representatives should be made defendants. The style of cause should be: Her Majesty the Queen at the relation of *A B* (plaintiff) v. *C D* (defendant).

Burden of Proof on the Informant.

An action by "*scire facias*" differs from an action of infringement in this respect; that the burden of proof is on the informant attacking the patent.

Patentee Has Reply.

The patentee has to open the case, and has the advantage of reply.

By sub-sec. 7 of sec. 26, Imperial Act of 1883, it is enacted that the defendant shall be entitled to begin and give evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent, the defendant shall be entitled to reply.

In Ontario there is now no writ of "*sci. fa.*" except as to these proceedings to annul a patent; and beyond the English practice and precedents and two or three Canadian cases, we have nothing to guide us.

In an ordinary suit for infringement in the Provincial Courts or the Exchequer Court, in which the defendant is successful, the patent only becomes null and void as to the defendants and those claiming through them. If it is desired to annul the patent entirely, it is necessary to do so by "*sci. fa.*" proceedings, and to file the certificate of the judgment in the Patent Office in compliance with the 35th section of the Patent Act (Can.).

The Crown alone has the right of demanding that Letters Patent granted under the Patent Act be annulled: *The Union Navigation Co.* v. *Restony*, 20 L. C. Jur., 306.

Where the repeal of a patent is a principal object of the action, the proceedings should be by "*sci. fa.*": See *Lainer* v. *Collette*, 5 L. N., 412, *S. C.* (1882).

Regina v. *Smith*, 7 Ont. Rep., p. 440, was decided by Mr. Justice Rose (23rd January, 1885) in favour of the defendant patentee on a demurrer. The Crown demurred on the ground that the matters set up in the pleas were not sufficient in law to bar the Queen from impeaching the Letters Patent: *Held*, that the statute (the Patent Act of 1872) does not require the delivery of a model prior to the issue of a patent: *Vide* Note to section 14.

This is the only *sci. fa.* decision we have had in the Provincial Courts of Ontario since 1867.

In Quebec in *The Attorney-General and Bate*, 6 L. N., 227, *S. C.* (1883), just the opposite view was taken on *sci. fa.* and the patent declared void; but see *contra*, *Campbell* v. *Bate*, 15 R. L., 467, *S. C.* (1886).

In *Regina* v. *Smith*, the suit should have been entitled *Reg. at the relation of E. C. Holden* v. *Smith*, Holden being the party at whose instance it was sought to annul the patent. A certified copy of the Patent No. 10,543, and certified copies of the oath and petition were filed in the Q. B. Div., Osgoode Hall, Toronto.

"Sci. fa." Proceedings in Ontario.

The præcipe filed for the writ of "*sci. fa.*" is for the repeal of the Letters Patent, giving the name and address of the applicant and the name and address of the patentee and setting out all the grounds relied on for repeal, and that the writ should be directed to the Sheriff of the county of ——, dated and signed by the solicitor for the applicant.

The fiat filed is granted by the Attorney-General for the Dominion, and this appears to be the proper practice, notwithstanding *Regina* v. *Patee*, 5 Ont. Prac. R., 292, *supra*; it was on the condition that the applicant, James C. Holden, give to the satisfaction of the Clerk of the Queen's Bench Division, H. C. J., Toronto, a bond executed by applicant and two sureties, each in the penal sum of $2,000.

Bond.

The bond for security of costs in *Regina* v. *Smith*, *ante*, was a joint and several bond in the penal sum of $2,000, executed by E. C. Holden and two sureties, conditioned to pay all costs and

charges, etc., to be taxed as between attorney and client, and not as between party and party, to the patentee or his legal representatives in the event of the letters not being adjudged to be void or vacated, cancelled or disallowed by means of the writ of *scire facias*.

A notice of allowance by the Registrar, Queen's Bench Division, is endorsed in the margin.

Amount of Bond Excessive.

The amount of this bond ($2,000) in *Regina* v. *Smith*, appears excessive, and is just double that now required in the Exchequer Court of Canada.

A bond in $1,000 by the informant and two sureties, joint and several, would now probably suffice in Ontario.

The writ of "*sci. fa.*" with the return of the sheriff is also filed. The writ is in the nature of a pleading, and sets out the effect of the patent and the suggestions for repeal: *Vide* Form 44, App. 2. There was also a withdrawal of prosecution as to certain of the suggestions.

An appearance in *Regina* v. *Smith*, *ante*, was filed September 10th, 1884, and a declaration embodying the writ of "*sci. fa.*" was also filed and served, as well as the particulars of objections, which were also filed and served along with the declaration.

Pleas by defendant in answer to the suggestions in the declaration, filed.

"*Demurrer*" on the part of the Crown that the matter set up in the pleas are not sufficient in law to bar our Lady the Queen from impeaching the patent.

This "*demurrer*" was argued and found in favour of the defendant.

The "*demurrer*" in *Regina* v. *Smith*, contains an erroneous request that the Letters Patent be delivered up to the Registrar of the Queen's Bench Division to be destroyed. He has only to certify as to the judgment and has nothing to do with destroying the Letters Patent: *See* as to annulment, sec. 35.

By the present Patent Act proceedings may be instituted in the Q. B. Div., C. P. Div., or the Chancery Div., and are not confined as

formerly to the Q. B. Div., and may also be taken in any of the Courts mentioned in this section 34, sub.-sec. 1. Proceedings are now usually taken in the Exchequer Court.

Jurisdiction in 1890 Given to Exchequer Court.

Sub-sec. 1, sec. 1, 53 Vic., c. 13, substituted in 1890 for the sub-sec. 1 in the Patent Act of 1886, first gave jurisdiction to the Exchequer Court of Canada in the matter of the repeal of Letters Patent by *sci. fa.*

And by sec. 4, sub-sec. (*b*), 54, 55 Vic., c. 26, "An Act to further amend the Exchequer Court Act," assented to 30th September, 1891, the Exchequer Court was clothed with jurisdiction: (*b*) "In all cases in which it is sought to impeach or annul any patent of invention, or to have any entry in any register of copyrights, trade marks or industrial designs made, expunged, varied or rectified;" so that the jurisdiction is doubly provided for.

There is no special advantage gained in instituting *sci. fa.* proceedings in the Exchequer Court beyond the fact that an appeal lies to the Supreme Court from a refusal by the Exchequer Court to grant an order *nisi*, or, if an order shall have been granted, from the decision of the Court on motion to make the same absolute: See Exch. Ct. Rule 231. Whereas if proceedings are instituted in the Provincial Courts, there are intermediate appellate Courts to be passed before the Supreme Court can be reached, thus making the procedure more expensive and cumbersome.

Proceedings by "*sci. fa.*" in any of the Provincial Courts, under secs. 34, 35 and 36 of "the Patent Act," are quite as effectual to annul a patent as proceedings in the Exchequer Court of Canada.

Bond for $1,000 in Exch. Ct. (Can.).

A joint and several bond in the penal sum of $1,000 made by informant and two sureties is also required in the Exchequer Court, Canada, as well as one to at least that amount in the Provincial Courts of Ontario, and possibly also in those of the other Provinces. The Province of Quebec is the only other Province besides Ontario where *sci. fa.* proceedings are reported to have been instituted.

The procedure has not been well settled in the Exch. Ct. (Can.) as yet, but it follows that already indicated for the Province of Ontario, which would doubtless be followed in the other Provinces and Territories of the Dominion, but the tendency will undoubtedly be to institute proceedings in the Exchequer Court, as the Judge holds circuit from the Atlantic to the Pacific oceans.

N. B.—For form of pleadings in a "*sci. fa.*" case in the Exch. Ct. (Can.), see report of *The Queen* v. *La Force*, 4 Exch. Ct. R (Can.), pp. 15-24, where they are printed in full; these pleadings, of course, may vary to suit the circumstances of each case.

Forms in "Sci. fa."

The Forms 42, 43, 44, 45, 46, 47, 48, 49 and 50, set out at length in Appendix 2, are forms that have been used in the Exchequer Court of Canada. Of course, they are subject to variation, and have to be adapted to the circumstances of each particular case.

Form 52a, Appx. 2, is the general order of the Exchequer Court of Canada of the 5th December, 1892, containing the Rules relating to the impeachment of Letters Patent; and Form 51, Appx. 2, the general order as to procedure in the Exchequer Court of Canada, and Form 52b is the general order of the 8th February, 1894, relating to filing consents, etc., and as to special cases.

Documents to be Filed.

The documents referred to in sub-sec. 2, sec. 34, are the certified copy of the patent, specification and drawings, and a certified copy of the affidavit and petition, as well as certified copies of any assignments or other documents relating to the title to the patent, certified under the seal of the Patent Office by the Commissioner, or possibly the Deputy Commissioner, who by sec. 21 has now power to sign patents as well as the Commissioner.

The writ of "*scire facias*" is to be under the seal of the court from which it issues, and signed by the clerk or registrar of the Court.

Omission in Sub-Sec. 2, Sec. 34.

The words "*And the said patent shall be repealed,*" have apparently been omitted after "for cause as aforesaid," in this sub-section. Their insertion would make the meaning more apparent.

37 Vic., c. 44, sec. 1, referred to, amends sub-sec. 1, sec. 29 of the Patent Act of 1872: "The Supreme Court in the Province of New Brunswick," being substituted for "The Court of Queen's Bench in the Province of New Brunswick."

38 Vic., c. 14, sec. 8, amends the same sub-section in proceedings for impeachment in Prince Edward Island. The certified documents are to be filed with the Clerk of the Supreme Court of Judicature there.

And by 49 Vic., c. 25, sec. 14 (1886), the Sup. Ct. of the North-West Territories is to have all the rights, etc., of a Court of Record, as exercised by Her Majesty's Superior Courts in England, on the 15th July, 1870.

35. A certificate of the judgment avoiding any patent shall, at the request of any person filing it to make it of record in the Patent Office, be entered on the margin of the enrolment of the patent in the Patent Office, and the patent shall thereupon be, and be held to have been void and of no effect, unless the judgment is reversed on appeal as hereinafter provided, 35 V., c. 26, s. 30.

NOTE.—This is substantially the same as in the Act of 1872, with verbal alterations. The word "voiding" is now changed to "avoiding," which is not so correct; "in order to make it of record" would be better than as it is now. It is also difficult to see the object in having the words "and be held to have been" inserted before void, for it is the filing of the certificate of judgment in the Patent Office, and the entry thereof on the margin of the enrolment, which rendered the patent void and of no effect.

Time Should be Allowed for Appeal before Final Entry of Repeal.

There should be some time limited after the filing of the certificate of judgment in the Patent Office before the entry on the margin of the enrolment, consummating the repeal, be made, in order to give the patentee time to appeal, and there should be

provision to notify the Patent Office that an appeal is pending, so as to stay the entry on the enrolment. The patent should not be finally repealed until after a lapse of say three months after the filing of the certificate of the judgment.

It is presumed that a certificate of judgment means a certified or office copy of a judgment. In Ontario, the Court of Appeal is the only court which issues a *certificate of judgment.*

The fee payable on registering a judgment by sec. 39 is $4.

36. The judgment declaring or refusing to declare any patent void shall be subject to appeal to any court having appellate jurisdiction in other cases decided by the court by which the judgment declaring or refusing to declare such patent void, was rendered. 35 V., c. 26, s. 31.

NOTE.—The judgment referred to is that of a Superior Court (see section 34); after having been referred to the Appellate Courts of the Provinces in which proceedings were instituted, the final Court of Appeal is the Supreme Court of Canada.

Appeal from Provincial Courts.

An appeal to the Supreme Court, Canada, is always understood to be from the Court of last resort in the Province where the judgment was rendered in such case (*vide* sec. 11, Supreme Court Act); under very exceptional circumstances the Supreme Court has permitted a direct appeal to itself without resort to the last Appellate Court of the Province, but not in any patent suit.

Appeal from Exchequer Court (Can.).

Under par. 8 of the Exchequer Court Amendment Act, c. 26, 54, 55, Vic. (1891), paragraph lettered (*b*) of sub-section 1 of section 52 of the Exchequer Court Act, Canada, 50–1 Vic., was repealed and the following substituted:

"(*b*) Relates to any fee of office, duty, rent, revenue or any sum of money payable to Her Majesty, or to any title to lands, tenements or annual rents, or to any question affecting any patent of invention, copyright, trade mark or industrial design, or to any matter or thing where rights in future might be bound."

By this, an appeal from the judgment of the Exchequer Court, Canada, in a "*sci. fa.*" proceeding is provided for.

Notwithstanding the bond given on obtaining the writ of *sci. fa.*, a further bond in $50 is required on an appeal to the Supreme Court.

The general or broad wording of this section 36 might have made a judgment on a "*sci. fa.*" in the Exchequer or Provincial Courts, appealable to the Supreme Court, without any special enactment.

As to Adducing Fresh Evidence on Appeal.

Where defendant moved for leave to adduce fresh evidence on appeal as to anticipation he had discovered after the trial: *Held*, that the motion must be refused because no issue as to novelty had been raised at the trial: *Hinde* v. *Osborne*, R. P. C., vol. 2 (1885), p. 45.

PART XI.

Forfeiture of Patents.

37. Every patent granted under this Act shall be subject, and be expressed to be subject, to the following conditions:—

(*a*) That such patent and all the rights and privileges thereby granted shall cease and determine, and that the patent shall be null and void at the end of two years from the date thereof, unless the patentee or his legal representatives, or his assignee, within that period or any authorized extension thereof, commence, and after such commencement, continuously carry on in Canada the construction or manufacture of the invention patented, in such a manner that any person desiring to use it may obtain it, or cause it to be made for him at a reasonable price, at some manufactory or establishment for making or constructing it in Canada;

(*b*) That if, after the expiration of twelve months from the granting of a patent, or any authorized extension of such period, the patentee or patentees, or any of them, or his or their representatives, or his or their assignee, for the whole or a part of his or their interest in the patent, imports, or causes to be imported into Canada, the invention for which the patent is granted, such patent shall be void as to the interest of the person or persons importing or causing to be imported as aforesaid:

2. Any question which arises as to whether a patent, or any interest therein, has or has not become void, under the provisions of this section, may be adjudicated upon by the Exchequer Court of Canada, which court shall have jurisdiction to decide any such question upon information in the name of the Attorney General of Canada, or at the suit of any person interested :

3. This section shall not be held to take away or affect the jurisdiction which any Court other than the Exchequer Court of Canada possesses. 35 V., c. 26, s. 28; 38 V., c. 14, s. 2; 45 V., c. 22, s. 1. The Patent Act (1886). 53 V., c. 13, s. 2 (1890); 54, 55 V., c. 33, s. 1 (1891); 55, 56 V., c. 24, s. 6 (1892).

2. Whenever a patentee has been unable to carry on the construction or manufacture of his invention within the two years hereinbefore mentioned, the commissioner may, at any time not more than three months before the expiration of that term, grant to the patentee an extension of the term of two years on his proving to the satisfaction of the commissioner that he was, for reasons beyond his control, prevented from complying with the above condition :

3. The commissioner may grant to the patentee, or to his legal representatives or assignee for the whole or any part of the patent, an extension for a further term not exceeding one year, beyond the twelve months limited by this section, during which he may import or cause to be imported into Canada the invention for which the patent is granted, if the patentee or his legal representatives, or assignee for the whole or any part of the patent, show cause, satisfactory to the commissioner, to warrant the granting of such extension; but no extension shall be granted unless application is made to the commissioner at some time within three months before the expiry of the twelve months aforesaid, or of any extension thereof. 35 V., c. 26, s. 28; 38 V., c. 14, s. 2; 45 V., c. 22, s. 1.

Patent Act of 1869, Section 28.

NOTE.—By sec. 28 of the Patent Act of 1869, patents were for the first time granted conditionally on the manufacture of the patented device, and it was declared that the patent should be void "at the end of three years from the date thereof, unless the patentee, or his assignee or assignees, shall, within that period have commenced, and shall, after such commencement, continually carry on, in Canada, the construction or manufacture of the invention or discovery patented, in such manner that any person desiring to use it may obtain it, or cause it to be made for him at a reasonable price, at some manufactory or establishment for making or constructing it in Canada."

Importation.

And by the Act of 1869 the patent was also to be void if after the expiration of eighteen months the patentee, or his assignee for the whole or part of his interest in the patent, im-

ported or caused to be imported into Canada the invention for which the patent was granted. In this Act of 1869 there was no provision for extending the time within which manufacture was to take place or importation was permissible; nor was any special tribunal appointed, but the ordinary Courts were left to adjudicate with respect to any breach of the conditions on which the patent was granted.

Act of 1872.

By the Patent Act of 1872, which took effect on the 1st of September, 1872, the Act of 1869 was repealed and re-enacted in much the same words as formerly; by sub-sec. 7 of sec. 28 of the Act of 1872 it was enacted "that such patent and all the rights and privileges shall cease and determine, and the patent shall be null and void at the end *of two* years from the date thereof unless, etc."; thus cutting down the time within which manufacture was to be commenced by one year, and the time after the date of the patent, within which importation of the patented device was permissible, was reduced to twelve months; in other respects the wording was the same as in the Patent Act of 1869.

By sub-section 2 it was provided that "whenever a patentee has been unable to carry on the construction or manufacture of his invention within the two years hereinbefore mentioned, the commissioner may grant to the patentee a further delay on his adducing proof to the satisfaction of the commissioner that he was for reasons beyond his control, prevented from complying with the same; but no such further delay shall be thus granted in any case in advance of the time hereinbefore prescribed"; but no provision was made as to the extension of time relating to importation.

It was also provided that in case "disputes should arise as to whether a patent has or has not become null and void under the provisions of this section, such disputes shall be settled by the Minister of Agriculture or his Deputy, whose decision shall be final."

Act of 1875, c. 14, s. 2.

By sec. 2, cap. 14, 38 Vic. (1875), sub-sec. 2, sec. 28, of the Act of 1872, just quoted, was repealed, and a new one substituted, which is the same as sub-section 2 of the present Patent Act; whereby the Commissioner may at any time, not more than three months before the expiration of two years from the date of the patent, grant to the patentee an extension of the term of two

years, within which manufacture in Canada must take place, on proving to the satisfaction of the Commissioner that he was for reasons beyond his control prevented from complying with the condition as to manufacture.

While in the Act of 1872 it was provided that no further delay should be granted in advance of the time prescribed, which is directly opposed to this enactment.

Act of 1882, c. 22, s. 1.

By the amending Act of 1882, sec. 28 of the Act of 1872, was again amended, and the present sub-section 3 of the present Patent Act was first enacted, authorizing the Commissioner to extend the time for importation for a period not exceeding one year if application be made within three months of the expiration of the twelve months mentioned in the first sub-section of section 28 of the Act of 1872.

R. S. C. (1886), c. 61, s. 37.

On the 1st March, 1887, the Revised Statutes of Canada came into force, and by 49 Vic., cap. 61, sec. 37, the provisions of sec. 28 of the Patent Act of 1872, and of the amending Acts of 1875 and of 1882, were revised and consolidated. The words "assignee or assignees" in the Act of 1872, were changed throughout into "legal representatives"; the words "or discovery" in the Act of 1872 were struck out, leaving the word "invention" by itself, apparently showing that a "*discovery*" was not synonomous with "*invention.*" In the United States the term "invention or discovery" is still retained in their patent laws.

In other respects the changes made by the Revised Statutes (1886), cap. 61, sec. 37, were merely verbal and formal.

Act of 1890, c. 13, s. 2.

By 53 Vic., cap. 13, sec. 2, assented to 24th April, 1890, sub-sec. 1 of sec. 37 of the Patent Act, R. S. C., cap. 61, was repealed and a new sub-section was substituted.

The wording was the same as in the Revised Act, except that the words "or his assignee" after "legal representatives" in sub-section

1, which were struck out when the statutes were revised in 1886, were again restored, and the words "or any authorized extension of such period" were added after the words "twelve months from the granting of a patent," referring to the clause prohibiting importation.

Jurisdiction of the Minister of Agriculture Taken Away.

That portion of the Revised Act of 1886 which conferred exclusive jurisdiction on the Minister or the Deputy of the Minister of Agriculture, making the decision of either of them final, in any question as to declaring a patent null and void for breach of condition relative to manufacture or importation, was finally struck out by the Act of 1890, and the jurisdiction of the said Minister or his Deputy was entirely abrogated, and the following inserted at the end of the new sub-sec. 1, sec. 37, of the Patent Act: "And any difference which arises as to whether a patent has or has not become null and void under the provisions of this section may be adjudicated upon by the Exchequer Court of Canada,—which Court shall have jurisdiction, upon information in the name of the Attorney-General of Canada, and at the relation of any person interested, to decide any such question; provided that this section shall not be held to take away or affect the jurisdiction which any Court, other than the Exchequer Court of Canada, possesses."

This has been amended by the Acts of 1891 and 1892, hereafter referred to, until it appears as now set out in the text of section 37.

Jurisdiction of Exchequer Court of Canada and Provincial Courts.

This enactment altered the whole procedure; hitherto all the decisions relating to breach of condition by non-manufacture and importation have been decided by the Minister of Agriculture or his Deputy; now the Exchequer Court of Canada has jurisdiction, apparently concurrent with the Provincial Courts, and the first decision is not final, for there is now the usual appeal to the Supreme Court from the final Courts of Appeal in the various Provinces, and by section 8 of "*The Exchequer Court Amendment Act of 1891*" there is also an appeal on "any question affecting any patent of invention" to the Supreme Court of Canada.

Now "*non-manufacture*" within the time limited by this section 37 and "*importation*," beyond the authorized time, of an article patented in Canada, may be specially pleaded in defence to an action of infringement.

Up to the 24th April, 1890, Provincial Courts had no jurisdiction relative to declaring a patent void for non-manufacture and unauthorized importation, the Minister of Agriculture or his Deputy having exclusive jurisdiction, the decision of either under the former state of the law being final.

In *Bell Telephone Co.* v. *The Telephone Manufacturing Co. and the Minister of Justice*, 7 Ont. Rep., p. 605, on a motion to prohibit the Minister of Justice from adjudicating as to the voiding of patent 7789, under sec. 28 of the Act of 1872, Osler, J., on November 21st, 1884, held that the Minister of Agriculture or his Deputy had been appointed a judicial tribunal, and cites the decision of Mr. Taché, the Deputy Minister of Agriculture, in *Barter* v. *Smith*, referred to with approval in the judgment of the Supreme Court, *Smith* v. *Goldie*, 9 Sup. C. R., p. 68, where Mr. Taché states: "The legislature has certainly not without intention provided for a kind of paternal tribunal formed by the Commissioner of Patents the natural protector of patentees, which intention can be no other that every case should be adjudicated on in a liberal manner."

And in the matter of the *Bell Telephone Co.*, 9 Ont. Rep., p. 339, on a writ of "*certiorari*" to bring up before the Court all proceedings before the Minister of Agriculture, and his decision on an application to declare a patent void, it was held by the Common Pleas Divisional Court (Ont.), on June 27th, 1885, that the Minister of Agriculture had jurisdiction under sec. 28 of the Act of 1872, and that he had "*ministerial*" and not "*judicial*" authority: following Henry, J., of the Supreme Court rather than Osler, J.

In an unreported decision of Spragge, C., in *Smith* v. *Goldie*, tried at Toronto, about 1881, the bill was dismissed on the ground of *importation* after twelve months after the date of the patent, this case was referred to in *Smith* v. *Goldie*, 7 App. Rep. (Ont.), p. 628; and also in *Smith* v. *Goldie*, 9 Sup. Ct. Rep. (Can.), 46, where Henry, J., says: "Spragge, C., decided the patent was void for importation and non-manufacture:" these cases were appeals from said decision of

Spragge, C.; this adverse decision of Sprague, C., was rendered, notwithstanding the same patent had been upheld on the question of "*non-manufacture*" and "*importation*" by Mr. J. C. Taché's judgment, before referred to, dated the 15th February, 1877. This last judgment in *Barter* v. *Smith*, which is one of our leading cases in Canada on the question of non-manufacture and importation, was strangely overlooked.

Act of 1891, c. 33, s. 1.

By 54, 55 Vic., cap. 33, sec. 1 (1891), the sub-section substituted by sec. 2 of 53 Vic., cap. 13, for sub-sec. 1 of sec. 37 of the Patent Act, cap. 61, Revised Statutes, Canada, was amended by striking out "and at the relation of any person interested," and substituting therefor the words "or at the suit of any person interested."

Act of 1892, c. 24, s. 6.

By 55, 56 Vic., cap. 24, sec. 6 (1892), sub-sec. 1 of sec. 37 of the Patent Act, cap. 61, Revised Statutes, as enacted by sec. 2, cap. 13, of the Act of 1890, and amended by sec. 1, cap. 33, of the Act of 1891 was repealed, and the present sub-section *one* was substituted.

The old sub-section 1 of section 37 of the said Patent Act, as it stood amended in 1891, was sub-divided into parts (*a*), (*b*) 2 and 3, (*a*) and (*b*) being the conditions on which the patent was granted. The new sub-divisions 2 and 3 of this sub-section 1, clash now with sub-divisions 2 and 3 of this section 37, and we have now a double set of 2 and 3 in this same section 37. The sub-divisions of sub-section 1 should have been all four lettered *a*, *b*, *c*, *d*, to avoid confusion.

In paragraph (*b*) of sub-section 1, the wording has been slightly altered from that in the Act of 1890, and the words "or patentees, or any of them," have been added after the word "patentee"; and it further reads, "and his or their representatives, or his or their assignee," the word "*legal*" having been dropped from before "*representatives*," and the words "*or their*" inserted twice.

New Sentence Added.

And the following words have for the first time been added at the end of paragraph (*b*): "Such patent shall be void as to the interest of the person or persons importing or causing to be imported as aforesaid."

In paragraph 2 of sub-section 1, the word "question" has been substituted for "difference," and the words "or any interest therein" has been added after "patent"; the words "null and" have been left out before "void"; "to decide any such question" has been placed immediately before "upon information in the name of the Attorney-General of Canada."

Paragraph 3 of sub-section 1 is the same as in the Act of 1890.

Having traced the wording of this important section from its inception in the Patent Act of 1869 down to the present time, we may shortly review some of the leading features of this section 37 as it now stands, before considering the cases already decided as to "non-manufacture" and "importation" by the Minister of Agriculture or his Deputy.

None of the principal foreign countries, except France, Tunis, Turkey and Peru, make restrictions as to the importation of patented articles. In these countries patented articles must not be imported except under special permit, which can be obtained for about $10.

France and Tunis now belong to the International Union, and citizens of the countries in this Union (*vide* note sub-section *d*, section 8) may import without restriction.

The Object of this Section.

The object of this section, which has been substantially in the same form since the Patent Act of 1869, was to protect and encourage home manufactures and Canadian labour and as stated by Deputy Minister Taché, "to guard against the danger of Canadian patents, granted to aliens, being made instrumental to secure the Canadian market in favour of foreign patents to the detriment of Canadian industry."

"The Patent Act of 1869, removing other disabilities, extended the right of obtaining patents to every resident of one year in Canada, and subjected all patented inventions to the condition of manufacturing within three years and of not importing after eighteen months, the decision of the question, as to whether or not a patent had lapsed for reason of non-compliance, was left to be pleaded and to the ordinary Courts to adjudicate. The law of 1872 extended the right of

obtaining patents to all-comers, and provided a special tribunal to apply the law, in the manner mentioned in the 28th section hereinbefore quoted": See *Barter* v. *Smith*, vol. 2, Exch. Ct. Rep. (Can.), p. 480.

Conditions on Which Patents are Issued

Every Canadian patent now issued, following the strict wording of the Act, should be expressed to be subject to the conditions as to "manufacture" and "importation" set out in paragraphs (*a*) and (*b*) of sub-section 1 of this section.

Formerly these conditions were printed on the face of the patent, and at one time the section of the Patent Act relating thereto was endorsed on the patent; these conditions have always remained the same, the only changes being with reference to the time within which manufacture was to take place or importation be allowed, and as to the time when application for extension should be made and the "*quantum*" of such extension.

Now, notwithstanding the express provision at the beginning of this section, all definite reference to the conditions as to manufacture and importation have been dropped out of the present form of Letters Patent. All that is now said is "provided that the grant hereby made is subject to the conditions contained in Acts aforesaid" (referring to the Patent Act, c. 61, Revised Statutes of Canada, and the Acts amending the same). Every person knows this without being told, but the intention originally was to call special attention to these conditions as to "*manufacture*" and "*importation*" on the patent itself.

It is enacted that "Every patent granted under this Act shall be subject, and be expressed to be subject, to the following conditions":—

"*And be expressed to be subject*," means that paragraphs (*a*) and (*b*) of sub-section 1 should be specifically referred to.

As to Provisions for Working, etc., in U. S. A. and United Kingdom.

In the United States there is no provision, such as we have, as to "*manufacture*" and "*importation*," but a patentee there has an "*exclusive*" interest in his patent; he is under no obligation to manufacture under it, nor utilize it in any way, nor even to license any party so to do.

In the United Kingdom, by sec. 22, Act of 1883, the patentee, if he does not work his patent, or supply the reasonable demands of the public, or if any one is prevented from working an invention of his own to the best advantage, may be subject to "*compulsory license.*" In most European countries, and elsewhere, there are strict provisions as to manufacture within time limited and as to importation, and the patent becomes forfeited on failure to observe these provisions.

Art or Process Excluded.

This section distinctly says "every patent granted under this Act shall be subject, etc., to the following conditions," but then paragraph (*a*) refers to "the construction or manufacture of the invention patented in such a manner that any person desiring to use it may obtain it, or cause it to be made for him, etc., at some manufactory for making or constructing it in Canada, etc."

This language seems clearly to exclude "*an art or process,*" and refers to "*a machine,*" "*a manufacture,*" or a "*composition of matter.*"

An "*art or process*" is defined in the note to sub-section (*c*) of section 2.

The definition of "*an invention*" is the same in Canada as in the United States; indeed we have adopted it from the U. S. Patent Statutes.

By sub-sec. (*c*) of sec. 2 of this Act "an invention" means "any new and useful art, machine, manufacture, or composition of matter, etc. See note to sub-sec. (*c*), sec. 2 of this Act, where the different classes of inventions are discussed and distinguished. See also section 7.

The intention may possibly have been to include every class of invention the subject of Letters Patent, including "a process"; but if this be so, why was it not so expressed. Now, notwithstanding the opening of the section, "a process" may be excluded from the operation of this section.

A "process" may be claimed to be excluded. This section was enacted to encourage home manufactures and Canadian labour, as we have shown. Now, a *process* is not a tangible property or an article which can be manufactured; it is merely a series of acts, and is outside the language of this section, and outside the reason of it, but a patented machine used in carrying out that process would come within the meaning of the section. If this be so, then the section should read "Every patent granted under this Act, *except one for a process*, shall be subject, etc."

With reference to conditions lettered (*a*) and (*b*) it may be said, that in the ten decisions, hereafter referred to, of the Minister of Agriculture or his Deputy, they have never been construed strictly. *Barter and Smith*, the first decision, 15th February, 1877, is still considered the leading authority, and it was approved of in 7 Ont. Rep., p. 605, as well as in *Smith* v. *Goldie*, 9 Sup. Ct. Rep.

Barter v. Smith.

In this case it was proved that none of the patented machines had been put up in Canada within the time prescribed, and that there had been some importation after the authorized period, yet the general conclusion arrived at was "that the respondent having refused no one the use of his inventions, and that the importation, assented to by him to be made being inconsiderable, having inflicted no injury on Canadian manufacturers, and having been so countenanced, not in defiance of the law, but evidently as a means to create a demand for the said inventions, which the patentee intended to manufacture, and did, in fact, offer to manufacture in Canada, he has not forfeited his patents": See *Barter* v. *Smith* (1877), vol. 2. Ex. Ct. R. (Can.), p. 494.

The Meaning of "Carry on in Canada the Construction or Manufacture."

In paragraphs (*a*) and (*b*) "the words *carry on in Canada the construction or manufacture* with their context cannot therefore mean anything else than that any citizen of the Dominion, whether residing in Prince Edward Island, in British Columbia, in Ontario, Quebec or elsewhere on Federal soil, has a right to exact from the patentee a license of using the invention patented, or obtain the article patented for its use at the expiration of the two years delay, on condition of applying to the owner for it, and on payment of a fair royalty. The words

imports or causes to be imported into Canada cannot mean anything else than injury to home labour, which injury, if actually done by or with the connivance of the patentee, must decidedly entail forfeiture of his patent": See *Barter* v. *Smith* (1877), vol. 2, Ex. Ct. R. (Can.), p. 484.

Construction or Manufacture Defined.

The Deputy Minister of Agriculture lays down as the meaning of "*construction or manufacture of the invention*" in paragraph (*a*) as follows:—

"In order to arrive at a correct interpretation of the words *construction or manufacture of the invention*, it is necessary to well understand and carefully consider the nature of the obligation thereby imposed.

"As to patents, it applies to *every patent granted;* as to subjects, it applies to every conceivable object which may be invented or improved; as to persons who have the right to exact it, it applies to all inhabitants of the Canadian Confederacy; as to extent of territory, it applies to the whole Dominion from Ocean to Ocean, and to every Province and locality therein; as to time, it applies to 13 out of 15 years of the longest patent and to 3 out of 5 years of the shortest.

"This simple enunciation of the nature of things to which the law refers, is sufficient to demonstrate that the law maker could not have had in contemplation to force, on penalty of forfeiture, the patentee to actually fabricate his invention with his own capital, within specific establishments, with his own tools, and to keep stock for every moment of the existence of his privilege; and where? All over the Dominion, and whether he has purchasers or not.

"The patent might be for a process, for an object to be used in conjunction with something else for an improvement on another patent still in existence; it might be for a railway bridge, switch or spike; it might be for a mail bag, and in all these cases it does lie within the powers of others than the patentee to say whether the invention shall or shall not be void at a given time or at any time:—

"Therefore the real meaning of the law is that the patentee must be ready either to furnish the article himself or to license the right of using, on reasonable terms, to any person desiring to use it. But again, that desire on the part of such a person, is not intended by the law to mean a mere operation or motion of the mind, or of the tongue; but in effect a *bonâ fide* serious and substantial proposal, the offer of a fair bargain accompanied with payment. As long as the patentee has been in a position to hear and acquiesce to such demand and has not refused such a fair bargain proposed to him, he has not forfeited his rights": See *Barter* v. *Smith* (1877), vol. 2, Ex. Ct. R. (Can.), pp. 482, 483.

"The offer of a fair bargain accompanied with payment," should read "*accompanied with an offer of payment*"; there can be no payment if the proposal is declined. The whole of this is based on the theory of a demand by the customer and a refusal by the patentee, in order to lay the foundation for a forfeiture.

Paragraph (*a*) refers to a single "patentee and his legal representatives or his assignee," while paragraph (*b*) refers to "the patentee or patentees, or any of them, or his or their representatives or his or their assignee." There may have been no necessity for the latter, as the Interpretation Act, R. S. C. (1886), sub-sec. 21, sec. 7, declares, "Words importing the singular number or the masculine gender only includes more persons, parties or things of the same kind than one, and females as well as males and the converse."

The two paragraphs ought, however, to be uniform, as the same class is referred to in both.

The construction or manufacture of the patented article is to be carried on in such a manner "that any person desiring to use it may obtain it, or cause it to be made for him at a reasonable price."

Exclusive Use.

The patentee then can only have an "*exclusive use*" of his own patented invention for two years from the date of his patent, or during any authorized extension of such time, except as to a process, as surmised.

If the patent be for a "product" to be made by a special process, and the patentee had patents on both the "process" and the "product" he might, it is conceived, have a monopoly in the sale of the patented product, provided he was able to supply the whole demand of the public, so that any person desiring to use it might obtain it.

If the patentee had a patent on the "product" and not on the "process," as was the case with the Goodyear rubber patent for vulcanized India-rubber, he might still have a monopoly of the sale, provided no one were able to evade his patent on the product.

In any event, it is conceived, there may be a monopoly in a "process," and the patentee may have an "exclusive" right.

The causing it to be made for him must refer to a making with the assent of the patentee, after a "*reasonable price*" has been agreed on. Otherwise the causing it to be made without authority would be an infringement.

A Reasonable Price.

Then the question arises, what constitutes a "*reasonable price*," and who is to be the arbiter in determining it.

The "*reasonable price*" must vary according to each particular class of invention; a patented machine of a complicated nature, such as "*an envelope making machine*," may be capable of supplying a very large demand, and may have been the result of years of patient toil, experiment and thought, and the result of a very large expenditure of money; while another machine may have been the result of a sudden thought, be simple in its nature, and the cause of little expenditure of time or money, and be capable of supplying a small demand comparatively, while in both cases the demand may yet be "*in embryo*," and it may turn out that the simpler and less expensive device, may eventually give birth to a vastly greater demand than the more meritorious and expensive machine, and therefore be more profitable. As the aim in both instances is the making of money, and the supply of a public demand or want, what rule is to be laid down when the possibilities of making money, or the demand, are not yet ascertained? The relative cost of construction of the two devices can form no criterion, for the royalty can be in no way based upon such cost, for it can bear no ratio thereto. The question is a very difficult and complicated one to answer, and the answer to it, in the absence of any well established license fee, which the patentee has hitherto been willing to take and the public to pay, must necessarily be of an empirical or arbitrary nature.

No stated rules have been laid down, but evidence of established royalties on cognate devices, if any there be, may afford some but inadequate assistance.

A patentee may be entitled to raise the amount of a royalty which he has previously been in the habit of accepting; it may have been an inadequate sum, and he is not always bound always to accept such sum; so a license fee may not be always a guide.

How is the "*reasonable price*" to be determined if the patentee and proposed customer differ in their views; the patentee who foresees, or thinks he foresees, the eventual possibilities of his device may put an altogether fabulous value on his own machine, particularly if he wants to secure a monopoly of the use of his machine, if, for instance, he can supply the market with envelopes

at a rate so much less than any other machine in the market, and thinks he can develop a trade; while the proposed customer, who may, in some measure, realize some of the advantages, but may not give them their proper value, would be pretty sure to go on the opposite tack and minimize everything

After great expense, enterprise and a lapse of years, and the luxury of some law suits, a patentee may have succeeded in establishing a market and price for his patented invention; how is the royalty to be estimated when rival manufacturers are desirous to step in and reap where he has sown, and in some cases to cut rates with some specific object in view? The system in the States where no conditions whatever are imposed, commends itself to one's reason; the assumed danger of the importation of foreign patented articles, to the detriment of Canadian manufacturers should not have much weight. "Compulsory licenses," as in England, which were approved by the representatives at the Vienna Congress by a large majority, are preferable and more just than the Canadian system, although "compulsory licenses" in the United Kingdom are not a success; the custom duties alone should be a sufficient protection. This provision as to manufacture in Canada might very well be dispensed with.

Compulsory Licenses in the United Kingdom.

In the United Kingdom by sec. 22, of the Act of 1883, if (*a*) a patentee does not work his device, or (*b*) does not supply the reasonable requirements of the public, or (*c*) if any person requires the use of the invention in order that he may work an invention of which he is possessed to the best advantage; if any of these three be proved to the Board of Trade, on the petition of any person interested, the Board may order the patentee to grant licenses, on such terms as to the amount of royalties, security for payment or otherwise, as the Board, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by "*mandamus*."

This section 22 has practically been inoperative, and few applications have been made to the Board of Trade, and no order

has been made in any case for a compulsory license. Up to end of 1887 there had only been one informal application, which was withdrawn. In 1888 there was one application.

It may be, however, that these provisions induce patentees to grant licenses rather than appear before the Board: See Edmunds on Patents, p. 462.

Determining as to the Reasonable Price.

In the United Kingdom, then the Board of Trade may fix on "*the reasonable price*," and there is no appeal from the decision of the Board; but in Canada nothing is said about this matter, so it may be inferred by some that if a person desires to bring the matter to a decision he must make the patentee a pecuniary offering in writing, and on the patentee refusing to accept the offer the party may then institute proceedings in Court, setting out the facts of the case and of the offer and refusal, and pay the money so tendered by him to the patentee into Court, and the Court may then be in a position to determine whether the offer is a reasonable one and should or should not be accepted, and what is "*the reasonable price*" to be paid, making the costs depend on the result; but then we are met with this difficulty, the tribunal under this section is not to be asked to determine what is the "*reasonable price*," but to determine whether or not the patent is to be declared null and void for breach of conditions. This "*reasonable price*" is one of the conditions precedent, so it would appear that a person making a definite offer and meeting with a refusal may ask the Court to annul the patent, which the Court may do if the Court considered that there had been an offer and a refusal of "a reasonable price," which reasonable price it has been found impossible to determine by the parties themselves. This does seem harsh and arbitrary, for a Canadian patent may be voided for an alleged breach of a condition which has never been determined and which may never have been capable of determination. The compulsory license and the fixing of an amount to be paid by an independent tribunal, as in England, seems more equitable.

The English provision, however, is still imperfect and appar-

ently inoperative, but is better than ours, the interests of the public appear to be more regarded than those of a private rival manufacturer, who may desire to use the invention for his own private gain.

What may be "*the reasonable requirements of the public*," which the patentee in England must supply, appears very indefinite. Do rival manufacturers constitute the public?

If it be a machine which is to be supplied; the public are more interested in the product of a machine than in the machine itself, and if the patentee, by enlarging his establishments, can supply the whole demand for the product of his patented article, why should he not be entitled to do so? The interests of home manufacture would be quite as well protected.

The true reason for this section may not be the protection of Canadian industries, as suggested in *Barber* v. *Smith* by Mr. Taché, but the lowering of the prices of commodities in the public interests, by inducing competition and cutting rates, the patentee having all the time the advantage of the royalties which he receives.

And this view appears to have suggested itself to Sir John Thompson in *The Royal Electric Co.* v. *The Edison Electric Light Co.* on the question of selling the patented invention "*at a reasonable price*," who says: "Probably the evil which that part of the statute was principally intended to prevent, was the exaction of exorbitant prices under the monopoly secured by the patent": See vol. 2, Exch. Ct. Rep. (Can.), vol. 2, pp. 608, 609.

Mr. Taché, in *Barter* v. *Smith*, does not consider the question of "*a reasonable price*" as one coming under the jurisdiction of the Minister of Agriculture or his Deputy, for he refers to sec. 21 of the Patent Act of 1872 (now section 44 of the Patent Act), as setting up "a special and exceptional mode of settling upon the price to be paid to the patentee" by the Government of Canada, viz., by the report of the Commissioner of Patents as to what may be a reasonable compensation for the use thereof: See *Barter* v. *Smith*, vol. 2, Exch. Ct. Rep. (Can.), p. 483.

The Court to Fix the Amount.

If it were the intention that the Courts should determine what is "*a reasonable price*," there could then be no ground for an-

nulling a patent because the patentee refused to accept an undetermined amount, so we are on the horns of a dilemma, which has not yet been solved, and the logical conclusion is that the Courts should be specially required to fix on the amount of the royalty, and to compel the patentee to grant a license on the receipt of such amount, as is the case in the United Kingdom ; but it would be better if the whole provision as to *manufacture* were wiped out as is the case in the U. S. A.

The addition of the words "at some manufactory or establishment for making or constructing it in Canada," would lead one to suppose that the obtaining of a patent involves the necessity of supplying one's self with the burden of a manufactory or establishment in Canada to make or construct the patented article within a couple of years or so of the date of the patent, whether the article be demanded or not, and before the patentee had time to create a market, unless the "*authorized extension*" of such time be taken as providing for this, as to which see note to sub-section 2. It must be borne in mind that by a strict interpretation of this section one must "commence, and after such commencement continuously carry on the construction or manufacture, etc.," there is to be no let up to it, whether the article is wanted or not, on pain of voidance of the patent, which is one of the absurdities of this section. The only way is to do as Mr. Taché did in *Barter* v. *Smith*, and substitute a totally different set of words as the meaning of the present agglomeration.

Barter and Smith establishes the fact that "it is not incumbent on a patentee to show that he has made active efforts to create a market for his patented invention in Canada; but it rests upon those who seek to defeat the patent to show that he neglected or refused to sell the invention for a 'reasonable price' when application was made to him therefor." See headnote 2, vol. 2, Ex. Ct. R. (Can.), p. 455.

Meaning of Sale for a Reasonable Price Modified.

But as to this in *The Royal Electric Light Co. of Canada, and* the *Edison Electric Light Co.*, decided by the Honourable John Carling on the 25th November, 1889, on the report of the Honourable Sir John Thompson, Minister of Justice, being the last decided case, the question of "*a sale for a reasonable price*," has been somewhat modified; for it was there decided that, "Where

the article patented is of delicate and skilful manufacture, and one from which the patentee can only reap the reward of his labour and expenditure through its being esteemed successful by the public, it is reasonable for him, at a time when public opinion in respect of it is in suspense, to decline to sell his invention unconditionally to those who, by unsuitable use, would fail to derive benefit from it themselves, and would create an impression in the public mind that the invention was a failure. If, upon application made to him, for the purchase of his invention, he imposes a limitation in respect to its use, he ought not to be held thereby to have forfeited his patent, unless it appear that such limitation was imposed for the purpose of evading compliance with the provisions of the statute, which require him to sell the patented invention at a reasonable price": See headnote, vol. 2, Ex. Ct. R. (Can.), p. 577.

Importation.

As to the interpretation to be placed on paragraph (*b*) *re* importation into Canada beyond the time authorized, it was held in *Barter and Smith* (1877), vol. 2, Ex. Ct. R. (Can.), p. 455, notwithstanding some unauthorized importation, that "the intention of the legislature in enacting the provisions of section 28, 35 Vic., ch. 26, which prohibit the patentee from importing his invention in a manufactured state after the expiry of a given time from the granting of his patent, was to protect the industrial interests of Canada, and the prohibition should not be extended to operate a forfeiture in cases where the character and circumstances of the importation tend to promote rather than prejudice such interests": See headnote 3.

And in the same case "If after the time has expired wherein the patentee may have imported the invention without prejudice to his rights, he consents to the importation by others, such importation brings him within the prohibition of the statute and avoids his patent": See headnote 4.

And in *The Toronto Telephone Manufacturing Co. and The Bell Telephone Co. of Canada* (1885), see headnote 2, vol. 2, Ex. Ct. R., p. 495, it was held that "The importation of the component parts of a telephone, in such a state of manufacture as simply to require putting together in Canada to make the completed instrument, falls within the prohibition of section 28 of 35 Vic., ch. 26, as amended by 38 Vic., ch. 14, sec. 2;" this view has been modified, or at least has not been followed in *The Royal Electric Co. and The Edison Electric Light Co.* (1889): See case No. 10 hereafter set out in this Part XI.

"Connivance by the patentee in an improper importation is equal to importing, or causing to be imported, within the meaning of the statute": See headnote 4, *Toronto Telephone Manufacturing Co. and The Bell Telephone Co.*, vol. 2., Ex. Ct. R. (Can.), p. 495.

In *Mitchell and the Hancock Inspirator Co.* (1886): "When the subject of a patent is a new combination of old devices, the patentee cannot import such devices in a manufactured state, and simply apply his combination to them in Canada, without violating the prohibition against importation contained in sec. 28 of the Patent Act of 1872": See headnote 2, vol. 2, Ex. Ct. R. (Can.), p. 539.

As to this, Sir John Thompson, in *The Royal Electric Co. of Canada* v. *The Edison Electric Light Co.* (1889), expressed this view:—

"The elements in that case were themselves machines, and the Deputy Minister seems to have entertained the view that the patentee was bound to manufacture the machines in Canada, although his patent was only for a combination of those machines."

"While I do not think the case to be one in point, or one from which any inference can be drawn to affect this case, unless it be an inference from the fact that a very severe view was taken, at that time, by the Deputy Minister of Agriculture, of the requirement in the patent law as to the manufacture in Canada, I must add, as respects that inference, that, if the case were admitted to be one in point, I should have very great difficulty indeed in advising you that the Hancock Inspirator case was correctly decided, or that it should be followed": See vol. 2, Ex. Ct. R. (Can.), p. 611.

Views on "Importation" and "Manufacture" Modified.

In *The Royal Electric Co.* v. *The Edison Electric Light Co.* (1889), just referred, the views on the question of "*importation*" and "*manufacture*" were much modified, explained and broadened in the interest of the patentee, the intention being to treat him, as to the conditions imposed by the Act, with the utmost liberality possible, and as this is the latest case, wherein the previous cases had been reviewed, and the judgment emanated from the Minister of Justice, it may be taken as a standard case of the highest authority and governing, on the question of "*manufacture*" and "*importation*," where it is applicable.

It was held by the Minister of Justice in this case "That if an article imported by a patentee and used by him in the construction of his invention is a common commercial article, employed for many purposes, and is not specified in the patentees' claim as an essential part of his invention, such importation does not operate a forfeiture of the patent": Headnote 1, *S. C.*

Test as to Right to Import.

And it was also held that "A fair test of the patentee's ability to freely import any article required in the construction of his invention, is to ascertain if it is open to every person in Canada to manufacture, import, sell and use the same without thereby infringing the patent in question. If the article is thus part of the public domain, the patentee is at liberty to import it or to purchase it in Canada for the purpose of such construction": Headnote 2, *S. C.*

And as defining the meaning of the words "The invention for which the patent is granted," it was held that "There is no express provision in the statute imposing the penalty of forfeiture for importing into Canada the various parts of the invention in respect of which the patent was granted, much less for importing one of its parts. The words of the statute are 'the invention for which the patent is granted,' and they ought not to be extended beyond their plain meaning. In administering the statute the minister can only apply the penalty to the offence which the statute forbids. He cannot apply it to an attempt to evade the statute": Headnote 4. See vol. 2, Ex. Ct. R. (Can.), pp. 576-577, *S. C.*

As to Unauthorized Importation.

The new words added "such patent shall be void as to the interest of the person or persons importing or causing to be imported as aforesaid," is a proper amendment. We have seen that one of the several joint owners of a patent, whether the joint interest be acquired by assignment or by joint invention, may deal with the patented invention as he chooses, without liability to account to the other joint owners. So it is only equitable that the other owners, who have had nothing to do with the breach of condition, should not suffer thereby.

As to sub-sections 2 and 3 referring to the jurisdiction of the Provincial Courts, and of the Exchequer Court of Canada, it may be assumed in view of the principles laid down in *Barter* v. *Smith*, that questions relating to "non-manufacture" and "importation" will be treated in a "*paternal manner*," and not after the strict letter of the law; for if the strict letter of the law were insisted on, it may be seen that but few if any patents would be sustainable, when a question of non-manufacture or importation arises.

Principles Which Should Govern.

As to the principles which should govern a tribunal in determining as to the meaning and intent of this section, Mr. Taché in

Barter v. *Smith*, vol. 2, Ex. Ct. R. (Can.), p. 481, lays down "The duty of this tribunal is, therefore, on one hand, after having satisfied itself of the facts, to apply the remedy if the mischiefs provided against by the Statute have been really committed in intent or effect; and, on the other hand, to guard against the cruel injustice of inflicting such a punishment as the total destruction of an acquired and vested right, when no real damage was either intended or done. The common principle of justice which says that when there is no injury inflicted no damages are to be granted, and that when no offence has been committed no penalty is to be imposed, must govern the matter as well as the principle that no offender should be sheltered from the punishment for offence or injury perpetrated by him."

Burden of Proof Not on Patentee.

And as affecting procedure it is also laid down in *Barter* v. *Smith*, *supra*, p. 476: "It is apparent that this case, being one in which the disputant urges the forfeiture of an acquired right which the respondent is presumed not to have lost nor alienated, the burden of proof cannot be admitted to lie on him who holds a public title which must be taken as good so long as nothing to the contrary is established, even if the evidence involved the proof of a negative. In this case the evidence does not rest on establishing a negative but on ascertaining the existence of positive facts."

And again in *Barter* v. *Smith*, *supra*, p. 480-481: "So far, the intention of the legislature, as shown by the history of the legislation, is evidently to guard against the danger of Canadian patents, granted to aliens, being made instrumental to secure the Canadian market in favour of foreign patents to the detriment of Canadian industry; for, in the measure that the right of taking patents was extended, the remedy against the dreaded danger was made more ample, but at the same time the jurisdiction over such cases of disputes as might arise was transferred from the judicial tribunals to the administrative tribunals, evidently for the purpose of avoiding an overstrict application of the provision made against the possible evil of a patent being taken for the sole purpose of depriving Canada from the use of a useful invention. The 28th section is also intended as a sort of protective policy in favour of Canadian labour. The Legislature has, certainly not without intention, provided for a kind of paternal tribunal, formed by the Commissioner of Patents, the natural protector of patentees, which intention can be no other than that every case should be adjudicated upon in a liberal manner."

It is to be hoped this section 37 will receive the same liberal interpretation in the Courts that it did before the Minister of Agriculture and his Deputy, otherwise, as the section is now worded, few patents will stand the test.

The judgment in *Barter* v. *Smith*, as we have shown, has been endorsed in the Ontario Courts, as well as in the Supreme Court (Canada) in *Smith* v. *Goldie*, 9 Sup. Ct. R., 46. At p. 69 of

the Supreme Court Report Henry, J., states, referring to Mr. Taché's judgment in *Barter* v. *Smith*: "I concur fully in his conclusions as I do in his reasons."

In the United States there was for a few years an obligation cast on aliens by the Patent Act of July, 1832, to introduce into public use the patented invention within one year from the date of the patent, otherwise it should become absolutely void, without resort to legal process; or in case the same, for any period of six months after such introduction, shall not continue to be publicly used in the United States. This Act was repealed by the U. S. Patent Act of 1836.

Mr. Taché states: By the 15th section of the Act of 1836, the defendant in an action of damages, was permitted to plead the general issue: at the end of the enumeration of defects, we read:—"..... or that the patentee, if an alien at the time the patent was granted, has failed and neglected, for the space of eighteen months from the date of the patent, to put and continue on sale to the public, on reasonable terms, the invention or discovery for which the patent issued; in either of which cases, judgment shall be rendered for the defendant with costs."

The provisions of this clause were invoked in one case of an assigned alien's rights: *Tatham* v. *Lowber*, Blatch., C. C., vol. 2, pp. 49-51. Messrs. Justices Nelson and Betts, State of New York, decided:—

"That even if the plaintiffs took their right with the condition attached to alien patentees, yet they had satisfied the statute: that they need not prove that they hawked the patented improvement to obtain a market for it, or that they endeavoured to sell it to any person; but that it rested upon those who sought to defeat the patent to prove that the plaintiffs neglected or refused to sell the patented invention for reasonable prices when application was made to them to purchase."

See *Barter* v. *Smith*, vol. 2. Ex. Ct. R. (Can.), p. 487.

This is the nearest approach to similar legislation in the States, and the onus was cast on the party seeking to defeat the patent, and an interpretation very liberal to the patentee was given.

The refusal of a patentee in U. S. A. to furnish his device when requested does not justify the use of an infringing article: *Masseth* v. *Reiber* (January 15th, 1894), 67 O. G., p. 143.

The new jurisdiction of the Exchequer Court and of the other Courts, established by the Act of 1890, and the removal of the jurisdiction from the Minister of Agriculture or his Deputy, together with the right of appeal have already been alluded to in tracing the history of this section.

Two Modes of Procedure Now.

By the Act of 1891 the change of and "at the relation of" into "or at the suit of" has given two different modes of procedure; either by information in the name of the Attorney-General of Canada, or by an ordinary suit "of any person interested," the latter may be taken to mean, any person among the public not under disabilities.

As the Act of 1890 provided for "an information in the name of the Attorney-General of Canada, and at the relation of any person interested" when proceedings were taken in the Exchequer Court of Canada, the proceedings were cumbrous and formal. Before the Attorney-General of Canada signed the information it was then necessary that there should be a certificate from counsel, that the information tendered was a true copy of the draft as settled.

A certificate from the solicitor of the relators, with an undertaking as to costs, etc., and a certificate of a notary as to a sworn statement by the solicitor of the relators to the statement of facts, etc., in the information.

By the Act of 1891, "and at the relation of any person interested" was struck out and "or at the suit of any person interested" substituted.

This appears to leave the procedure as now set out in Rules 4, 5 and 6 of the Exchequer Court, the information being according to the Form Schedule A, and to be signed by the Attorney-General of Canada, or some person duly authorized to affix his signature.

Instead of these proceedings in the name of the Attorney-General an ordinary suit between plaintiff and defendant may now, it appears, be instituted either in the Exchequer Court or any of the Provincial Courts, and this form of procedure will, doubtless, be adopted, though the practice is not yet settled in any way.

The proceeding by information in the name of the Attorney-General appears to be confined to the Exchequer Court, Canada, the ordinary form of procedure in the Provincial Courts appears to be applicable.

Paragraph 8, Sub-Section 1, Section 37.

This paragraph, as to jurisdiction of courts other than that of the Exchequer Court, dates from the 24th April, 1890, when 53

Vic., c. 13, came into force, and when the jurisdiction of the Minister of Agriculture or his Deputy was taken away. The Provincial Courts, now, inferentially have jurisdiction on questions of "*non-manufacture*" or "*importation*"; this jurisdiction may better have been conferred directly, in the manner that section 30 confers jurisdiction on the Provincial Courts in infringement suits, or as section 34 expressly empowers Provincial and Territorial Courts to deal with the impeachment of Letters Patent.

Since the special tribunal of the Minister or his Deputy was done away with, "*non-manufacture*" or unauthorized "*importation*" may be grounds for "*sci. fa.*" proceedings in the Provincial Courts to void a patent under section 34.

Difficulties of Provincial Courts Dealing with Questions Under Section 37.

Should Provincial Courts undertake to deal with the question of "*non-manufacture*" or "*importation*," there is nothing to give effect to their decrees beyond the province or territory in which proceedings were instituted. Section 35, whereby the recording of certificates of Decrees in Provincial Courts, etc., has the effect of rendering a Dominion patent void, has only relation to "*sci. fa.*" proceedings, and not to an ordinary suit. Then again, what right, for instance, would an Ontario Court have to interfere in the matter of unauthorized importation in British Columbia.

This paragraph 3, of sub-section 1, appears inoperative as to Provincial Courts; one would be forced to proceed in the Exchequer Court, Canada, to void a patent for the Dominion. "*Non-manufacture*" and "*importation*" may be good as a defence in an infringement suit, and will doubtless be pleaded in Provincial Courts.

If Courts, other than the Exchequer Court, have not now jurisdiction to void a Dominion patent for breach of condition as to manufacture and importation, how can the conferring of jurisdiction on the Exchequer Court, Canada, to do so, affect a jurisdiction which the other Courts do not possess: See paragraph 3, section 37.

As to Extension of Time to Manufacture.

Sub-sec. 2. Whereby the term within which manufacture is to take place, may be extended beyond the two years from the date of the patent, is defective, in that it does not provide for more than one extension, and does not in any wise limit the length of such extension; so that now, at any time within three months before the expiration of the two years, the Commissioner of Patents may, on proof to his satisfaction, of the impossibility of manufacture by the patentee extend the period for sixteen years, until the final expiry of the patent; and it is also evident that the Commissioner having made one extension, if it be only for three months, may be considered "*functus officio*" and may be unable to grant a second extension for any reason whatever; this would appear to be the case according to the wording of the Act, but the practice has been otherwise and the Commissioner of Patents has been in the habit of making a series of extensions, of one year each, as to manufacture, so that sometimes five or six extensions or more may be endorsed on the patent.

As to the first eventuality, which appears clear, Mr. Taché in *Barter* v. *Smith*, states:

"The effect of the delay of two years and the effect of any further extension thereof means, that during that time the patentee is permitted to withdraw entirely (the Government excepted) the use of his invention from the Canadian public, that he can refuse the use of it to all and everyone, under any and every circumstance. It follows that the granting of a long delay would amount to depriving, during such time, Canadian industry of the use of such invention, which could not be imported and which the inventor would not be bound to furnish on any condition. As it is logically necessary to carry the argument to the extent that there are many cases in which the difficulty being of all times, the delay, of necessity, should be carried to the whole duration of the patent, it amounts to saying that the Commissioner of Patents is empowered to grant, and in fact forced to grant, that Canada should remain for a long period of time, or the whole period of the duration of patents, *quoad* the utility of certain inventions, in a state of industrial inferiority as compared with all other countries: See vol. 2, Ex. Ct. R. (Can.), pp. 485–6.

Mr. Taché, in *Barter* v. *Smith*, *supra*, pp. 492–3, says the "extension can of course be granted by the commissioner only as a continuation (without interruption) of the respite of which it is the mere prolongation. When the statutory delay has expired, a patent is either voided or in operation, according to the spirit of the law, and no other proceeding, on the point in question, can intervene, unless a dispute is raised."

Only one Extension for Time to Import.

By sub-sec. 3, sec. 37, the Commissioner is empowered to grant an extension of time to import "to the patentee or to his legal representative or assignee." By the Interpretation Act this extends to plural patentees, etc., expressly mentioned under paragraph (*b*), section 37, *ante*; but, having granted one extension for a period not exceeding twelve months, he can grant no more.

Surplusage.

The words "or any extension thereof" at the end of the paragraph are evidently a surplusage, and should be struck out, for they may be taken to mean that a second extension might be obtained to run into the third year, which is not the case, the beginning part of this sub-section being express as to one extension only.

It is to be inferred, however, that if there be several joint owners of a patent, that an extension of time granted to one of them, either as to manufacture or importation, will not inure for the benefit of the other co-owners, but that each owner must make application or join with the other owners in an application for an extension of time in order to save his own interest in the patent.

No Provision as to Extension when There are Plurality of Owners.

The section as originally drawn only contemplated a single interest in a patent, whereas the new sub-section (*b*), introduced in 1892, contemplates the very possible contingency of a plurality of interests. Provision should be made in this section as to application for extension of time to manufacture or import in the event of a plurality of owners, each of whom may be dealing independently with the patented invention, as we have seen he is entitled to do.

I.

Barter v. Smith, 15th February, 1877.

In the first case tried, *Barter* v. *Smith*, decided by the Deputy Minister of Agriculture, Mr. Taché, 15th February, 1877: See Appendix No. 2, vol. 2, Ex. Ct. R., p. 455; one of the three patents in dispute, No. 2409, was for a "*process of milling*" and

he adjudicated with respect to it, and declared that it, as well as two others, Nos. 2257 and 2258 for the flour-dressing machines, had not become null and void. We have already discussed whether a *process patent* came within the operation of this section and gave reasons for supposing that it did not. As to this process patent, Mr. Taché states in his judgment in *Barter* v. *Smith*, *supra*, p. 491: "The disputant, aiming at the process of milling patented under No. 2409, has tried to connect patent No. 2257 with patent No. 2409, as being necessarily dependent on each other in the way of cause and effect, or rather object and means, but has failed in that, and, by his evidence, has in fact, proved the contrary of his proposition, in establishing that Smith's process does not require any special plant or machinery; but can be added to any mill by ordinary tools and workmanship, and with ordinary materials, which is, besides, made plain by a careful study of the patents." This is hardly correct, for a "process is a mode or method of operation, or an act or series of acts performed upon the subject matter to be transformed and reduced to a different state or thing." So you can hardly say, as here, that this process "can be added to any mill by ordinary tools," although it may be necessary to utilize a machine for the purpose of carrying out the process.

The evidence in this case was altogether documentary and by affidavit.

We have already given the findings in this case, the leading features being:

As to Non-manufacture Not Creating Forfeiture.

That although a patentee may not have commenced to manufacture the patented article within the period limited, yet so long as he is in a position either to furnish it or to license its use at a reasonable price to any person desiring to use it, his patent ought not to be declared forfeited.

Importation Not Creating Forfeiture.

And as to "*importation*" it was also found that the provisions which prohibit the patentee from importing his invention in a manufactured state, after the expiry of a given time from the granting of his patent was to protect the industrial interests of Canada, and the prohibition should not be extended to operate a forfeiture in cases where the character and circumstances of the importation tend to promote rather than prejudice such interests.

Mr. Taché states in *Barter* v. *Smith* "As to importation, it is proved that the machines imported at Thorold by Messieurs. Howland and Spink, more than twelve months after the date of the patent, are of Smith's invention No. 2257; that Smith was neither the consignor, nor the consignee, nor the owner thereof; that he did not actually import them but that he consented to the importation, which action amounts to causing them to be imported. It is clear that Smith's consent in this instance was not intended to defy the law, that it did not cause any appreciable injury to Canadian industry, but had for its object to bring the merits of his patents and process before the Canadian public, with the honest intention of manufacturing in Canada as his efforts to introduce his process in Lawson's mill proves." See vol. 2, Ex. Ct. R. (Can.), p. 491. So that although here there was an actual case of unauthorized importation, admitted to be the case, nevertheless it was declared that the patent was not forfeited.

Chancellor Spragge, in *Smith* v. *Goldie*, tried about 1881, declared this same patent, upheld here in *Barter* v. *Smith*, to be void on account of this unauthorized importation; this judgment was finally reversed in *Smith* v. *Goldie*, 9 Sup. Ct. R., p. 46, where Mr. Taché's decision in *Barter and Smith*, was endorsed and approved of; Chancellor Spragge had in some way overlooked, apparently, the prior judgment in *Barter* v. *Smith* (1877).

The provision as to "*importation*" has been further extended by the decision in *The Royal Electric Co., of Canada, and The Edison Electric Light Co.*, No. 10, hereafter referred to.

Importation of Parts to be Put Together.

As showing the difference between an answer to a letter put in the abstract relative to "construction" and "importation," and the decision of a case presented with all its bearings and particulars, the following letter and answer from the Patent Office is referred to in *Barter* v. *Smith*, vol. 2, Ex. Ct. R. (Can.), pp. 493–4:

The letter written contained the following question:—"Is it considered as '*construction*' sufficient to hold the patent, if an article composed of various parts is *imported* in *parts* and put together and constructed in a Canadian manufactory?"

The letter in answer was as follows:—"You ask if the manufacturing clause of the Patent Act would be complied with by importing the whole of the parts of a machinery to be only put together in Canada? Evidently this would not be in compliance with the requirements of the law."

To such an interrogation no other than an answer based on the supposition of a breach of the law could be safely given. But if, departing from the abstraction

of the above given question, the investigation were made as regards a certain patent, under specific circumstances, the conclusion might be widely different from the general answer. In fact, it is not difficult to imagine a case in which the importation of all and every one of the component parts of an invention, to be simply put together in Canada, would not be an *importation* in the meaning of section 28 of the Patent Act, but, on the contrary, would be the only means of obeying the statute as to manufacturing, and therefore to all intents and purposes, in full compliance with the spirit of the law and the nature of the contract: such would be, for example, the case of a patent granted for a *composition* of *matter*, all the ingredients of which would be products not to be found in the country; a compound of exotic gums and extracts, for instance, or a medicine composed of portions of tropical plants.

This is sufficient to illustrate the difference of cases, every one of which must stand on its own merits, viewed in the light of the facts confronted with the spirit of the law.

This question comes up again *directly* in the next decided case. II. *The Toronto Telephone Manufacturing Co.* v. *The Bell Telephone Co.*, and again in X. *The Royal Electric Co.* v. *Edison Electric Light Co.*, in which cases there were diverse answers.

The Finding, see S. C., p. 494.

"The conclusion is, that the respondent having refused no one the use of his inventions, and that the importation, assented to by him to be made, being inconsiderable, having inflicted no injury on Canadian manufactures and having been so countenanced, not in defiance of the law, but evidently as a means to create a demand for the said inventions, which the patentee intended to manufacture and did, in fact, offer to manufacture in Canada, he has not forfeited his patents."

This case of *Barter* v. *Smith* is a standard case of much importance, and an authority which may guide future decisions, so long as this section 37 retains its present shape; copious extracts have therefore been made therefrom.

II.

The Toronto Telephone Manufacturing Co. v. The Bell Telephone Co., of Canada, 24th January, 1885.

The next case which came up was *The Toronto Telephone Manufacturing Co.* v. *The Bell Telephone Co., of Canada*, decided by the Hon. J. H. Pope, Minister of Agriculture, 24th January, 1885, nearly eight years after *Barter and Smith.* Reported in vol. 2, Ex. Ct. R. (Can.), p. 495, and 8 L. N. 34 (1885).

It was a dispute raised as to the existence of Patent No. 7789, granted 22nd August, 1877, to Alexander Graham Bell, now

owned by the Bell Telephone Company, of Canada, for alleged forfeiture on the ground of non-manufacture and of importation.

This case was the cause of considerable litigation in the Ontario Courts.

In 7 Ont. R., p. 605, it was sought to prohibit the Minister of Agriculture from adjudicating on this case. Osler, J., (November 21st, 1884), found this section, as then constituted, conferring exclusive jurisdiction on the Minister or his Deputy, not "*ultra vires*," it being claimed that a Dominion Court had been created for adjudication on property and civil rights in the Province of Ontario contrary to the provisions of the British North America Act.

And again in 9 Ont. R., p. 339, before the Common Pleas Divisional Court, June 27th, 1885, on a motion for a "*writ of certiorari*" to bring up all proceedings before the Minister of Agriculture, and his decision in this case of the 24th January, 1885, declaring this Patent 7789, void, it was held that the Minister of Agriculture had jurisdiction as to the question whether a patent had become void for non-compliance with conditions as to manufacture and importation.

The parties appeared before the Minister of Agriculture by their counsel, on the 20th October, 1884. It was endeavoured to adjourn the case until new legislation could be obtained giving the Minister power to summon witnesses and to administer oaths to them. This not being granted, the intention was intimated of applying for the "*writ of prohibition*" just referred to. This writ was refused before the resumption of the case on the 24th November. There was an enormous mass of documentary evidence adduced, as well as an oral examination of witnesses taken.

These points are now, however, immaterial, as the jurisdiction of the Minister of Agriculture and his Deputy has been taken away, as already mentioned, in 1890, by 53 Vic., c. 13.

Finding as to Importation of Parts.

It was held that "The importation of the component parts of a telephone in such a state of manufacture as simply to require putting together in Canada to make the completed instrument falls within the prohibition of the section": See vol. 2, Ex. Ct. R. (Can.), p. 496.

This finding has been subject to such modification as to be practically reversed (if that were possible), in *The Royal Electric Co. of Canada* v. *The Edison Electric Light Co.*, decided on November 25th, 1889, No. X., *infra*.

The same line of reasoning or test adopted by Sir John Thompson in that case would be equally applicable in this; any of the component parts alleged and proved to have been imported in the manufactured state, could have been made in Canada by any person who wished to do so, without infringing the patent.

As Sir John Thompson puts it in *Royal Electric Co.* v. *The Edison Electric Co.*: See No. X., reported in full, p. 589, vol. 2, Ex. Ct. R. (Can.).

"It does not seem reasonable that a person who has been placed expressly under the protection of the Patent Law, as a reward for inventive genius, and for expenditure of labour and capital in devising a patented article, should be subjected to enormous penalties for doing what everybody else may do, and I do not think that such would be a correct construction of the law."

Importation of the Invention is Prohibited, not the Parts.

Besides, that which is prohibited is the importation into Canada of "the invention for which the patent is granted," *i.e.*, the combination, and not one or more of the component parts separately.

Dr. Taché in *Barter* v. *Smith*, pp. 493–4, vol. 2, Ex. Ct. R., also remarks: "In fact, it is not difficult to imagine a case in which the importation of all and every one of the component parts of an invention, to be simply put together in Canada, would not be an *importation* in the meaning of section 28 of the Patent Act, but, on the contrary, would be the only means of obeying the statute as to manufacturing, and therefore to all intents and purposes, in full compliance with the spirit of the law and the nature of the contract."

The finding, therefore, of the Hon. J. H. Pope, in this case, is open then to serious doubt on this question of the importation of parts to be put together in Canada, and may be said to be overruled.

It was held that raw material does not fall under the application of this section. Among other things, however, rubber handles in a manufactured state had been extensively imported. It was also shown that Canadian labour was only benefited to the extent of from 25c. to 30c. for each telephone put together in Canada.

As to "importation," it was shown as follows, vol. 2, Ex. Ct. R. (Can.), p. 513: "During the first year of the existence of the patent the patentee or his legal representatives, imported, or caused to be imported, about five hundred instruments ready for use, as they had a right to do; a few days after the expiration of the twelve months they also imported, or caused to be imported, seventy-five complete instruments, which latter importation being inconsiderable, and apparently done in good faith, and not with any intention to evade the law, is declared not to have forfeited the patent." So that importation after twelve months of matter of insignificant value may not affect the validity of the patent.

Refusal to Sell.

"Upon application being made to the respondents to purchase a number of their telephones for private purposes they refused to sell the same, accompanying such refusal by the statement, 'We do not sell telephones but we rent them.' *Held*, that the respondent had thereby afforded a good ground for forfeiture of their patent." See headnote 3 to this case, vol. 2, Ex. Ct. R., p. 495.

As to Rental.

One is unable to see by what process of reasoning the Minister of Agriculture arrived at the conclusion that the payment of an annual sum for a license would not be a compliance with the statute, which provides that the invention must be rendered so available by the patentee "that any person desiring to use it may obtain it at a reasonable price."

Why should not this mean a licensing at an annual rental? As a matter of fact, licenses are usually paid for in annual or half-yearly payments.

The Minister interprets the term "*to license*" as meaning "*to sell the use of the invention*," but even so, a sale may be by annual or half-yearly payments.

The Minister, in effect, held the patent invalid, because the payment, instead of being in one lump sum, was proposed to be spread over a number of years. There is nothing in the statute to show how the payment is to be made, provided the parties agree upon what is termed a "*reasonable price*." If the parties can agree upon this, it must be assumed to be "*reasonable*." The difficulty with this word *reasonable* arises when the parties cannot agree. So long as the public has the use of the telephones it is not damnified in any way. What use would a telephone instrument

be by itself, as a general thing, without the use of the lines, the central stations, and the employés of the Telephone Company? You might rent the use of these latter, but you could not sell them in anywise to each particular customer. There might, of course, be a private wire between houses or stations, but this is hardly to be contemplated.

Sir John Thompson in *The Royal Electric Co. of Canada* v. *Edison Electric Light Co.*, No. X., also inclines to the view expressed by the Hon. Mr. Pope in this case No. II., as to importing parts to be assembled and put together in Canada, but at the same time intimates that he could not have concurred in the judgment, viz.: "The case of the Bell Telephone is more in point. A glance at the decision will indicate to you how far (and it seems to have been very far) the patentees carried the attempt to evade the law by introducing the patented machine in pieces, with the intention of merely assembling these pieces in Canada, besides positively refusing to sell these instruments in Canada. Without saying whether I could have been able to concur in the conclusion arrived at in that case or not, I have simply to observe that the introduction of the parts in this case bears very little analogy to the introduction of the parts of the telephone, etc.: See vol. 2, Ex. Ct. R. (Can.), p. 610. See also S. C., p. 599, where he also states: "If the parts were for use, ready to be assembled, and merely requiring to be assembled in order to produce the patented invention, as seems to have been the case with regard to the Bell Telephone, we should have to consider the question as to whether the invention for which the patent was granted was not really imported into the country, although imported in parts. We should then have to consider, with much doubt and difficulty, whether the penalty provided by the statute should not be attached to that offence to prevent an evasion of the law."

As to the importation of parts to be put together in Canada, Sir John Thompson's remarks here are somewhat inconsistent with his finding in No. X.

The Minister of Agriculture ends his decision in this case No. II., as follows:

"The conclusion is, that the patentees, the respondents in this case, or their representatives, having extensively imported the patented articles, after the expiration of twelve months from the date of their patent; having not manufactured in Canada the said articles to the extent they were bound to do, after two years of the existence of their privilege; having resisted and refused to sell or deliver licenses as required by the statute, to persons willing to pay a reasonable price, for the private and free use of the patented invention, they have forfeited their patent.

"Therefore, I decide that Alexander Graham Bell's patent (No. 7789) for 'Bell's System of Telephony' has become null and void, under the provisions of section 28 of 'The Patent Act of 1872.'" See vol. 2, Ex. Ct. R. (Can.), p. 523. The report of this case in 8 L. N., p. 34 (1885), is as follows: "Accidental delay, by which importation arrived a day, or so after the expiration of twelve months, held not to avoid the patent.

"The importation of manufactured parts to be put together in Canada avoids the patent.

"Refusal to sell unconditionally the right to use an invention or to license avoids the patent."

For the opposite view, where a rental sufficed and an out and out sale was held, not necessary under this section 37: See Case No. VIII., *Brook* v. *Broadhead*, *infra*. Decided by Deputy Minister Lowe, 17th September, 1889.

As to Importation of Parts.

And as to the view that the importation of parts to be assembled and put together in Canada did not void a Canadian patent, Sir John Thompson, in *The Royal Electric Light Co.* v. *Edison Electric Light Co.*, states: "To apply this idea to the case in hand, it would be unsafe to apply the penalty of forfeiture to the importation of the various articles out of which the patented article is produced, on the theory that Parliament, having prohibited under this penalty the importation of 'the invention for which the patent is granted' it may likewise have intended to prohibit, under the same penalty, the importation of the various articles out of which 'the invention for which the patent is granted' is made. Even if we thought the law had been violated by importing these parts, it would be better to suffer the risk of the law being infringed, for the time being, and to invite the attention of Parliament to the subject, in order to have an explicit declaration of its will." See vol. 2, Ex. Ct. R., pp. 597, 598. This appears opposed to his stated views just quoted from p. 610, of these Ex. Ct. Reports.

III.

The Telephone Manufacturing Co. of Toronto v. The Bell Telephone Co. of Canada, 19th Dec., 1885.

This is the third case between the same parties as in No. II., and is reported in vol. 2, Ex. Ct. R. (Can.), p. 524.

This is a case of *dispute* raised against the existence of three patents granted to Thomas Alva Edison (now owned by the Bell Telephone Company of Canada), namely:—No. 8026, issued

the 17th October, 1877; No. 9922, issued the 1st May, 1879, and No. 9923, issued the 1st May, 1879, for alleged forfeiture on the ground of *non-manufacturing* and of *importing*, in the terms of section 28 of "The Patent Act of 1872," and was decided by Mr. Taché, the Deputy Minister of Agriculture, on the 19th December, 1885, eleven months after the previous case, No. II., when Bell's patent for a telephone was annulled.

These patents comprised a variety of improvements on the telephone, No. 8026 having nineteen claims, including some covering the "phonograph," the carbon button, mica diaphragm, etc.

It appeared that some $12 worth of carbon buttons had been imported after the time was up, as to which Mr. Taché found (p. 534, 2 Ex. Ct. R., Can.) "the allegation of importation after the expiration of twelve months from the granting of each of the three patents involved in this case, has not been in any way sustained by evidence. It was not even necessary to examine whether the few articles imported after twelve months from the dates of any one of these patents could be properly, or to what extent properly, qualified as illegal importations, for the simple reason that the insignificance of their total value forbids the view of their being susceptible of affecting in the least any patent. The counsel of the disputants has, with commendable good faith, admitted this in saying: 'I do not rely upon the importations as being of themselves importations sufficient to upset those patents without more proof.'"

As to non-manufacture and refusal to sell, the same evidence was relied on as in the last case, No. II., between the same parties, when patent No. 7789, Bell's patent, was declared null and void. In this case, however, Mr. Taché declared that this evidence could not serve to destroy three other distinct patents (Edison's), unless it is specially proved that the same refusals which applied to Bell's one patent, was also extended to Edison's three patents. Nothing of the kind was proved.

Finding.

Mr. Taché found (2 Ex. Ct. R. Can., pp. 537–8), as follows: "Therefore, the voidance of one patent for telephones does not, by any means, entail the voidance of another patent for telephones; because they stand as distinct combinations. Bell's patent was declared null and void, by the Minister of Agriculture, because there was ample proof of importation, in forbidden time, having taken place to the notable detriment of home labour, and because there was sufficient proof of refusal to sell, which amounted to non-manufacture; while in this, *Edison's case*, there is no such proof as applied to any one of the three Edison's patents.

"In this case, there is absence of the proof, without which no patent should be considered forfeited.

"Therefore, Thomas Alva Edison's Patents No. 8026, for telephonic communication, No. 9,922, for improvements in telephone, and No. 9923, for improvements in telephones and circuits, have not become null and void under the provisions of Section 28 of 'The Patent Act of 1872.'"

Here, Mr. Taché apparently endorsed the view of the Minister in the last case, No. II., on the question of "*a refusal to sell*" and a "*proposal to rent*"; as to which, See No. II., *ante*.

And Sir John Thompson, in *The Royal Electric Co. of Canada* v. *The Edison Electric Light Co.* (See case No. X., and pp. 609, 610, of reported case, vol. 2, Ex. Ct. R., Can.), in discussing the price demanded ($4 per lamp), to those who would not use the Edison plant, while the price to persons who used the Edison plant was only $1. Says: "All this was very different from the Bell Telephone Case, where there was a distinct refusal to sell on any terms, the answer being: 'We do not sell telephones; we lease them.'"

This would also indicate that Sir John Thompson inclined to the same view as to an annual rental, not being within the term "*a reasonable price*," mentioned in the section, although in No. X., he held that the patentee might, under circumstances, reasonably *refuse to sell* his invention unconditionally; which appears inconsistent.

This case is also reported in the Quebec Reports, 18 R. L., 463, 9 L. N., p. 27; where one of the headnotes states: "A patentee is, within the meaning of the law, in regard of his obligation to manufacture, when he has kept himself ready either to furnish the patented article or to sell the right of using, though, may be, not one single specimen of the article has been produced, and he may have voided his patent by refusal to sell, although his patents were in general use.

This case is also reported in 34 O. G., 250 (January 12th 1886).

IV.

Mitchell v. The Hancock Inspirator Co., 22nd January, 1886.

This case was decided by Mr. Taché, the Deputy Minister of Agriculture, on the 22nd day of January, 1886, about thirteen months after the decision in Case No. III., and is reported as *Robert Mitchell* v. *The Hancock Inspirator Co.*, in vol. 2, Ex. Ct. R. (Can.), p. 539.

This case of dispute is raised against the existence of Patent No. 7011, granted the 24th January, 1877, to J. T. Hancock, for "The Hancock Inspirator," now owned by the Hancock Inspirator Company of Montreal, for alleged forfeiture on the ground of non-compliance with section 28 of "The Patent Act of 1872."

It arose out of an action brought by The Hancock Inspirator Company against one Mitchell for infringement, and was referred by the Superior Court of Montreal to the tribunal of the Minister of Agriculture.

Illegal "importation" and "non-manufacture" had been pleaded by way of defence, and the question came before Mr. Justice Mathieu on a demurrer.

The only question relied on was "*illegal importation*," and on which alone the decision was based. The owners of the patent had never received any demand for license to manufacture from the disputant nor any other person, except certain named licensees, and had never refused to sell the patented invention to anyone.

The invention in question was a combination of two old and well-known sets of apparatus, one known as the "lifting injector" or "ejector," and the other known as the "injector," two well-known machines. Patent No. 7011 appeared to be a new arrangement or combination of these two devices.

Combination Defined.

Mr. Taché in this decision defines *a combination* as follows:—

"It is argued that inasmuch as the patent covers an invention which consists of a new combination of old elements, the importation of the elements in their separate state is not the importation of the invention. This is opposed to the very nature of things, as admitted in all countries in matters of patents. A new combination of known elements is an invention to all intents and purposes, and as such is patentable, and confers to the person having devised such new combination the rights and privileges of an inventor, even if the novelty consisted in a trifling mechanical change, provided, in the latter case, some economical or other result is produced someway different from what was obtained before. The combination then is the invention, and, when patented, is the essence of the patent; it must be taken as a whole, not the elements as several things to be separately discussed, and the combination another thing, but the elements as combined, one thing, to stand with all the privileges conceded by law, and, reciprocally, with all the obligations imposed on all patentees: See pp. 548, 549, of reported case.

The headnote, No. 2, to this reported case, in the Ex. Ct. Reports (Can.), vol. 2, p. 539, is as follows: "Where the subject of a patent is a new combination of old devices, the patentee cannot import such devices in a manufactured state, and simply apply his combination to them in Canada, without violating the prohibition against importation contained in section 28 of 'The Patent Act of 1872.'"

NOTE.—Instead of "apply his combination to them" it would be more correct to say "*combine them.*"

Finding.

Mr. Taché concludes his decision as follows, see pp. 550–1, Ex. Ct. R. (Can.), vol. 2: "In the present case the importation of the invention itself lasted for several years of the existence of the patent, till a comparatively recent date, covered a large number of the patented articles and amounted in the aggregate to a large sum, many thousands of dollars. 'It seems hard, says the counsel of respondent, after the company trying so many years to introduce this invention into the country, that the patent should be set aside.' It is undoubtedly very hard; if it were a matter of sympathy or of sentiment in all probability the patentee would continue to enjoy the privileges to which inventors are so well entitled; but it is a matter of the fulfilment of obligations and administration of the law, in a case where no legitimate doubt can come to the rescue of the patent. As regards the part of the petition of the disputant which asks for costs, the answer is that there is no awarding of costs to parties coming before this tribunal.

"Therefore, John Theobold Hancock's patent, No. 7011, for an 'Inspirator,' become null and void, under provision of section 28 of the Patent Act of 1872."

This Finding Discredited.

This very positive decision of Mr. Taché in the "*Hancock Inspirator case*" has been very much discredited by the decision of Sir John Thompson, on the 30th October, 1889, in the *Royal Electric Co. of Canada and Edison Electric Light Co.*, wherein he states:

"The case of the Hancock Inspirator, decided in January, 1886, was much relied on by counsel for the petitioners, as going farther than the petitioners were asking you to go to forfeit the present patent. I do not regard that as a decision in point. The one point which the Deputy Minister there decided was that when a patent was a patent of a new combination of old elements the patentee might not import the old elements, and simply apply his combination to perform the functions described in the patent. The Deputy Minister forfeited the patent because he thought the patentee was bound to manufacture, and not import, all the elements, as well as to apply the combination in Canada. The elements in that case were themselves machines, and the Deputy Minister seems to have entertained the view that the patentee was bound to manufacture the machines in Canada, although his patent was only for a combination of those machines.

"While I do not think the case to be one in point, or one from which any inference can be drawn to affect this case, unless it be an inference from the fact that a very severe view was taken at that time by the Deputy Minister of Agriculture, of the requirement in the patent law as to the manufacture in Canada, I must add, as respects that inference, that, if the case were admitted to be one in point, I should have very great difficulty indeed in advising you that the *Hancock Inspirator case* was correctly decided, or that it should be followed": See vol. 1, Ex. Ct. R. (Can.), pp. 610, 611.

Headnote in Revue Legal.

In the report of the *Hancock Inspirator case* in Quebec in 17 Revue Legal, 484, S.C.(1885). The headnote is: "Proceedings before the Minister of Agriculture or his Deputy to declare the patent void, etc., is no bar to the defendant pleading every fact or default which under the Patent Act annuls a patent."

It is also reported in the Legal News (Quebec), p. 50, Minister of Agriculture, 1886, where it is stated: "That a patent for a new combination of old elements, the importation of the elements in their separate state to be merely put together in Canada, is an importation within the meaning of section 28 of the Patent Act of 1872."

V.

The Gurney Manufacturing Co. v. A. Harris, Son & Co., 7th July, 1886.

This, the fifth case heard under the terms of section 28 of the Patent Act of 1872, and is not reported in the Ex. Ct. R. (Can.), but is printed or reported by the Patent Office, and is contained in a book containing all the cases decided under this section by the Minister of Agriculture which may be found in Osgoode Hall Library, Toronto, and in the County of York Law Library, Toronto, and is entitled *The Gurney Manufacturing Co. v. A. Harris, Son & Co.*

This is a case of dispute raised against the existence of Patent No. 4193, granted on the 19th December, 1874, to James F. Gordon, now owned by A. Harris, Son & Co., for alleged forfeiture on the ground of "*non-manufacturing*," in the terms of the section 28 of "The Patent Act of 1872."

It came before the Deputy of the Minister of Agriculture Mr. Taché, and the petition, which is addressed to the Minister of Agriculture, bears date the 18th February, 1886.

The case was heard on the 6th April, 1886.

Judgment was delivered by Mr. Taché on the 7th July, 1886, without reporting the arguments, and without taking up several incidental points raised in this case, owing to his severe illness.

Decision.

"In this instance there is absence of the proof without which no patent should be considered forfeited.

"Therefore, I decide that James F. Gordon's patent (No. 4193) for 'Gordon's Self-binding Harvester' has not become null and void under the provisions of section 28 of the Patent Act of 1872."

VI.

Wright and Hibbard v. The Bell Telephone Company of Canada, March 3rd, 1887.

The sixth case, was one decided by the Hon. John Carling, as Minister of Agriculture, on 3rd March, 1887. Between *James A. Wright and Wm. C. Hibbard* v. *The Bell Telephone Company of Canada.*

The following is the decision voiding the "*Blake Transmitter*" patent:

"This is an application to have patent No. 10021, granted on the 28th day of May, 1879, to Francis Blake, Jr., for improvements in speaking telephones, called 'Blake's Transmitter,' now owned by the Bell Telephone Co. of Canada, declared void for alleged forfeiture on the ground of importation contrary to the provisions of section 28 of 'The Patent Act of 1872,' and for failure to manufacture the same within the time prescribed; and having heard Mr. Christie, Q. C., and Mr. Archibald, and Mr. Roaf, for the petitioners, and Mr. Lash, Q. C., and Mr. S. G. Wood, for the respondents, and the petitioners having submitted satisfactory proof of the importation by the respondent of the several mechanical parts or elements composing the Blake Transmitter, at various dates, after the expiration of the time limited by the 28th section of 'The Patent Act of 1872,' and such importation not being denied by the respondents, I therefore decide that the Francis Blake patent (No. 10021) for 'Blake's Transmitter,' has become, and is null and void, under the provisions of section 28 of 'The Patent Act of 1872.'" (Now Revised Statutes of Canada, c. 61, s. 37.)

This case is not reported in the Ex. Ct. Reports (Can.), but is in the book in Osgoode Hall Library and County of York Law Library, in case V., referred to.

VII.

Wright & Hibbard v. The Bell Telephone Co. of Canada, May 9th, 1887.

This is the seventh case before the Minister, between the same parties as No. VI., J. A. Wright and W. C. Hibbard, petitioners, The Bell Telephone Company of Canada, respondents, and was decided by the Hon. John Carling, May 9th, 1887. This case is fully reported in vol. 2, Ex. Ct. R. (Can.), p. 552.

It related to three patents, No. 8026, and Nos. 9922 and 9923. These patents, known as "*The Edison Patents*," after some *mesne* assignments, were finally assigned to the respondent company on the 5th July, 1882.

Illegal Importation Relied on.

The petitioners relied solely on importation contrary to law, and no evidence of failure to manufacture was offered.

There was evidence of importation of a large number of articles, such as Blake transmitters, carbon buttons, boxwood pieces, keys, screws, guages, etc., of a total value of many thousands of dollars.

For the respondent it was contended :—

1st. That the articles imported were all articles of commerce that any one could import, and that there was therefore no importation contrary to law :

2nd. That the articles imported were not used in the construction of the Edison inventions, but of the commercial instrument made and used by the company.

The respondent company examined Mr. Lockwood, an expert, at considerable length, and from his evidence it appeared that the commercial instrument made and used by the company as a telephone does not embody, and is not an infringement of any of the elements or claims of any one of the three Edison patents. It was clear from the evidence, and it was admitted, that the articles imported were used in the construction or manufacture of the commercial instrument used by the company, and, therefore, if a conclusion were reached that this instrument did not embody and would not, if manufactured by any one, constitute an infringement of the elements or claims of the Edison patents, it would become unnecessary to consider the question as to whether or not the importations complained of were importations of articles of commerce, or, taking them as a whole, of the commercial instrument used by the company.

Finding.

The Minister concludes his judgment by finding as follows: See p. 556, Ex. Ct. R. (Can.), vol. 2 :

"In view, therefore, of the statement made by the company by its counsel, and being myself of opinion that the weight of evidence compels me to that conclusion, I have decided, and do now decide, that the commercial instrument used by the respondent company as a telephone does not embody the elements or claims of any of the Edison patents, and that its use or manufacture by any one would not constitute an infringement of the Edison patents, which would therefore not be affected by the importations complained of, whatever view might otherwise be taken of the effect of such importations.

For these reasons and on these grounds, I dismiss the petition, and declare that, notwithstanding anything that has been shown to me on this application, the three patents for telephones hereinbefore mentioned, granted to Thomas Alva Edison, and now owned by the respondent company, are not void.

The headnote or syllabus to the reported case in the Ex. Ct. Reports (Can.), in this case is as follows:—

"To bring an importation by the patentee within the prohibition of section 37 of the Patent Act (R. S. C. c. 61), it is necessary that it consist of or affect the particular invention in respect of which the patent has been granted."

VIII.

Brook v. Broadhead (17th September, 1889).

This is the eighth case decided by the Deputy Minister of Agriculture, and was between James Brook, as petitioner, and Elizabeth K. Broadhead, respondent, and was decided by Mr. J. Lowe, the Deputy Minister of Agriculture, on the 17th September, 1889, and fully reported in vol. 2, Ex. Ct. Rep. (Can.), p. 562.

This is a petition to the Minister of Agriculture, bearing date the 25th April last, to have declared null and void the patent No. 6375, granted to L. W. Whipple, on the 31st July, 1876, for "*improvements on machines for making napped fabrics*," on the ground that the invention had not been manufactured in compliance with the 37th section of the Patent Act.

In November, 1876, the patent was assigned to one Harriet T. Strong, who, in March, 1882, assigned to the respondent. The machine was capable of manufacturing different classes of goods.

The respondent denied the allegations of the petition, and pleaded want of good faith on the part of the petitioner.

Evidence.

The evidence showed that the respondent in 1882, by agreement, licensed the Penman Manufacturing Co. of Paris, Ont., to manufacture horse-blankets, and agreed to supply a patented machine for this purpose at a certain rental, the machine to remain her property, and to be returned to her at the expiration of the patent; the respondent, by the deed, divested herself of the right to manufacture or license others to manufacture the said class of goods. In April, 1884, another agreement was entered into by the same parties for a certain other class of goods.

The Penman Manufacturing Co. having failed to pay the royalty stipulated, legal proceedings were instituted by the respondent; and it was charged that the petitioner was put forward by the Penman Company to offer to purchase a machine from the respondent to serve the purposes of the Penman Company in view of the lawsuit.

For the petitioner it was contended that Mr. Taché's ruling in *Barter* v. *Smith* (see No. I.), to the effect that the patentee was not bound to keep his invention in stock so long as he was ready to furnish it or license the use of it to any person desiring it, was wrong, and that the respondent had rendered herself unable either to supply or license the invention by the terms of her contract with the Penman Company.

The following is the decision by the Deputy Minister, Mr. Lowe (see 2 Ex. Ct. Rep. (Can.), p. 567) :—

Finding.

"The main subject for the consideration of this tribunal is, to ascertain whether the allegations in his petition are supported by the evidence adduced. The 37th section of the Patent Act does not require the patentee or his representative to manufacture the invention personally, but in such manner that any person desiring to use it may obtain it at a reasonable price. The evidence establishes that these conditions were complied with. The petitioner is the only person who is proved to have applied for it, and he could have obtained it, as he knew, from the Penman Manufacturing Company, and indeed from the respondent as well, as shown by the letters of the company, and that of Mr. Moffatt, above referred to; but he refused to have anything to do with it because he could not, as he expressed it, buy it out and out from the respondent. This was not required of the respondent by the terms of the Patent Act, as above stated, and as is clearly and ably shown at length by Mr. Taché in the case of *Barter* v. *Smith*, the ruling in which has been accepted as the settled jurisprudence on this subject.

"I therefore decide that the patent, No. 6375, granted to L. W. Whipple, on the 31st July, 1876, for 'improvements in machines for making napped fabrics,' has not become null and void under the provisions of the 37th section of the Patent Act."

A Rental Suffices, a Sale not Necessary.

This decision distinctly recognizes the fact that you can let out a machine for an annual rental by way of complying with the provisions of this section, and that it is not necessary that you should sell it out and out. It is directly opposed to the view taken by the Hon. Mr. Pope in Case No. II., *ante.*: *The Toronto Telephone Manufacturing Co.* and *The Bell Telephone Co.*, in which he held that the refusal to sell, accompanied by the statement, "We do not sell telephones but we rent them," afforded good ground for the forfeiture of the patent.

N.B.—In the suit of *Broadhead* v. *Penman Manufacturing Co.* on the question of liability under the agreement as to royalties, the plaintiff succeeded at the trial before Street, J., and in the Court of Appeal (Ont.), but on appeal to the Supreme Court (Can.) it was held that the Penman Manufacturing Co. were not liable to pay any further royalties, and the action was dismissed with costs.

IX.

Richard J. Doyle v. Fred. Ransome, 18th November, 1889.

The ninth case tried before the Deputy Minister of Agriculture, Mr. John Lowe, wherein Richard J. Doyle was petitioner, and Frederick Ransome was respondent, was decided on the 18th November, 1889.

This case is not reported in Ex. Ct. Reports (Can.), but is in the book, before referred to in cases V. and VI., in Osgoode Hall Library and County of York Law Library, Toronto, and the following is the text of the decision:

"Decision."

"This is a petition to have the patent No. 24961 granted to the respondent, on the 16th day of September, 1886, for "improvements in manufacturing cements," declared "null and void," on the ground that the invention had not

been manufactured in Canada in accordance with the provisions of the 37th section of the Patent Act.

"Evidence in this case was taken in June last, before the Deputy Commissioner of Patents, and doubts having arisen as to his jurisdiction in cases of dispute arising under the above recited section of the Statute, the trial was held *de novo* before me, as Deputy Minister of Agriculture, on the 29th October, last.

"Mr. James Masson, Q. C., appeared on behalf of the petitioner. The respondent did not appear, and was not represented by counsel.

"The evidence of the petitioner and another witness, *William Robinson*, conclusively established, that the invention has never been manufactured in Canada. This is also admitted by the respondent, in certain letters written and addressed by him to a patent agent in this city, as an answer to the petition, and which were, for this purpose, produced at the trial. In these letters, the respondent admits that he never manufactured the invention in Canada, but states, that it was owing to the failure on the part of the petitioner, as president of the *North American Chemical Mining and Manufacturing Company*, to carry out an agreement, whereby the company was to manufacture the invention in Canada and pay him a royalty thereon.

"The petitioner, in his evidence, denies this agreement, and states that the company offered to pay the respondent a reasonable sum for the right to manufacture the invention in Canada, but that he refused to accept the offer. I have no power to enter into the merits of a misunderstanding of this nature between the parties in this case, and can only inquire into the allegations of the petition and ascertain whether, in fact, as alleged therein, the provisions of section 37 of "The Patent Act," have been contravened.

"It was alleged, in the petition, that the invention had been imported after the time prescribed by the Statute, but in view of the evidence above referred to, it is not necessary to pronounce on this point.

"I therefore decide, that the Patent No. 24961, granted to Frederick Ransome, on the 16th September, 1886, for '*improvements in manufacturing cement*,' has become null and void, under the provisions of the 37th section of the Patent Act."

NOTE.—Had this decision been based on the ground that the mining company had offered to pay the respondent a reasonable sum for the right to manufacture the invention in Canada, and that he had refused to accept the offer, as alleged; we could then understand that it was given on the lines laid down in *Barter and Smith*, No. I., *ante;* but here the Minister states that he has no power to enter into this question, and that he could only enquire into the allegations of the petition as to non-manufacture in Canada within two years from the date of the patent, etc. And as the respondent had admitted, and the evidence showed that the invention had never been manufactured in Canada, on this ground

the Deputy Minister declared the patent null and void; although the respondent further stated that it was owing to the failure on the part of the petitioner to carry out an agreement that there was no manufacture in Canada.

This case it is conceived, can hardly be taken as a precedent.

This was *first* instituted before the Deputy Commissioner of Patents, but as doubts were entertained as to his jurisdiction, it was finally tried before the Deputy Minister of Agriculture. The Minister or his Deputy, at that time, alone having jurisdiction.

X.

The Royal Electric Co. of Canada v. The Edison Electric Light Co. (25th November, 1889).

This is the tenth and last case decided by the Minister of Agriculture or his Deputy before their jurisdiction was taken away on 24th April, 1890, by 53 Vic., c. 13.

This case, as to non-manufacture and illegal importation, was between *The Royal Electric Co. of Canada* (petitioners) and *The Edison Electric Light Co.* (respondents), relative to *Edison's Incandescent Lamp Patent.*

By a strange oversight, the number and date of the patent in question granted to Edison in Canada was omitted from the decision; nor is the patent identified in the reasons for the decision furnished by Sir John Thompson to Mr. Carling, who sat with the Minister at the rehearing of the case.

This case is fully reported in vol. 2, Ex. Ct. R. (Can.), p. 576, *et seq.*

This is a rehearing of the case, on the petition of the Royal Electric Light Co. of Canada, tried before Mr. Richard Pope, the Deputy Commissioner of Patents, and on which he gave a decision, on the 26th February, 1889, annulling the Edison patent, as contravening sec. 37, c. 61, Revised Statutes of Canada.

This decision of Mr. Pope *annulling* the Edison patent appears to be reported in 12 L. N., p. 90 (1889), as follows:

"The allegation of inability to manufacture in Canada is not a good defence to an action to annul a patent for not manufacturing in Canada; and where it appears that all the essential parts and elements of the invention continued to be imported by the patentee in a manufactured state for the purpose of putting them together in Canada, the patent was annulled."

NOTE.—This judgment of Mr. Pope was nugatory, directly opposed to this subsequent judgment, and should not have been reported.

A doubt having arisen as to the jurisdiction of Mr. Pope, the Deputy Commissioner of Patents, by reason of the provisions of the section of the Act referred to, it was decided that the case should be commenced *de novo*.

A rehearing accordingly took place before the Minister of Agriculture on the 23rd July, 1889.

The evidence taken at the previous hearing, before the Deputy Commissioner of Patents, was accepted by both the petitioners and the respondents, and some additional evidence was taken. The counsel on both sides argued the question at issue, from their respective standpoints, with great clearness and ability.

In addition to the arguments at the last hearing, Mr. Lowrey, on behalf of the respondents, with consent, put in a written statement of argument, a copy of which was communicated to Mr. Lash, and to which he subsequently furnished a reply.

The Hon. John Carling, Minister of Agriculture, (November 25th, 1889) rendered his decision.

Finding.

After a careful consideration of the evidence I decide as follows :—

(1) "I find that Thomas Alva Edison, the patentee of the patent in the proceedings mentioned, did, within two years from the date of such patent, commence, and, after such commencement, did continuously carry on in Canada the construction and manufacture of the invention patented, in such manner that any person desiring to use it might obtain it, or cause it to be made for him, at a reasonable price, at some manufactory or establishment for making or constructing it in Canada.

(2) "I further find that, after the expiration of twelve months from the granting of the said patent, neither the said patentee nor any person claiming or holding under him did import or cause to be imported into Canada the invention for which the said patent was granted.

"I do, therefore, in pursuance of the statute in that behalf, declare that the said patent has not become null or void, and I dismiss the application of the petitioners, the Royal Electric Co. of Canada."

Sir John Thompson, on the 30th October, 1889, made his report, on which the Minister's decision was founded, in which he states that a decision was rendered by Mr. Richard Pope, the

Deputy Commissioner of Patents, on the 26th February, 1889, by which the patent was declared null and void; and that, on petition to the Governor-General in Council it was prayed that effect should not be given to that decision, and it appearing at least doubtful that Mr. Pope, as Deputy Commissioner of Patents, possessed the necessary jurisdiction, it was deemed best that the whole matter should be reheard before the Minister of Agriculture, who desired his (Sir John Thompson's) assistance at the hearing.

Sir John Thompson, having reheard the matter, arrived at conclusions directly opposite to those of the Deputy Commissioner of Patents.

Importation of Samples or Models not Prohibited.

As to the unlawful importation of four lamps and lamp fittings, he states (2 Ex. Ct. R. (Can.), p. 586) :—

"I think we may also put out of the case the points taken in the particulars as to the importation of completed lamps. These points were probably based on a misapprehension of fact. It appears that four completed lamps were actually imported.

"It is said that they were returned, or destroyed, and that the importation had been made by mistake.

"The excuse, however, is not material. They were never sold in Canada, nor offered for sale, nor intended to be sold, but were merely intended to be used *as samples or models* of the article which it was intended should be manufactured within the Dominion.

"Another item of this charge was the importation of lamps for the Lachine Canal; but it seems from the evidence that what were called lamps were only lamp fittings." So that he holds that the importation of samples or models, after the authorized period, did not void the patent.

As to Articles Imported Into Canada.

The application of the petitioners, therefore, rests on the set of facts following (see 2 Ex. Ct. R. (Can.), p. 587) :—

"The patentee has made his lamps out of glass bulbs and glass tubes made in the United States, and imported from there into Canada; with platinum wires produced from platinum, mined in Russia, manufactured into wire in the United States, and imported into Canada from there; with filaments of bamboo, grown in Japan, imported thence to the United States, carbonized partially in furnaces there, and imported thence into Canada, with brass bottoms made in the United States, to fit into lamp sockets, and imported into Canada; also with copper wire which has come from the United States.

"The glass bulbs and tubes are the first articles to be considered. It is admitted that they are articles *of commerce* in the United States, in Canada, and in almost every other country, and were so for many years before the patent.

"That they were used for other purposes than for electric lamps, the bulb being the simplest form the glass takes in the process of blowing, and the tubing being made and used for a great variety of purposes and that (p. 587) a description of the patented lamp does not mention the glass bulb as being an essential part of the lamp. A transparent chamber of any shape, or of several parts joined, capable of affording a vacuum, would suffice. Therefore, the bulbs and tubes are not used exclusively for this purpose and are not even essential to the invention, strictly speaking."

And he finds as follows, as to the bulbs and tubes, see pp. 588, 589, Ex. Ct. R. C. (Can.), vol. 2:—

"These bulbs and tubes, as I have said, are not a part of the claim in the patent. In fact, it is quite possible to conceive of the patented article being made without them—made, for instance, in some other shape. However this may be, they are articles of commerce, which any one may import, manufacture, sell or use without infringing the patent. They were in use long before electric lamps were invented, are used for other kinds of electric lamps, and I cannot come to the conclusion that the importation of these into Canada incurred the forfeiture of the patent.

"What I say on this point may be taken as said of many other articles which go into the composition of the lamp, and which will be referred to hereafter. I do not see how it can be reasonably contended that these articles may be imported freely into the country, may be sold in all our shops and warehouses, may be used for any other purpose which a purchaser pleases (even for the manufacture of electric lamps), and the purchaser be liable to no penalty; while, if the patentee buys them, and uses them in making his lamps, he is to incur the enormous penalty of forfeiture of all his patent rights. If he may buy them here and use them for his lamps, he may certainly import them and use them.

"It does not seem reasonable that a person who has been placed expressly under the protection of the patent law, as a reward for inventive genius, and for expenditure of labour and capital in devising a patented article should be subjected to enormous penalties for doing what everybody else may do, and I do not think that such would be a correct construction of the law."

Platinum Wire, etc.

As to the platinum wire and brass bottom pieces he finds "*inter alia*"; pp. 589, 590, 591, Ex. Ct. R. (Can.), vol. 2:

"The platinum wire is imported from the United States wound on spools. It is not denied that this is an article of commerce, useful for many purposes. It is not pretended that its production is covered by any claim in the patent which makes its manufacture the sole property of the patentee.

"It is a common commercial article, used for many purposes, and not an essential part of the lamp which was patented by the patent under consideration.

"All that the claims in the patent say in regard to the wires is that the filament shall be 'secured to metallic wires,' and that 'metal wires' shall pass through 'a receiver made entirely of glass,' and the 'securing of platina contact wires' to a carbon filament. The copper wire used is the copper wire imported and used for all electrical purposes.

"As to the brass bottom pieces, it is stated in the testimony that these are two brass pieces, separated, or held together, by means of plaster, and that the two brass pieces are imported into Canada from the United States and are put together and set in plaster in Canada and attached to the lamp. It does not appear that these brass pieces are an essential part of the lamp, or in any way covered by the patent claim, or by the patent itself. The pieces may be of any other material which will serve the purpose, and may be of any shape, size or quality which fancy can design. They are, in one form or another, common to all electric lamps. The expert called by the petitioners says concerning the brass shells: 'There is absolutely nothing said about it in the patent, so I should regard it as a subsequent improvement or attachment.'

"It is clear, to my mind, that in respect of all these articles (and only one remains to be considered), every one of them is of the public domain, free to every person in Canada to manufacture, import, sell and use without thereby infringing the patent under consideration, and that, in respect of their use, the respondents incur no greater liability or penalty than they incur by importing, and not manufacturing, the plaster with which they seal the lamps, or any of the common appliances of the workshop which may be used in the manufacture."

Carbon Filament.

The carbon filament alone remains to be considered,—as to which, on p. 591 (*inter alia*) he states:—

"This is described in the patent claim as 'a filament of carbon of high resistance, made as described, and secured to metallic wires as set forth,' etc.

"The strips of bamboo, out of which filaments are made, are imported from Japan, as I have said, are split into threads in the United States, baked into a partly carbonized condition there, and sent from there into Canada."

And on pp. 592–5, 2 Ex. Ct. R., Can. (*inter alia*), he further states:—

"After being brought into Canada it is attached to the leading wires and, during the process of exhausting the air from the glass bulb, is subjected to an electric current for the greater portion of half a day. The carbonizing which it receives in the United States and the treatment by electric current after it arrives in Canada, before the final completion of the lamp, are what make the filament a filament of high resistance and fully carbonized. It could hardly be said to be fully carbonized until the treatment which is given in Canada has been applied. Before that the filament is a partly carbonized filament, which would emit light when the current was applied, but not efficiently; because, not being completely carbonized, it would be of short duration, comparatively, and would impair the vacuum. It would be a carbonized filament, but not 'a filament of carbon.'

'But the carbon filament is not 'the invention for which the patent is

granted" (to quote the exact words of the enactment prohibiting importation, which is invoked here). On the contrary, the production of the filament is not covered by the patent at all. The 'invention for which the patent is granted' is a *lamp*, in which the filament is to emit the light. The lamp was old, the filament new. The combination was patented.

"The patentee might have patented the filament, it would seem, but he has chosen to patent only the lamp containing the filament—or, the combination, and not the new part merely.

"If the view expressed in the above quotations were sound, the patentee would have satisfied the conditions of the patent by simply making the filament of carbon in Canada, and doing no more; but it is clear that if he had done only that the petitioners would have had an unanswerable case for the forfeiture of the patent. They would have said: 'True, your great contribution—your only contribution to the art of electric lighting, was your filament of carbon, but you have patented a lamp, in which that filament would give out light. How is it that you have not made lamps in Canada, but only carbons?'

"A carbon filament, even of high resistance, or even such a filament, subjected to treatment by electric current, is not a thing which the patentee has the exclusive right to *produce*. It can be made in Canada by any person who wishes to do so. It can even be used in Canada, for any purpose, by any person, without the charge of infringement, unless he uses it in an 'electric lamp.' It may be said that no person wants to use such an article for any other purpose, but I do not see that this in any way affects the argument. If the making of a filament of carbon is not patented, but only the construction of a lamp with such a filament, the patentee is bound to manufacture his lamp, with the filament in it, in Canada; but he is not, I think, bound to manufacture his filament here. The one thing which is covered by this patent, and of which the patentee has a monopoly under the patent, is to make 'an electric lamp for giving light by incandescence, consisting of a filament' so made 'and secured,' etc.; or, stating it another way, as his claim does: 'The combination of carbon filament within a receiver made entirely of glass, through which leading wires pass, and from which receiver the air is exhausted,' etc.; or, stating it still in another way, his claim covers 'a coiled carbon filament or strip arranged in such a manner that only a portion of the surface of such carbon conductor shall radiate light, as set forth'; or, stating it in still another way, his claim covers this—'securing the platina contact wires to the carbon filament and carbonizing of the whole in a closed chamber,'" etc.

And on pp. 596, 597, *S. C.*: "As I have already intimated, however, inasmuch as the making of the filament is not patented by this patent, I think that the filaments stand in the same position as all the other articles which go to form the lamp. As to the other articles, I have already given you my views."

The argument as to the importation of the different elements has been here put forward, as a type or suggestion of what may be made available by counsel in future cases, when it is desired to sustain a patent under this section. There is great cogency in the reasoning, for that which the statute provides for and

guards against is the unlawful importation into Canada of "the invention for which the patent is granted." See paragragh (*b*), section 37.

No Penalty for Importing Parts.

Sir John Thompson thus puts it: "I do not find anywhere that the statute expressly imposes the penalty of forfeiture for importing into Canada the various parts of the invention for which the patent was granted, much less for importing one of the parts. The words of the statute are, 'the invention for which the patent is granted,' and it does not seem that the Minister, or his deputy, in administering that law, can enlarge the statute or add any words to it, even in trying to prevent an evasion of the statute. In considering and administering such a statute the Minister or his deputy can only apply the penalty to the offence which the statute forbids. He cannot apply it to an attempt to evade the statute. In imposing penalties Parliament must take its own measures to prevent evasion, and it would be most unsafe to impose, against an evasion, the heavy penalty which the law has levelled at the principal offence, on the theory, which may or may not be correct, that Parliament intended, by an equal penalty, to forbid the doing of that which would be *almost* or quite an equivalent of the principal offence.

"To apply this idea to the case in hand, it would be unsafe to apply the penalty of forfeiture to the importation of the various articles out of which the patented article is produced, on the theory that Parliament, having prohibited under this penalty the importation of 'the invention for which this patent was granted,' it may likewise have intended to prohibit, under the same penalty, the importation of the various articles out of which 'the invention for which the patent was granted' is made. Even if we thought the law had been violated by importing these parts, it would be better to suffer the risk of the law being infringed, for the time being, and to invite the attention of Parliament to the subject, in order to have an explicit declaration of its will." See vol. 2, Ex. Ct. R. (Can.), pp. 597, 598.

NOTE.—The following English cases support this view of Sir John Thompson; the mere making, using or vending of the elements which afterwards enter into a patent consisting of a combination, is not prohibited by, and is not an infringement of the Letters Patent: *Townsend* v. *Haworth* (1875), 12 Ch. D., 831; *Sykes* v. *Haworth* (1878), 12 Ch. D.

Sir John Thompson then quotes largely from the evidence to show what was done in Canada to produce the patented invention, and states, on p. 604, Ex. Ct. R. (Can.), vol. 2.

Finding as to Manufacture and Importation.

"This seems to show conclusively to my mind (1) that the invention for which the patent was granted was not imported, but was manufactured in Canada, and (2) that the invention for which the patent was granted was not imported *in parts.*"

As to Refusal to Sell at a Reasonable Price.

As to this remaining branch of the case, he states: See pp. 604, 605, Ex. Ct. R. (Can.), vol. 2:

"There remains to be considered the charge that the patented article was not manufactured in such a manner that any person who desired to use it could obtain it at a reasonable price. There is much evidence on this point. There is evidence that the respondents, at one time, refused to sell the lamps to persons who did not intend to use them with the Edison plant.

"It seems that the Edison plant is simply a description of dynamo which Mr. Edison uses. It is not a machine of which he has the patent or any monopoly. The dynamos which are called the Edison plant can be purchased in Canada and in the United States. The explanation made in the evidence, is that the electric lighting business was then in its initiatory stages, and that it was deemed by the Edison Company most important, that the success of the lamp should not be prejudiced in the public estimation by its being used in connection with plant which they believed it could not be used with successfully.

"Under the charge of refusing to sell at a reasonable price, and as to the evidence of a refusal to sell, except for use on the Edison plant, the questions to be determined are :—

"Is the evidence to be relied on which declares that this was the only limitation to the sale? and

"Was the limitation made in good faith, in order to prevent the success of the lamp being destroyed and to prevent public opinion being prejudiced against it at a critical stage of the electric light business ?

"Was it reasonable ?

"Or, was the whole business carried on merely as a sham to avoid the forfeiture of the patent, while the company had no intention of really doing business in Canada ?"

And on pp. 607–8, Ex. Ct. R. (Can.), vol. 2, he further states (*inter alia*):

"The petitioners endeavour to support their charge of bad faith by evidence that the expenditure in putting up the plant was very heavy, as compared with what was spent in putting up the lamps to be worked by the plant, and that there was more profit on the sale of the plant than on the sale of the lamps. The petitioners have failed, however, to show that any stipulation was made, or attempted to be made, by the agents of the respondents, that persons who were negotiating for lamps should be supplied *by them* with the Edison plant. On the contrary, the single limitation sought to be imposed was that the lamps should be used on Edison plant, and this was withdrawn, subsequently, as the petitioners allege, because the respondents became alarmed, by learning from the Bell Telephone decision the effect of a refusal to sell a patented invention; or, as the respondents allege, because the merits of the invention had become better known and there was not so much reason to fear a prejudice in the public mind."

As to Charge of Refusing to Sell.

Pages 609, 610, *S. C.*:

"To support the charge of refusing to sell, there was evidence that the respondents asked, in some cases, as high as three dollars or four dollars per lamp, to persons who would not use the Edison plant, but the more settled rule was to ask $1.25 in such instances, while the price to persons who used the Edison plant was $1, with a guarantee of the duration of the lamp. It is said that these higher prices were unreasonable. They were not unreasonable if the condition which they were intended to enforce was not unreasonable. On that point I have already stated my view; but, in justice to the respondents, I must add that none of these prices reached the actual cost of producing the lamps in Canada. All this was very different from the Bell Telephone case, where there was a distinct refusal to sell on any terms, the answer being: 'We do not sell telephones; we lease them.'"

Not Bound to "Sell Unconditionally."

Pages 608 and 609, *S. C.*:

"It was urged by counsel for the petitioners that in view of the provisions of the Patent Act as to the invention being produced 'in such a way that it can be sold to any person desiring to purchase the same,' the patentee can impose no limitations, but must sell at a reasonable price to all comers.

"I think that to lay down the rule thus broadly would be going too far. Admitting, what was urged by counsel for the petitioners, that a purchaser has the right to buy the patented invention and then destroy it if he please, I do not think it unreasonable that the patentee of an article of delicate and skilful manufacture, from which he can only reap the reward of his labour and expenditure by its being esteemed successful by the public, is not bound to sell his invention to those who, by unsuitable uses, would fail to derive benefit from it themselves, and would create the impression, in the public mind, that the invention was a failure, at a time when public opinion was in suspense. When any such case arises, and we find the patentee attaching a limitation, honestly, with that view, I do not think it would be right to punish him by forfeiting his patent. We should in every case ascertain, as carefully as possible, whether good faith exists, and we should not punish, by forfeiture of patent, the limitation so imposed, unless we thought the limitation was imposed by the patentee really for the purpose of evading compliance with the statute which requires him to sell the patented invention at a reasonable price. Probably the evil which that part of the statute was principally intended to prevent was the exaction of exorbitant prices under the monopoly secured by the patent. The respondents had much to fear from the lamps appearing to be a failure. The plan on which they relied was to set a company on foot to work the patent in Canada. The business was in its infancy; the public had not yet acquired confidence in the light, and competitors were in the field—interested in depreciating the Edison lamp—competitors who were not hampered by any condition as to manufacturing in Canada, but who relied for their supplies on the factories in the United States."

After referring to the case of *Barter* v. *Smith* (No. I.), and the

observation which calls attention to the unreasonableness of insisting that the patentee should be called on to produce his invention at all times and places in Canada, without any regard to the demand for the invention in the market, Sir John Thompson refers to the *Bell Telephone Case* (No. II.), and states that the process of manufacturing electric lamps in Canada was widely different from the assembling of the parts in constructing the Bell Telephone here.

He also refers to the *Hancock Inspirator Case*, and states that he would have great difficulty in advising that the *Hancock Inspirator Case* was correctly decided or that it should be followed. A full extract of this reference may be found in Case IV., *ante*.

And Sir John Thompson winds up his report (p. 611, Ex. Ct. R. (Can.), vol. 2), as follows:—

It results from all that I have said that in my opinion the petition should be dismissed and a decision pronounced that the patent in question is not void.

I have the honour to be,
Faithfully yours,
JOHN S. D. THOMPSON,
Minister of Justice.

To the Honourable
JOHN CARLING,
Minister of Agriculture.

This case is reported in 12 L. N. p. 90 (1889), as follows:—

"The Minister of Agriculture or his Deputy has exclusive jurisdiction as to the question of validity of a patent under sec. 37 of the Act, and cannot divest himself of it by relegating it to any other tribunal whatever."

Since the Act of 1890, as we have pointed out, the jurisdiction of the Minister and his Deputy have been taken away and the Exchequer Court of Canada has now concurrent jurisdiction with the Provincial Courts as to questions under section 37.

General Conclusions.

It seems to be definitely settled under this section that although a patentee may not have commenced the manufacture of the patented article within the period limited, yet so long as he is in a position *either to furnish it or to license its use at a reasonable price to any person desiring to use it*, his patent ought

not to be declared forfeited. And that the desire must be one *expressed*, the offer of a fair bargain and offer of payment.

That it is not incumbent on the patentee *to make active efforts to create a market*, but it rests upon those who seek to defeat the patent to show that he neglected or refused to sell the invention for a reasonable price when proper application was made to him therefor. (See No. I., *Barter* v. *Smith*). This rule appears also to prevail in Germany.

It is also settled (see Case I.), that an inconsiderable importation after the authorized time does not void a patent, nor the importation of models and samples: See also Case No. X.

There is some little confusion with reference to the "*refusal to sell.*" In Case II., where the respondents refused to sell, but stated that they would *rent* them, this was held to be a ground for forfeiture of the patent. Case No. III. apparently upholds Case No. II. in this respect. It is impossible to see why payment could not be made by annual instalments instead of one lump sum; and Case No. VIII. distinctly states that an *annual rental*, instead of an out and out sale, sufficiently complies with the statute.

And in Case No. X. it is distinctly held that there are cases when a patentee may decline to sell his invention *unconditionally.*

There is also some clashing in these decisions as to whether the importation of parts in a manufactured state, to be put together in Canada, voids a patent; in Cases No. II. and IV. such importation was distinctly held sufficient to void the patent.

Sir John Thompson in Case No. X. refers to this point, raised in Case No. II., and although he considers there was an evasion of the statute, expresses doubts, and he distinctly states that Case No. IV. should not be followed; and in Case No. X. he distinctly holds that parts not specifically claimed in the patents, and being articles of *public domain* or of *commerce*, could be imported and put together in Canada. He argues that that which may not be imported is "the invention for which the patent was granted"; and he also intimates that if Parliament intended to prohibit the importation of the separate parts it should have been so stated.

Difficulty as to "Reasonable Price."

The greatest difficulty in this section is one we have discussed under *note to paragraph (a) ante* on the question of "*reasonable price*," and it does not appear to have been touched on in any of the reported cases. This "*reasonable price*" is not to be determined by the tribunal, which may declare the patent void for breach of conditions. It is a condition precedent, which cannot possibly be determined by the patentee alone, for it always takes at least two to make a bargain. So this section, as it now stands, drives us to this absurdity, viz., that a patentee may have his patent declared null and void, because he did not determine on "*a reasonable price*," which may have been impossible for him to do, owing, among other things, to the fact that no market had been created, and that it was impossible to foresee the extent of the demand, or whether it might not be displaced, or was in actual process of displacement, by some other article, whether patented or unpatented, of a similar character. If the extent of the demand could be foreseen, then there might be a way for arriving at "*a reasonable price*"; or, again, it might be impossible to get the customer to act reasonably so as to conclude a bargain.

Exception When the Commissioner Fixes "the Reasonable Compensation."

In section 44 of this Act, as an exception to the general rule which fastens on the public the duty of determining on "*the reasonable price*," the Government has appointed the Commissioner as the sole arbiter to determine on the price to be paid, the Government being entitled to take and use any patented invention, without the leave or license of the inventor, at any time, even during the first two years of the life of the patent.

French Authorities.

In *Barter* v. *Smith* Mr. Taché, the Deputy Minister, quotes in his judgment, see pp. 488, 489, 490, vol. 2, Ex. Ct. R. (Can.), the following French authorities as throwing light on his interpretation and adjudication on this section 37 (formerly section 28 of the Patent Act of 1872):—

"The French Legislation, as does the legislation of most countries, contains conditions similar to those of the 28th section of our 'Patent Act of 1872.'

"The doctrine and jurisprudence adopted on the subject is amply summed up in the quotations of two eminent writers on patents and patent laws, which will follow, after citing the text of the law.

"The French law reads thus :—Article 32, 'Shall be deprived of all his rights; ..... 2. The patentee who shall not have worked his invention in France, within a delay of two years from the date of the signature, or who shall suspend his operations for two consecutive years unless he show cause for such inactivity. 3. The patentee who will have introduced in France articles manufactured in foreign countries similar to those guaranteed by his patent.'

"It must be remarked that the last proviso, at the end of paragraph 2 of the French law, is similar in effect to the means adopted by our statute, for making the non-manufacturing a *condition* of nullity to take effect only when rendered applicable by an administrative decision. The nullity enacted by the French law can be pleaded in Courts; the nullity enacted by our Act is *conditional* upon a decision of the Minister of Agriculture, who alone is to say whether the condition is to be enforced or not.

"Renouard, after quoting Arago's speech, in the *Chambre des Deputés* (1844), against the stringency of the then proposed legislation, goes on to explain how it is to be understood :—

"The tribunals will appreciate, he says, according to circumstances, whether it has been worked or not; whether or not the working has been interrupted; if the reasons of not working are sufficiently justified." Traité des Brevets d'Invention, Paris (1844), p. 243.

"This was said by a magistrate of the highest order and a specialist, in anticipation of the judicial decisions which afterwards confirmed his views of the matter; many years after, Bédarride, reviewing the jurisprudence established on the subject, recapitulates it, and exposes the doctrine in the following sentences :

"The spirit of the law is therefore indubitable. It intends to punish only voluntary, premeditated, and calculated inactivity: Bédarride Commentaires des lois sur les Brevets d'Invention, etc., Paris (1869), vol. 1, p. 448.

"It is to be remarked that Bédarride is not a loose but rather a strict interpreter of laws; he holds that the laws of France do not admit of prætorian interpretation, and are not to be mitigated by the Courts no matter how severe and hard they may be. Bédarride again says :

"The voidance of paragraph 2 of Article 32, touches only voluntary inactivity. The law wishes to punish for inaction, the only one who has willingly remained idle. *It would have been really too unjust* to extend the penalty to the one who has abstained on account of circumstances independent of his will: Bédarride, vol. 1, p. 450.

"As regards the importation, Bédarride says :

"The prohibition having for its unique object the protection of national labour, it would have been unreasonable to extend it to cases in which such protection could not be injured."

"The judicial authority, exclusively inspired by this spirit, refused to apply

the penalty of forfeiture, when the importation, *although non-authorized*, was not in its nature susceptible of damaging national labour."

"It is proper to decide to-day, as it was decided by the Courts of Douai and Paris in 1846 and in 1855. Should not be considered as violation of the prohibition of the law, the importation of a few specimens of the articles or the importation of machines, having no other object in view than to find either associates or licensees for the invention": Bédarride, vol. 1, pp. 456, 457, 463.

In Germany, if the inventor is prepared to supply the demand, the invention need not be manufactured till a demand springs up.

In view of the fact that the Provincial and the Exchequer Court of Canada have now to determine in cases of "*non-manufacture*" and "*importation*," and that unless a liberal interpretation of the section be had, few if any patentees will be able to comply with the provisions of this section, it is to be hoped that these French authorities, the practice in Germany, in Belgium, in Italy and elsewhere, as well as the spirit of the cases hitherto decided by the Minister of Agriculture or his Deputy, will prevail in the Courts.

Provisions in Canada as to "Manufacture" and "Importation" of Questionable Utility.

It is difficult to see the value of these provisions for manufacture and importation as bearing on inventions patented in Canada. They are cumbrous and ill-defined, and to a certain extent are a clog and hindrance to invention, without effecting any good, nor promoting home manufactures.

It is to be hoped our Legislature will do away with all restrictions, and put us, in these respects, on the same footing as the U. S. Patent Laws have placed citizens of the United States. The following section 106, Walker, indicates clearly the policy of the U. S. Government, and the history of legislation bearing on the subject:

Walker, section 106: "No abandonment of an invention after the issue of Letters Patent thereon, has ever been judicially decided to exist in the United States. The Patent Act of 1832, provided that a certain class of aliens might obtain United States Patents, who had theretofore been excluded from that privilege; but it coupled with that provision an enactment, that every patent granted by virtue of that Act, should cease and determine in case of failure on the part of the patentee to introduce the invention into public use in the United States

within one year from the issuing of the patent, or in case of a discontinuance of such public use for any period of six months, or in case of failure on the part of the patentee to become a citizen of the United States. In providing such a rule of constructive abandonment for a certain class of aliens, Congress showed that it did not overlook the subject of non-user of patented inventions; and in omitting to provide any such rule for citizens of the United States, Congress showed that it did not intend constructive abandonment to result from non-user in their cases. Even as to aliens, the policy of the law upon the point was soon given up. The Act of 1836 repealed all former patent statutes, and did not re-enact the provision just cited from the Act of 1832, nor put any corresponding restrictions upon any class of patentees. Nor has any later statute contained any provision of the kind. The fair inference from this course of legislation seems to be, that Congress does not intend any patent right to be lost on any ground of non-user of that right. Even before Congress had thus indicated its intention on the subject, Justice Washington instructed a jury, that no dis-user of an invention, after it is patented, can amount to an abandonment, so as to deprive the patentee or his assignees of their exclusive right to it for the term of the patent: See *Gray* v. *James*, 1 Peters C. C., 403 (1817). So also, the Supreme Court has held, that no presumption arises against a patent from any use of the invention by the public after the patent is granted: See *Shaw* v. *Cooper*, 7 Peters, 320 (1833). Since no abandonment of an invention after it is patented, can arise out of any existing statute, or be based on any non-user by the patentee, or on any user by the public, we seem shut up to the conclusion, that no such abandonment is known to our laws.

Forfeiture of Patents in Foreign Countries.

In the following, among other countries, there are statutory provisions relative to "non-manufacture" or "working" and "importation," viz.: In France and Colonies; in The Argentine Republic; in Austria-Hungary; in Belgium; in Brazil; in Denmark; in Germany; in Italy; in Japan; in Norway; in Portugal and Colonies; in Russia; in Spain and Colonies; in Sweden; in Switzerland; in Uruguay.

N.B.—In Austria and Hungary, there is no law prohibiting the importation of the patented article; patents for warlike inventions are either not granted at all, or are appropriated by the Government and the patentee rewarded.

In Belgium, the importation of a part or granting of a license is deemed sufficient as "working." The law is liberally construed in the interest of the patentee.

In Italy, the importation of one or two machines and setting them up to work, suffices as "working."

In Germany, the law is liberally construed on the question of "manufacture"; very much on the lines hitherto indicated in Canada; being prepared to supply the demand is sufficient, and if there is no demand, and the inventor tries to create that demand and fails, the patent need not be worked till the demand springs up.

In foreign countries, generally, the provisions as to "manufacture" and "importation" are not rigidly enforced.

In Russia, very few patents are taken out by foreigners—there being only about 300 annually, all told.

Countries in which there are no Restrictions.

Neither in Great Britain nor any of her Colonies except Canada nor in India, are there any restrictions as to "manufacture" or "importation." In Great Britain, since the Act of 1883, there is a system of "compulsory licensing."

In the United States, also, there is no restrictive legislation bearing on "manufacture" and "importation."

PART XII.

CAVEATS.

38. Any intending applicant for a patent who has not yet perfected his invention and is in fear of being despoiled of his idea, may file, in the Patent Office, a description of his invention so far, with or without plans, at his own will; and the commissioner, on payment of the fee in this Act prescribed, shall cause the said document, which shall be called a caveat, to be preserved in secrecy, with the exception of delivering copies of the same whenever required by the said applicant or by any judicial tribunal,—but the secrecy of the document shall cease when the applicant obtains a patent for his invention:

2. If application is made by any other person for a patent for any invention with which such caveat may, in any respect, interfere, the commissioner shall forthwith give notice, by mail, of such application, to the person who has filed such caveat, and such person shall, within three months after the date of mailing the notice, if he wishes to avail himself of the caveat, file his petition and take the other steps necessary on an application for a patent, and if, in the opinion of the commissioner, the applications are conflicting, like proceedings may be had in all respects as are by this Act provided in the case of conflicting applications:

3. Unless the person filing a *caveat* makes application within one year from the filing thereof for a patent, the commissioner shall be relieved from the obligation of giving notice, and the caveat shall then remain as a simple matter of proof as to novelty or priority of invention, if required. 35 V., c. 26, s. 39.

A *caveat* is intended to answer a double purpose: 1st. To give notice of the *caveator's* claim as inventor. 2nd. To prevent a patent issuing to another for the same thing. It was introduced for the benefit of the inventor, but is not necessary to the preservation of his right. It enables him to have notice of any interfering application, as well as affording proof of priority of invention in certain cases.

The purpose of the *caveat*, according to U. S. decisions is to save the discoverer from the effect of the rule of law which gives the inventor, who first adapts his invention to practical use, the right to the grant of the patent: *Phelps* v. *Brown*, 4 Blatch., 362. But query in Canada as to "*race of diligence*": See *Queen* v. *La Force*, p. 62.

It is only when one desires to perfect or improve his invention that there is any object in filing a caveat.

Caveat to be Filed Only by Inventor.

By Rule 12 of the Canadian Patent Office, a *caveat* can only be filed by *an inventor*, and shall be composed of a specification, with or without drawings, following Form 23.

The applicant, while it is pending, may lodge additional papers, provided they relate exclusively to the same invention.

Caveator Not Entitled to Notice of a Pending Application.

The person filing a *caveat* will not be entitled to notice of any application pending at the time of filing his *caveat*, and a *caveat* must be limited to a single invention.

The specification of a *caveat* should be sufficiently precise to enable the Office to judge whether there is a probable interference when a subsequent application is filed.

By section 39 the fee payable is $5, and the total costs, including the preparation of papers and drawings, is from $10 to $15.

A sketch will suffice in place of a finished drawing, or a drawing may be dispensed with under certain circumstances.

How a judicial tribunal is to become officially acquainted with the existence of this secret document, and in what manner, whether by Judge's order or otherwise, it is to require the production of a copy from the Patent Office, does not appear; it is presumed that the party opposing the *caveator* is the moving party, for the former could obtain a copy himself of his own *caveat* without judicial authority.

Notice.

As to the notice mentioned in *sub-section 2*, it would be better to have the date endorsed on the back of the notice, as is the case in the United States, from which the three months is to be counted within which the *caveator* must file his petition and take the other steps necessary on an application for a patent. In the States the date endorsed on the notice is the day on which such notice is deposited in the Post-office at Washington with the regular time for the transmission of the same added thereto.

One year after filing the *caveat*, the Commissioner in Canada is under no obligation to give notice.

If a new application should have come in, which the Commissioner thinks in any respect conflicts with the invention set out in the *caveat*, having notified the *caveator* by mail and received the formal application of the *caveator*, and if then the Commissioner considers the two applications conflicting, the matter is to be settled as set out under *Conflicting Applications* in Part V., sec. 19; or in the Exchequer Court, which, by sub-sec. (*a*), sec. 4 of "*The Exchequer Court Amendment Act of 1891*," has jurisdiction "in all cases of conflicting applications for any patent of invention," etc.

But query? whether there is any appeal to the Supreme Court (Can.) at present, as by 54, 55 Vic., c. 26, sub-sec. (*b*), sec. 8, there is an appeal "on any question *affecting the patent of invention*, copyright, trade mark, or industrial design." This relates only to a patent "*in esse*," and not to any application for a patent. The Commissioner first considers the new application with respect to the *caveat*, and again with the application subsequently filed by the *caveator*.

Overlooking a "Caveat."

Should the commissioner accidentally overlook a *caveat* filed before an application for the same inventor by another party, and issue the patent to the latter, it is not stated how the matter is to be remedied in Canada. The matter might be brought up by the *caveator*, in proceeding by "*sci. fa.*" under section 34, to repeal the patent, which may be done if the *caveator* can show that he was the first inventor when, after repeal, the Commissioner might issue the patent to the successful *caveator*.

The proper practice (in U. S. A.) where a *caveat* is accidentally overlooked and a patent granted to another during its pendency, is to grant a patent to the *caveator:* See *Phelp* v. *Brown*, 1 Fish., 479, 4 Blatch., 362, in which case the Courts must determine which of the two patentees was the first inventor and entitled to the patent. If the *caveator*, who has thus obtained a patent, has in the U. S. A. exercised due diligence in reducing his invention to practice, he is entitled to carry back his invention to the date of filing the *caveat:* See *American Pavement Co.* v. *Elizabeth*, 6 Fish., 424; *Hoe* v. *Kahler*, 12 Fed. Rep., 111.

The granting of a patent while a *caveat* is pending and in force does not render the patent void: *Cochrane* v. *Waterman*, Cranch Pat. Dec., 121.

In the United States Revised Statutes, section 4902, there is a similar provision with respect to *caveats;* it first appeared as section 12 of the Patent Act of 1836, and was then practically the same as now. Our section was doubtless taken from the U. S. enactment.

Who May Apply in Canada.

In Canada "any intending applicant," whether an alien or not, as well as all the parties referred to under note (*a*) to section 7, may file a *caveat*, whereas in the United States, since 1836, besides a citizen, an alien may file a *caveat* if he has resided in the United States one year next preceding the filing of his *caveat*, and has made oath of his intention to become a citizen.

Caveat Not Conclusive Evidence of Imperfection.

A *caveat* is not conclusive evidence that the invention was not perfected, for it may happen that a person may choose to file a *caveat*, while he is going on and making improvements on an invention which he has already completed to be of practical utility: See *Johnson* v. *Root*, 1 Fish., 479, and 2 Fish., 291. As to the effect of a *caveat* on a subsequent patent, see the ruling of Spragge, J., in *Johnson* v. *Root*, Curtis, 4th ed., sec. 270.

"If an invention is fully described in a caveat then the caveat will constitute evidence showing that invention to have been made at least as early as the caveat was filed. This, however, is an incidental and not a statutory function of such a document, and it cannot be performed by any caveat which is not complete enough in its description to enable a skilful mechanic, without inventing anything himself, to construct a specimen of the invention to which the caveat refers": Walker, sec. 143.

Although an inventor takes out *a caveat* in his own name alone, yet if the invention is in fact joint it may be carried back to the filing of the *caveat*: *Hoe* v. *Kahler*, 12 Fed. Rep., 111.

Provisional Protection in United Kingdom.

In the United Kingdom under section 14 of the Act of 1883, *provisional protection* may be obtained, whereby the invention may, during the period between the date of the application and the date of sealing such patent, be used and published without prejudice to the patent to be granted for the same. Its only analogy to a "*caveat*" is a means of preserving rights till the patent be granted.

Provisional protection, however, is no security against infringement, because by section 13 no proceedings shall be taken in respect of infringement before publication of the complete specification.

Within nine months from the date of application the complete specification must be filed, unless an extension is granted. So provisional protection usually only lasts for that period.

Abandoned Applications Not Publications in England.

By section 4 of the Patent Amendment Act of 1885, Eng., *abandoned applications* are at no time open to public inspection, or to be published by the Comptroller, so that those who are not

in position to proceed with their original applications, within the time allowed, may now renew their application from time to time without risk of losing their rights, as would formerly have been the case.

Caveats, U. S.

In U. S. A. the *caveat* fee is $10, and the *caveat* is in force for one year, but may be renewed indefinitely from year to year on yearly payment of the $10 fee; the *caveat* must be restricted to a single invention.

N. B.—In Canada a *caveat* only exists for one year, within which time, under sub-section 3, sec. 38, the *caveator* must apply for his patent; in Canada, we have no provision as to renewals, as is the case in U. S. A.

"Caveat" in the United Kingdom.

The term *caveat* is applied in England to a notice filed by any one in the Privy Council Office in opposition to a petition for prolongation of a patent beyond fourteen years, under the Acts of 1835 and 1883. An extension of a patent in the United Kingdom may be obtained from the Judicial Committee of the Privy Council for a further period not exceeding fourteen years.

A provisional application in England takes the place of our *caveat* to a certain extent, it admits of use, importation and publication during the nine months of provisional protection, without detriment to the patent thereafter granted.

PART XIII.

Patent Fees.

39. The following fees shall be payable before an application for any of the purposes herein mentioned shall be received by the commissioner, that is to say :—

Full fee for 18 years	$60 00
Partial fee for 12 years	40 00
Partial fee for 6 years	20 00
Fee for further term of 12 years	40 00

Fee for further term of 6 years	$20 00
On lodging a *caveat*	5 00
On asking to register a judgment *pro tanto*	4 00
On asking to register an assignment or any other document affecting or relating to a patent, and for each and every patent mentioned in the notice given under section 8 of this Act	2 00
On asking to attach a disclaimer to a patent	2 00
On asking for a copy of patent with specification	4 00
On petition to reissue a patent after surrender, and on petition to extend a former patent to the whole of Canada for every unexpired year of the duration of the provincial or sub-patent, the fee shall be at the rate of	4 00

On office copies of documents, not above mentioned, the following charges shall be made :—

For every single or first folio of certified copy	$0 25
For every subsequent hundred words (fractions from and under fifty not being counted, and over fifty being counted for one hundred)	0 10

35 V., c. 26, s. 34, The Patent Act (1886); 53 V., c. 13, s. 3; 55-56 V., c. 24, s. 7; 56 V., c. 34, s. 4.

Any Document May be Registered.

By 53 Vic., c. 13, sec. 3 (1890), the 39th section of the Patent Act, 49 Vic., c. 61, was amended by adding after "assignment" in the eleventh line the words, "or any other document affecting or relating to a patent," for which the fee was also to be $2; this amendment will cover agreements, licenses, mortgages, etc. No reason exists why a patent should not be pledged like any other property.

By 55-56 Vic., c. 24, sec. 7 (1892), the 39th section of the Patent Act as amended in 1890, was repealed and a new one substituted, which was a re-enactment, except as to the following items, viz.: The full fee for eighteen years being $60; partial fee for twelve years, $40; partial fee for six years, $20; the fee for a further term of twelve years, $40; and fee for further term of six years, $20. The fee for every single or first folio of certified copy was reduced from 50c. to 25c., and for every subsequent hundred words (fractions from and under fifty not being counted, and over fifty being counted for one hundred), was reduced from 25c. to 10c.

New Tariff Relates to Patents Issued After 9th July, 1892.

These changes in fees only apply to patents issued after the 9th July, 1892, when the Act came into effect, and eighteen years' patents first began to be issued. As to certified copies of patents issued prior to 9th July, 1892, it is presumed that the old rates of 50c. for the first folio, and 25c. for each subsequent folio, may be demanded, although probably not so intended. The rate now charged throughout, as a matter of office practice, is on the lower scale.

Inconsistency.

As the previous Act *was repealed*, and as the 9th section expressly provides that this Act of 1892 shall only apply to patents issued after the passing thereof, the provision of the Act of 1890, whereby "any document (besides an assignment) affecting or relating to a patent," might be registered for $2, might be said to apply only to patents issued after the 9th July, 1892, leaving out all patents issued before that date, which evidently was not the intention, for it would be absurd that there should be no provision for the registration of an assignment or mortgage or other document relating to a patent issued before the 9th July, 1892; but reading the Act strictly, such would apparently be the effect.

Fees on Filing Notice Under Section 8.

By 56 Vic., c. 34, sec. 4 (1893), the section substituted for section 39 of the Patent Act by the amending Act of 1892, was amended by adding after the word "patent," in the thirteenth line, the following words: "And for each and every patent mentioned in the notice given under section 8 of this Act." So that according to this, if more than one patent is included in the notice, $2 *on each* patent mentioned therein must be paid on filing the notice.

As a Canadian Patent is limited to expire at the earliest date on which any foreign patent for the same invention expires (see section 8), if, for instance, a United States patent be first issued,

the Canadian patent (as to which notice has been given under section 8), might then extend to a little less than seventeen years at the maximum, and for a shorter period, where the life of the prior foreign patent is shorter than in the United States: (see Form 59, Appendix 2).

Fees on Reissue may be $72.

As patents are now issued for 18 years, and as $4 a year has to be paid on "*reissues*," should a patent be reissued during the first year of its life, the reissue fee may be 17 × 4, or $68, and in addition another $4 may possibly be demanded, in all $72; for it is not stated that a fractional part only of the $4 is payable for the unexpired portion of a year.

As to "provincial" or "sub-patents," mentioned in this clause, for every unexpired year, $4 is payable, which would appear to make $4, payable for the fractional part of a year.

Not Necessary to Give Notice when Prior Patent is British.

If the patent previously taken out be a British patent, then as section 8 relates only to previously existing *foreign* patents, it would appear not necessary to give the notice, nor would the Canadian patent expire in less than *eighteen* years, the previously granted British patent not being a foreign patent.

The amount payable with notice under section 8 varies as the period of life of the previous foreign patents, as to which see note (*d*) to section 8.

When the Life of the Canadian Patent is Shortened.

When notice is given under section 8, the life of a Canadian patent may be materially shortened. The maximum duration of most European patents is fifteen years, and as the application in Canada must be made within a year of the date of a foreign patent, and as there may be delay in the Patent Office at Ottawa of from four to six months after application, the life of the Canadian patent may be shortened to a period within thirteen and fourteen years in this case.

Cost of Reissues Increased.

The effect of a payment of $4 a year, in the event of reissue, now that the life of a patent has been extended to eighteen years, is to increase the cost of "*reissues.*" When patents were for fifteen years the actual rate for "reissues" was $4 per year, now it should be only $3.33⅓, instead of $4 as provided. Still up to this date the Patent Office, Canada, has not demanded any increased rate for reissues.

40. For every copy of drawings, the person applying shall pay such sum as the commissioner considers a fair remuneration for the time and labour expended thereon by any officer of the Patent Office or of the department or person employed to perform such service. 35 V., c. 26, s. 35.

NOTE.—This section is the same as in the Act of 1872 with "of the Patent Office" added. By this the drawings may be made by Patent Office officials, or by persons not connected with the office. The department referred to is the Department of Agriculture. As a matter of facts "*blue prints*" printed by the Sun are made and supplied at *the rate of 25c. per sheet.* Tracings or regular drawings are never made.

41. The said fees shall be in full of all services performed under this Act, in any such case, by the commissioner or any person employed in the Patent Office. 35 V., c. 26, s, 36.

NOTE.—The fees referred to are those fees set out in section 39, as well as the fees paid for drawings; or, as a matter of fact, "*blue prints,*" payable under section 40. Patent Office officials in Canada get nothing personally for making the drawings.

42. All fees received under this Act shall be paid over to the Minister of Finance and Receiver-General, and shall form part of the Consolidated Revenue Fund of Canada, except such sums as are paid for copies of drawings when made by persons not receiving salaries in the Patent Office. 35 V., c. 26, s, 37.

NOTE.—The exception at the end of this section allows of payments personally to persons, not on the staff of the Patent Office, for copies of drawings made by them if employed so to do, referred to in section 40.

43. No person shall be exempt from the payment of any fee or charge, payable in respect of any services performed for such person under this Act; and no fee, when paid, shall be returned to the person who paid it, except :—

(*a*) When the petition is not susceptible of being patented; or

(*b*) When the petition for a patent is withdrawn.

And in every such case the commissioner may return the fee paid less the sum of ten dollars. 35 V., c. 26, s. 38.

NOTE.—When an application for a patent is sent in, the smallest fee payable is $20, and this fee must be paid before any action is taken. If, under section 16, the Commissioner objects to grant a patent for any of the reasons therein set out (see Part 4), or if the applicant himself withdraws his application, with or without any stated reasons, then $10 of this $20 is returnable to the party who has paid in the $20.

PART XIV.

44. The Government of Canada may, at any time, use any patented invention, paying to the patentee such sum as the commissioner reports to be a reasonable compensation for the use thereof. 35 V., c. 26, s. 21.

NOTE.—This is the same as section 21 in the Patent Act of 1872, except that "at any time" has been substituted for "always," and "reports" for "may report."

Referring to this section 21, in *Barter* v. *Smith*, vol. 2, Ex. Ct. R., Appx. 2, p. 483, Mr. Taché, with reference to a demand to be made on the patentee, states as follows in his judgment:

"If it were necessary to furnish a collateral proof of this intention of the Legislature, within the law itself, of requiring on the part of the customers an actual substantial demand or request accompanied with a settlement of royalty, it would be found in section 21, in which an exception to that obligation of demanding is made in favour of the Government, which is, by way of derogation to the general rule, allowed to make use of all inventions without going to the patentee, even during the two years' delay, free of any blame for infringement, by resorting to a special and an exceptional mode of settling upon the price to be paid to the patentee.

NOTE.—Section 21—The Government of Canada may always use any patented invention, paying to the patentee such sum as the commissioner may report to be a reasonable compensation for the use thereof.—"*The Patent Act of 1872.*"

In this case, where the Government adopts the invention, the patentee has not the usual two years' monopoly of use. And the Commissioner of Patents, is alone authorized to report on "the reasonable compensation" which is to be paid by the Government for the use of the invention; there appears to be no appeal from his report; it seems more sensible to appoint an independent tribunal to settle the "reasonable price" to be paid, than to expect the parties to do so themselves. This is an exception to the general rule.

Under sub-section 2, of section 5, of this Patent Act, can *the Deputy Commissioner of Patents* be authorized by the Governor-in-Council to report on the "*reasonable compensation*" to be paid? As he is not mentioned in this section, it would appear at least doubtful.

In the case of a royalty of $100 per door for a patented "*dredge shovel door*," covered by Canadian Patent No. 9440, where the Department of Public Works had previously voluntarily paid, and the patentee accepted royalty at $100 per door on shovels used in some of their dredges; by letter No. 12516, of the 10th November, 1885, the Commissioner of Patents remarks "that there seems no necessity to interfere, inasmuch as the point touched by section 21 of 'The Patent Act of 1872' has seemingly been already settled between the Department of Public Works and Mr. Canan, viz., that the sum of $100 for the use of each machine covered by patent No. 9440 is a proper royalty therefor."

How Royalty May Be Recovered.

In the event of the amount of the royalty being fixed by the Commissioner, and if the Government, for any reason, refuses to pay the amount of the compensation, proceedings may be had in the Exchequer Court by way of Petition of Right under c. 136, Rev. Stats. (Can.).

This section does not state that the Government of Canada may have the exclusive use, as is the case in many countries as to munitions of war.

Government Employee May Be Patentee in U. S.

In the States it is held that one in the employ of the Government is entitled to a patent in the absence of an agreement on his part that his invention shall be the property of the Government: See *Riley* v. *Bernard*, C. D., 59 O. G., p. 1919. This same rule would apply also to Canada.

And in *Head* v. *Porter*, December 3rd, 1891, U. S. Circuit Ct., Mass, 60 O. G., p. 1052, it was declared that the rights secured to a patentee under his grant from the Government are a form of property in the enjoyment of which he is entitled to protection against all trespassers, including the Government.

In the United States a patent is private property, and the Government cannot, after it is issued, make use of the improvement any more than a private individual without license of the inventor or making him compensation: See *Cammeyer* v. *Newton*, 11 Brodix, p. 131, 94 U. S., 225 (January 29th, 1877); see also *United States* v. *Burns*, 8 Brodix, 458, 12 Wall., 246, and Walker, sec. 157; *James* v. *Campbell*, 104 U. S., 356; *Hollister* v. *Benedict Manufacturing Co.*, 113 U. S., 59 (January 5th, 1885); *United States* v. *McKeever*, 14 Brodix, 437 (November 20th, 1882).

There is no express enactment in the United States such as we have, with reference to use by the Government; but the Secretary of the Interior (U. S.) and the Commissioner of Patents (U. S.) are authorized to grant any officer of the Government, except officers and employees of the Patent Office, a patent for any invention of the classes mentioned in sec. 4886 (U. S.), Revised Statutes, when such invention is used or to be used in the public service, without the payment of any fee; provided, that the applicant in his application shall state that the invention described therein, if patented, may be used by the Government, or any of its officers or employees, in prosecution of work for the Government without the payment to him of any royalty thereon, which stipulation shall be included in the patent. Act of March 3rd, 1883, c. 143, U. S. Stat. 22, p. 625.

As to War Munitions, etc., in Great Britain.

In Great Britain by section 44 of the Patent Act of 1883, the inventor of any improvement in instruments or munitions of war may assign to the Secretary of State for War all the benefits of his invention and any patent obtained or to be obtained; the Secretary may direct that the invention be kept secret and all documents be kept sealed up.

Under ordinary circumstances, under section 22 of the Patent Act of 1883, the British Government could compel a patentee to grant a license on such terms as the Board of Trade may deem just.

The Board of Trade is defined by 17 and 18 Vic., c. 104, sec. 2, to mean: "The Lords of the Committee of the Privy Council appointed for the consideration of matters relating to trade and foreign plantations." Compulsory licenses only relate to patents granted since January 1st, 1884.

45. No patent shall extend to prevent the use of any invention in any foreign ship or vessel, if such invention is not so used for the manufacture of goods to be vended within or exported from Canada. 35 V., c. 26, sec. 47.

NOTE.—There does not appear to be any provision similar to this, either in the U. S. Act or that of Great Britain. According to this, a foreign ship might make use of, for instance, an anchor patented in Canada, but this anchor may not be manufactured on board to be sold in Canada or for export.

Section 45 Does Not Relate to Canadian or British Ships, etc.

This section relates only to "any foreign ship or vessel," and does not relate to Canadian or British vessels, or those belonging to British colonies or possessions, so that all vessels other than foreign ships or vessels would not be entitled to make an unlicensed use of the anchor referred to in Canadian waters.

In Walker, section 161: "No United States patent right extends to the mere use of the patented invention on any foreign ship, while temporarily in a harbor of the United States for the purposes of commerce, though such a right would be infringed by making or selling the patented article on board any foreign vessel while in either of our ports: See *Brown* v. *Duchesne*, 19 How., 196 (1856).'

The provisions of the U. S. patent laws in this respect are very similar to ours.

United States patent rights extend to the decks of United States ships, even when these ships are on the high seas, as fully as they extend to the solid earth of the United States: See *Gardiner* v. *Howe*, 2 Cliff. 464 (1865).

46. "Every person who, before the issuing of a patent, has purchased, constructed or acquired any invention for which a patent is afterwards obtained under this Act, shall have the right of using and vending to others the specific article, machine, manufacture or composition of matter patented and so purchased, constructed or acquired before the issue of the patent therefor, without being liable to the patentee or his legal representatives for so doing; but the patent shall not, as regards other persons, be held invalid, by reason of such purchase, construction or acquisition or use of the invention, by the person first aforesaid or by those to whom he has sold the same, unless the same was purchased, constructed, acquired or used, with the consent or allowance of the inventor thereof, for a longer period than one year before the application for a patent therefor—making the invention one which had become public and in public use. 35 V., c. 26, s. 48.

This is the same enactment as in the Patent Act of 1872, with some alterations; "has been obtained" near the beginning is now "is afterwards obtained," and "with the consent or allowance of the inventor thereof," is now added after "acquired or used" towards the end of the section. The other alterations are immaterial.

Provision of Act of 1849.

A provision somewhat similar to this section 46, being the original provision in Canada, appeared in 1849, in 12 Vic., c. 24, sec. 22: See Form 55, Appx. 2.

The words in the beginning of this section 22 of 12 Vic. c. 24 (1849), "invented or discovered," sound strangely, for it would appear the true inventor might be displaced by a person only claiming to be the inventor; also that a corporation might be an inventor or discoverer; and further on, near the middle of the section, it would appear that the words "invented or discovered" are displaced by the word "introduced," as if an introduction of the invention into the Province of Canada was tantamount, at that time, to an invention or discovery, thus savouring of the English Act. The provision as to introducers into Canada, being entitled to obtain patents,

did not appear till subsequently in section 11 of 14 and 15 Vic. c. 79 (1851).

This section 22 of 12 Vic. c. 24, appears again in Con. Stat. (Can.), c. 34, sec. 22 (1859), and also in a modified form in this sec. 46 R. S. (Can.), c. 61, our present Act, but in the latter the word "acquired" is substituted for "invented or discovered" at the beginning of the section, and in order to make out abandonment to the public, the purchase, construction, use, etc., must now be with the consent or allowance of the inventor for a longer period than one year before the application. In the old Act, 12 Vic., c. 24, referred to, there was a similar provision as to abandonment, but nothing was said about the "*consent or allowance of the inventor.*"

Section 22, of chapter 24, 12 Vic. (Form 55, Appx. 2), was evidently taken from section 7, of the U. S. Patent Act of 1839, and has been spoilt by the addition of the words "invented or discovered" already referred to, which do not appear in the U. S. sections.

The first half of this section 46, of our Act, down to the words "for so doing," bears an analogy to section 4899 of the U. S. Revised Statutes (which was taken from the U. S. Act of 1870, sec. 37) now in force, which is as follows:

Section 4899. "Every person who purchases of the inventor or discoverer, or with his knowledge and consent, constructs any newly invented or discovered machine, or other patentable article, prior to the application by the inventor or discoverer for a patent, or who sells or uses one so constructed, shall have the right to use and vend to others to be used, the specific thing so made or purchased without liability therefor."

Is the Purchase with the Consent or in Fraud of Inventor?

Do the words "purchased, constructed or acquired," at the beginning of this section 46, of our Act, mean from any person in fraud of the inventor, who afterwards obtains a patent, or do they mean from the inventor with his consent or allowance? This is a material consideration, and we have no decisions in our Canadian Courts to guide us. In our section also, the reference is before "*the issue*" of the patent; in the U. S. section, it is prior to

"*the application*" for a patent by the inventor. In our section 46, the purchase, construction or acquisition, referred to in the beginning of the section, is not said to be from the inventor or with his consent or allowance.

The U. S. Act of 1839, from which our original section in 12 Vic., c. 24, was taken, is silent, as to the purchase, sale or use, being with the knowledge or consent of the inventor, which makes this section in the Act of 1839, like our present section in this respect; in the other U. S. Acts, including section 4899, Revised Statutes, at present in force, the fact that the purchase should be made of the inventor, and that the construction should be with his knowledge or consent, is especially mentioned.

In Walker on Patents, sec. 158, referring to this U. S. section 4899, and as to purchase or construction in fraud of the inventor, it is stated: "No patent right covers any use or sale of any specimen of the patented thing which was purchased of the inventor or made by another, with his knowledge or consent before his application for a patent therefor: See *Wade* v. *Metcalf*, 16 Fed. R., 130 (1883). Where another than the inventor surreptitiously obtains knowledge of an invention, and *without the consent* of the inventor, makes a specimen of the invented thing before any patent thereon is applied for, that specimen is covered by a patent for that invention as truly and as fully as it would be if it had been made by an infringer after the date of that patent. Such a case is clearly outside the rule just stated, and the statute upon which that rule is based.

Indeed, Justice Story, in *Pierson* v. *Screw Co.*, 3 Story, 402 (1844), and afterwards the full Supreme Court in *Kendall* v. *Winsor*, 21 Howard, 32, held such a case to be outside the corresponding provision of the Patent Act of 1839, though that provision did not literally exclude such a case."

As the provisions of the U. S. Act of 1839 do not refer to any "knowledge or consent" on the part of the inventor as to the prior purchase, sale or use, in the same manner as this Canadian section 46 commences, these two last named cases would appear to be direct references, applicable to our present section, so as to exclude, if they be followed in Canada, all surreptitious purchase, construction, or acquisition; and making the purchase or acquisition referred to in our section to be from the inventor or those authorized by him, and the construction to be with his knowledge or consent. This would appear to be the meaning of our section, and would make it conform with the meaning and

intent of the U. S. sections (of which ours is an adaptation), and to these decisions in the U. S. Courts lastly referred to.

"Consent or Allowance," etc., Added in Revised Act, 1886.

Since the Patent Act of 1872, and by the Revised Patent Act of 1886, the words "with the consent or allowance of the inventor," have been added with reference to the words "purchased, constructed, acquired or used," in the latter half of the present section, and this would seem to imply that they should also be taken to refer to the same words, "purchased, constructed or acquired," at the beginning of the section.

To save all doubt, it would be better, if the words added in 1886, in the latter half of the section, viz., "with the consent or allowance of the inventor," were also added in the beginning of the section after the word "acquired."

Our Description Like that in U. S. Act of 1839.

It will be also noticed that in the U. S. Act of 1839 it reads "the specific machine, manufacture or composition of matter;" in the U. S., 1870, Act, and U. S., section 4899, Revised Statutes, it reads "specific thing." In our Patent Act, section 46 reads "specific article, machine, manufacture or composition of matter" which, barring the word "article," which has been added, is the same as in the U. S. Act of 1839.

In Part I. and sub-sec. (*c*) of sec. 2, an invention means "any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement in any art, machine, manufacture or composition of matter."

See note to sub-section (*c*), section 2, where the term "*art*" is shown to mean "*a process.*"

Our Section 46 may not Include a "Process."

And it will also be noticed, that in the definition of the thing invented, the word "*art*" has been expressly dropped out of this section 46, and the word "article" substituted so as to make it correspond with the term "thing" in the U. S. sections referred to, thus showing that our draftsman had these U. S. sections under his eye. So that this section 46 may not be held to include "*a process.*"

A Process not Included in the U. S. Section.

In section 159, Walker, the author, says: "The rule stated at the head of the last section (158 before referred to) does not apply to any '*process patent.*'"

"The provision of 1870, and Section 4899 of the Revised Statutes, treat only of machines or other patentable articles, and confer exemption from the operation of patents upon nothing but specific things. Now a process is neither an article or thing. It is a series of acts. It is, therefore, outside the language of the law on this subject. It is also outside the reason of that law. That reason is as follows:

Where another than the first inventor of a particular tangible thing, buys from the inventor a specimen of that thing, or makes such a specimen with his consent, or reinvents and makes such a specimen independently of the first inventor, that specimen ought to be exempt from any patent afterwards applied for by the first inventor; because, if it is not so exempt, it will become worthless in the hands of one who honestly expended of his substance to procure it, and who procured it without violating any patent or any law. Processes are not subjects of these considerations. A process cannot be purchased. The right to practice a patented process can indeed be purchased; but the right to practice an unpatented process, while it remains unpatented, cannot be the subject of a sale, because that right belongs to every one without any purchase. So also, if an inventor of a process consents that another person may practice that process, before the inventor applies for a patent, that fact furnishes no reason why that person should be allowed to practice that process against the will of that inventor after the date of his patent. To deprive such a person of such a privilege, is not to deprive him of the use of a thing. It is only to deprive him of the privilege of repeating a series of acts. These considerations apply also to cases where a reinventor produces and practices a process, after its production by the first inventor, and before any application is made for a patent thereon, and without any knowledge of the first inventor or his doings. Such a reinventor has no more natural right to practice that process after a patent is granted to the first inventor, than any other person has. He has no such right growing out of the fact that he was a reinventor, because the patent laws do not reward reinventors, and because patents to first inventors are exclusive of reinventors, as well as of other persons. He has no such rights growing out of rights of property, because to deprive him of the privilege of repeating the process is not to deprive him of the use of any tangible property, and because he has no intangible property in the process itself."

The foregoing long extract from Walker, section 159, is equally applicable to our section 46, and affords cogent reasons why it should not cover a "*process*"; it merely covers a "*machine*," "*manufacture*" or "*composition of matter.*" As to the definition of these terms see note (*c*) to section 2 of this Act. This extract also affords reasons why a reinventor of a process may be included therein. The question arises whether a reinventor, who may have constructed the machine or manufac-

ture, or made the composition of matter, in ignorance of the prior invention for which a patent is afterwards obtained, may be held to have the right to use and vend to others, the specific article, machine, manufacture or composition of matter so reinvented and made. This case is apparently not specifically provided for in our Act, and the fact that the words "*with the consent or allowance of the inventor*" are absent from the beginning part of our section, would make it more applicable, so as to cover a case of reinvention, and exclude the use of the reinvented thing or process after a patent has been obtained. In Canada we have no decided cases bearing on this point.

On the other hand, as bearing on the question whether a process is included, the section in the Act of 1839 (U. S.), which relates to the purchase or construction of any newly invented "machine, manufacture or composition of matter," is worded nearly the same as our present Act, which refers in addition to the "specific article," etc., and this U. S. section was held by the Supreme Court in *McClurg* v. *Kingsland*, 1 How., 202 (1843), 4 Brodix, 382, to cover patents for processes as well as patents for things. As to this decision of the Supreme Court, Walker, in section 159, remarks: "The reasoning of Justice Baldwin in the case was never convincing to the present writer. It was spoken of by Justice Story as 'certainly general,' and Judge Wheeler has well said that 'it is not probable that *McClurg* v. *Kingsland*, would be followed beyond cases of its class, upon the same statute: See *Brickill* v. *New York*, 5 Ban. & Ard. 547 (1880). Generally speaking, a patent for a new composition of matter covers the process, for if the composition itself be new, the process by which it is made must also be new, so that indirectly a new composition of matter may cover a process.

Illustrations.

If parties construct a machine before the application of a patentee for Letters Patent, and the patentee consents and allows them so to do, then they may lawfully continue to use the same after the date of the Letters Patent: *Kendall* v. *Winsor*, 21 How., 322; *Black* v. *Hubbard*, 3 Ban. & Ard., 39.

The purchase spoken of is not from a mere wrong-doer, but from the first and true inventor before he obtained his patent:

Pierson v. *Eagle Screw Co.*, 3 Story, 402; *Troy Factory* v. *Odiome*, 17 How., 72.

A use by fraud and piracy is not contemplated or protected under section 4899, U. S.: See *Hovey* v. *Stevens*, 2 Robb., 479.

In U. S. A., he who permits the use of a machine which he afterwards patents, cannot stop the use after his patent issues: *Duffy* v. *Reynolds*, 24 Fed. Rep., 855.

If a member of a firm, prior to his appplication for a patent, makes a machine at the expense of the firm, and permits its use by the firm, the firm may continue to use it after the grant of a patent, and this right does not cease on the dissolution of the firm: *Wade* v. *Metcalf*, 16 Fed. Rep., 130.

The right of a party who has purchased or constructed a machine prior to the application for a patent by the inventor is confined to the *specific machine*: *Brickill* v. *New York*, 18 Blatch., 273.

In the Can., section 46, the term "every person" is as comprehensive as "*any person*"; as to which see note (*a*) to section 7 of this Act; and by the Interpretation Act includes any "body corporate, and politic, or party, and the heirs, executors, administrators or other legal representatives of such persons to whom the context can apply."

Three Classes of Persons Included in Sec. 46.

Our section apparently contemplates three classes of persons who shall have the right of using and vending to others the specific article purchased, constructed or acquired before the issue of a patent:

1st. Every person who purchases any invention of the inventor or from those authorized by him before the issue of a patent therefor.

2nd. Every person who, with the inventor's knowledge or consent, constructs any invention before the issue of a patent therefore.

3rd. Every person who acquires, otherwise than by purchase from the inventor or those authorized by him, any invention before the issue of a patent therefor.

Our Section 46 is not Specific.

Our Act is not as specific as the U. S. section 4899, and does not expressly state that the purchase is to be from the inventor, as already discussed; nor that the construction is to be with his knowledge or consent; nor what may be the nature of the acquisition.

The nature of the invention is defined in this section 46 to be "the specific article, machine, manufacture or composition of matter patented" which may be understood possibly to exclude "*a process*," as has been pointed out.

In the U. S. Section Four Classes are Included.

In *Wade* v. *Metcalf*, 129 U. S., 202, 19 Brodix, 258 (January 21st, 1889), the American section is said to define clearly four classes of persons who shall have the right to use and vend to others to be used a specific patentable machine.

1st. Every person "*who purchases of the inventor*," etc., the machine before his application for a patent.

2nd. Every person "*who with his knowledge and consent constructs*" the machine before the application.

3rd. Every person "*who sells*" a machine "*so constructed*," that is to say, which has been constructed, with the knowledge and consent of the inventor, by another person.

4th. Every person "*who uses one so constructed*," that is to say, constructed, with the inventor's knowledge and consent, by another person.

"In order to entitle a person of any of these four classes to use and vend the machine, under this U. S. section, the machine must originally have been either purchased from the inventor, or else constructed with his knowledge and consent, before his application for a patent; and it may well be that a fraudulent or surreptitious purchase or construction is insufficient: *Kendall* v. *Winsor*, 7 Brodix, 1; *Andrews* v. *Hovey*, 124 U. S., 694, 17 Brodix, 477 (February 20th, 1888)." And every other person who uses or sells that specific thing is within the protection of the statute, the clause which includes every person "who sells or uses one so constructed" does not leave this in doubt.

Inasmuch then, as from the foregoing, the U. S. analogous provision is more definite, and does not leave so much to conjec-

ture as our provision, the U. S. enactment, although shorter, is the better of the two.

The Right of Vending Implies the Right to Use.

Our section provides that every person who has "purchased, constructed or acquired," etc., before the issue of the patent, etc., shall have the right of "using and vending to others" the "specific article, machine," etc. The right of "*vending to others*" also implies that those to whom the specific article is sold have the right *to use*, otherwise the sale would be abortive; and it is here as if the person to whom the specific article is sold were the lawful assignee of one holding the machine, etc., under a purchase or under an express and unrestricted license from the inventor.

The Canadian form of patent grants "the exclusive right, privilege and liberty of making, constructing, and using, and vending to others to be used in the Dominion of Canada, the said invention," etc., here the words "*to be used*" after "*vending*," omitted in this section 46, are expressly added in the patent.

Instance of an Implied License.

This section 46 furnishes an instance where an implied license to construct, use, and vend, may arise without any *written license* from the inventor or patentee with respect to any article, machine, manufacture or composition of matter constructed, etc., with the consent or allowance of the inventor prior to the issue of his patent therefor—in which case one would continue to have the right to use and vend to others to be used the "*specific article*" without further license even after the issue of the patent. Under section 29 of this Act we have seen that it is expressly provided that licenses must be in writing in every case where a patent has been obtained, and this provision as to licenses being in writing has been in force since our earliest Patent Act, in 1826: See note to section 29.

As to the Period Covered by this Section.

The latter half of this section indicates (if the purchase, construction or acquisition is taken to be a purchase from or construction or acquisition with the consent or allowance of the inventor),

that the period covered may be a year prior to the application for the patent *plus* the time between the date of application for and the date of issue of the patent.

In consenting to the construction of his invention by another, or making sale of a specimen, the inventor must be careful not to let more than a year slip by before making application for a patent, for, if his invention be so purchased, constructed, acquired or used for a longer period than one year prior to application, his invention becomes public property and unpatentable.

New Cause of Forfeiture.

The fact, that a year from the date of construction, with the consent or allowance of the inventor, is one of the times limited in this section 46, adds another cause of forfeiture of a patent to those provided in section 7, which relates to an invention being "in public use or on sale with the consent or allowance of the inventor thereof, for more than one year previously to his application for patent therefor in Canada," this latter does not relate to the construction which evidently must precede the being "*in public use or on sale*," indeed, an article might be constructed for years without the time commencing to run, under section 7.

As to that which constitutes a dedication to the public: See note (*e*), sec. 7; also note (*b*) to sec. 16.

In this section 46 it is stated that every person purchasing, constructing or acquiring the invention before the issue of the patent, etc.—shall have the right of using, etc., "without being liable to the patentee or his legal representatives for so doing."

In the body of the Canadian patent the grant is to the patentee, "his executors, administrators, legal representatives and assigns," thus distinguishing between "*assigns*" and "*legal representatives*," while "*legal representatives*" may be said to include "*heirs, executors and administrators*": See (22), sec. 7, of the Interpretation Act, R. S. C. Do legal representatives include "*assigns*"? for "assigns" are not mentioned in this section 46; such, no doubt, is the intent, for it is absurd to suppose that liability to loss incurs to the assignor when none incurs to the assignee.

In the U. S. A. "*legal representatives*" includes in its terms assignees as well as executors and administrators: See *Hamilton v. Kingsbury*, 15 Blatch., 64, 3 Ban. & Ard., 346.

Do the terms "*public*" and "*in public use*" at the end of this section refer to the Canadian public and to "public use" in Canada, only; it is difficult to say what they may mean; a Canadian invention to be patentable should be novel the world over: See notes to sec. 7, pp. 55, 56, 59, 65, *et seq.*

47. All specifications, drawings, models, disclaimers, judgments and other papers, except caveats, shall be open to the inspection of the public at the Patent Office, under such regulations as are adopted in that behalf. 35 V., c. 26, s. 44.

Pending Applications Not Open to Inspection.

This section is the same, word for word, as in the Act of 1872. As it is at present worded, it might be concluded that pending applications were open to public inspection, this, however, is not the case either in Canada or the United States; in Great Britain abandoned applications under the Amending Act of 1885, are not open to public inspection, so as to become publications, which might defeat a subsequently granted patent for the same invention.

In the U. S. Patent Office, under Rule 177, forfeited and abandoned applications will not be cited as references; and, under Rule 179, U. S. Patent Office, copies of the files of rejected and abandoned applications may be furnished when ordered by the Commissioner. The request for such copies must be presented in the form of a petition, properly verified as to all matters not appearing of record in the Patent Office. Except by attending to these formalities abandoned or forfeited applications, in U. S. A., are not open to the inspection of the public.

In the Canadian Patent Office Rules there is no provision for getting copies of abandoned or forfeited applications, as in the U. S. Patent Office, and Rule 15, Canadian Patent Office provides that information, in relation to pending cases, will be furnished only so far as it becomes necessary in conducting the business of the office, which shows by implication that information as to pending cases is not open to the public.

Mr. Justice Burbidge, in his judgment in the "*sci. fa.*" case of *The Queen* v. *La Force*, 4 Ex. Ct. R. (Can.), p. 15 (1894), assumes that, by section 47, the filing of La Force's application was a pub-

lication and made it open to the world; this, it is conceived, is not the case nor the practice in Canada.

The foregoing section 47 should expressly state in its body that it does not apply to *pending applications*.

In the U. S. Patent Office, Rule 16, after a patent has issued, the model, specification, drawings and all documents relating to the case are subject to general inspection, and copies, except of the model, will be furnished at the rate specified in Rule 218.

As to judgments: See note to section 35; and as to caveats, note to section 38.

48. Clerical errors which occur in the framing or copying of any instrument in the Patent Office, shall not be construed as invalidating the same, but when discovered they may be corrected under the authority of the commissioner. 35 V., c. 26, s. 45.

This is the same as sec. 45 in the Act of 1872, only that "in" is now substituted for "of" before "the Patent Office," and "which occur" is also now substituted for "happening."

This section relates to clerical errors made in the Patent Office, and does not relate to clerical errors made elsewhere.

In Ontario in *Riech* v. *Hoerr* (1889), where letters had been misplaced in a claim, which claim was the subject of a suit, and the case in consequence had been dismissed by Ferguson, J. (the trial Judge), the case was restored, on appeal to the Chancery Divisional Court, the error being apparent on the face of the document. Although it may be contended that this was a "clerical error" on the part of the Patent Office in not correcting the erroneous lettering of the claim, it appears that this was not such a case as the Office felt bound to correct. Any error in the certificate or of a certified copy of a document, or error in the name of a patentee, etc., would come within this section, and be corrected under authority of the Commissioner.

In *Marsh* v. *Nichols & Co.*, Sup. Ct., U. S. (December 10th, 1888), 19 Brodix, p. 112, "*a clerical error*" is defined to be an error of a clerk or a subordinate officer in transacting or entering an official proceeding ordered by another.

In this case the signature of the Secretary of the Interior had been omitted from a patent which had been issued, the section 4883 of the Revised Statutes providing that patents should be under the seal of the Patent Office, signed by the Secretary of the Interior and countersigned by the Commissioner of Patents; although this was not a mere "*clerical error*" the existing Secretary of the Interior had power to rectify the patent, and the Department had power to prevent the consequences of inadvertence and mistakes in its officers.

As to Clerical Errors in U. S.

By Rule 170 of the U. S. Patent Office, whenever a mistake has occurred in the Letters Patent through the fault of the Office and is clearly disclosed by the records or files of the office, a certificate, stating the fact and nature of such mistake, signed by the Secretary of the Interior, countersigned by the Commissioner of Patents, and sealed with the seal of the Patent Office, will, at the request of the patentee or his assignee, be endorsed without charge upon the Letters Patent, and recorded in the records of Patents, and a printed copy attached to each printed copy of the specification and drawings.

Whenever a mistake, incurred through the fault of the Office, constitutes a sufficient legal ground for a reissue, such reissue will be made, for the correction of such mistake only, without charge of Office fees, at the request of the patentee.

Mistakes, not incurred through the faults of the Office, and not affording legal grounds for reissue, will not be corrected after the delivery of the Letters Patent to the patentee or his agent.

Correction of Clerical Errors.

At Common Law, in England, the Master of the Rolls had power to direct the amendment of a clerical error in a specification, but the Lord Chancellor, as Keeper of the Great Seal, alone had power to amend the Letters Patent themselves: *In re Nickel's Patent*, 1 Web., P. C., 650; *Ex parte Beck*, 1 British Crown Cases, 578.

Where there has been a clerical error made in the name of a British patentee, the *register* may be corrected at an expense of

about £2, 10s, sterling. In order to correct the Letters Patent it would be necessary to make application to the Lord Chancellor, which would involve a much more considerable expense.

Illustrations.

Where, in the specification, the word "*wire*" was by mistake substituted for the word "*fire*," the mistake was ordered to be corrected: See *In re Whitehouses Patent*, 1 Web., P. C., 649.

Where the grant was in "*October*" instead of "*November*," *In re Rubery's Patent*, 1 Web., P. C., 649; also, where the specification had the name "*Charles*" instead of the name "*George*": See *In re Dinsmore's Patent*, 18 Beav., 538.

Where there was an error in spelling the name of the patentee, an application to amend, four years after the patent was granted, was refused on account of lapse of time: *In re Blamond's Patent*, 3 L. T. R., N. S., 800.

Where clerical errors had been corrected by order: See *In re Redmund's Patent*, 5 Russ., 44; *In re Sharp's Patent*, 1 Web., P. C., 645; *In re Adams' Patent*, 21 L. T. R., 38, and 1 Web., P. C., 647, note (*l*).

The Court had the right by Common Law to amend in foregoing cases, irrespective of statutory enactment.

Where a disclaimer had been filed without the consent of the patentee, the Master of the Rolls had jurisdiction *without bill filed*, to order it to be taken off the file: *In re Berdan's Patent*, L. R., 20 Eq., 346. The Master of the Rolls had this power by Judicature Act of 1873, sec. 17, sub.-sec. 6.

Clerical Errors in Applications for British Patents.

By the British Act of 1883, sec. 91, the comptroller may, on request in writing accompanied by the fee of five shillings up to sealing, and one pound after sealing, correct any clerical error in or in connection with the application for a patent, or in the name, style or address of the registered proprietor of the patent.

Common Law Right to Correct Clerical Errors.

Our Courts would appear to have a common law right to order the correction of clerical errors in specifications, etc., and

have so corrected them (see *Riech* v. *Hoerr, ante*), and our section 48 should be so worded as to empower the Commissioner of Patents to correct clerical errors, apparent on the face of the patent or specification, on payment of a fee, in the same manner as in Great Britain.

49. If any patent is destroyed or lost, a certified copy thereof may be issued in lieu thereof, upon the person who applied therefor paying the fees hereinbefore prescribed for office copies of documents. 35 V., c. 26, s. 49; the Patent Act (1886); 53 V., c. 13, s. 4 (1890).

In the Acts 1872 and 1886 instead of "a certified copy thereof," it was "another patent of the like tenor, date and effect"; the present reading was introduced by the Act of 1890. In the Act of 1872 it was "upon the party paying the fees"; the present reading dates from the Revised Act of 1886.

By section 50, certified copies, under the seal of the Patent Office, are receivable in evidence without production of the originals.

For a copy of a patent with specification the charge is $4, and 25c. for each sheet of drawings; there is no tariff charge for certifying to this copy of patent, and attaching the seal of Patent Office (Can.): See sec. 39.

Fees in U. S. for Copy of Patent.

In the United States for certified copies of patents, whether in manuscript or print:—

For the specification for every 100 words or fraction thereof	$0 10
For the drawings, if in print	0 25
For the drawings, if not in print, the reasonable cost of making them.	
For the certificate	0 25
For the grant	0 50

Proof of an Official Public Document.

For proof of an official public document, which comprises a patent of invention, sec. 12 of the Canada Evidence Act, 56 Vic.,

c. 31, provides that a copy of any official or public document of Canada purporting to be certified under the hand of the officer or person in whose custody such official or public document is placed, shall be receivable in evidence without proof of the seal or of the signature, or of the official character of the person appearing to have signed the same; if under the Patent Office seal, this will, of course, suffice: See sec. 50.

In Great Britain, by section 37 of the Act of 1883, if a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the Comptroller, the Comptroller may, at any time, cause a duplicate thereof to be sealed.

This may be done by an application in letter form to the Comptroller, Patent Office, 25 Southampton Buildings, Chancery Lane, London, W. C., setting out the date, number, name and full address of the patentee, the title of the invention, and state whether it has been destroyed or lost, and the interest of the applicant in the Letters Patent.

The fee for duplicate of Letters Patent of the United Kingdom is £2.

50. Every court, judge and person whomsoever shall take notice of the seal of the Patent Office and shall receive the impression thereof in evidence, in like manner as the impressions of the Great Seal are received in evidence, and shall also take notice of and receive in evidence, without further proof and without production of the originals, all copies or extracts certified under the seal of the Patent Office to be copies of or extracts from documents deposited in such office. 35 V., c. 26, s. 2, *part.*

The beginning part of section 2 of the Act of 1872, has now become the 6th section of this Act, while the rest of this section 2 with some verbal alterations is the foregoing section 50.

The "person whomsoever" referred to must be some one authorized to take evidence judicially, and refers to one such as an arbitrator, mentioned in section 19 relating to "*conflicting applications*," Part V.; in sub.-sec. 5, of sec. 19, such an one, when sworn, may summon any applicant or other person to give evidence on oath and to produce documents, in which case the arbitrator or

arbitrators might have to take cognizance of the Patent Office seal.

By the Canada Evidence Act (1893), official or public documents may, by section 12, be proved without proof of the seal of the corporation, or of the signature, or of the official character of the person or persons appearing to have signed the same.

Should a Canadian patent issue under the seal of the Patent Office, but without the signature of the Commissioner or Deputy Commissioner, would the Patent be void?

In U. S. A., a patent issued without the signature of the Secretary of the Interior, is void, and a subsequent signing will not make it valid from its issue, and it cannot be signed by a secretary whose term of office has expired: See *Marsh* v. *Nichols*, 15 Fed. Rep., 914, 24 O. G., 901.

51. No officer or employee of the Patent Office shall buy, sell or acquire or traffic in any invention or patent, or in any right to a patent; and every such purchase and sale, and every assignment or transfer thereof by or to any officer or employee, as aforesaid, shall be null and void, but this provision shall not apply to any original inventor, or to any acquisition by bequest. 35 V., c. 26, s. 4, *part*.

As to a Gift Inter Vivos.

In Canada this section also covers apparently a *gift* or any mode of acquiring, other than purchase; if this be so, it should read "*and every such purchase, sale or gift 'inter vivos,' etc., etc., shall be null and void, etc.*"

But then an employee may by this section expressly become possessed of an invention in Canada by bequest, which might be open to some of the same objections as in the case of a gift "*inter vivos.*"

If the officer or employee in the Canadian Patent Office be an original inventor, he can obtain a patent for his invention in Canada, and deal or traffic in the Letters Patent when obtained as much as he chooses; whereas in the U. S. A. a Patent Office employee cannot take out a patent.

Employees in U. S. A. Patent Office, etc

In U. S. A. *Patent Office employees* cannot take out patents while in that employment, and cannot acquire or take directly or

indirectly, except by inheritance or bequest, any right or interest in any patent (Rev. Stat., sec. 480). He who invents while in the Patent Office may properly patent it after he leaves it: *Foote* v. *Frost*, 3 Ban. & Ard., 607; *Page* v. *Telephone Co.*, 17 Blatch., 448.

In the United States one in the Government employ, other than the employ of the Patent office, is entitled to a patent in the absence of an agreement on his part that his invention shall be the property of the Government: See *Riley* v. *Bernard*, Commissioners' Decisions, 59 O. G., p. 1919.

52. The commissioner may, from time to time, subject to the approval of the Governor-in-Council, make such rules and regulations, and prescribe such forms, as appear to him necessary and expedient for the purposes of this Act,—and notice thereof shall be given in *The Canada Gazette;* and all documents, executed in conformity with the same and accepted by the commissioner, shall be held valid, so far as relates to proceedings in the Patent Office. 35 V., c. 26, s. 3.

Patent Office Forms (Can.)—Appendix 1.

There are a number of alterations and additions which might be advantageously made in the forms issued by the Patent Office (Can.). The petition should follow the wording of the Patent Act, 1886, instead of the Act of 1872—it should be up to date; "*others*" should be "*any other person*," "*and not being in public use, etc.*," should be "*and which has not been*" in public use, etc.; "*with his consent or allowance as such inventor*" should be "*with the consent or allowance of the inventor thereof*"; "*previous*" should now be "*previously*"; thus altering **Forms 1 to 5** inclusive so as to make them correspond with the present Revised Patent Act.

The serial number of the original patent should be set out in **Forms 6 and 7** relating to reissue.

When the petition is made by the executor or administrator, as in Form 5, it is stated, that a certified copy of letters of administration or of the will should be attached to the petition.

Form 13—Specifications.

The beginning and end of the specifications are merely given; there are four figures referred to, relating to *a planing machine*,

while the drawings, illustrating the specifications, show only two, which relate to a different class of machine altogether, while the lettering of course does not correspond to the specifications—the drawings given are of no use as they do not relate to this specification, so they are not inserted; the proper drawings should be substituted for these given for Form 13.

The title of the invention, though shown in the drawings in the Form, is now never called for:—At the bottom of the sheet of drawings is printed "*certified to be the drawings referred to in the specification hereunto annexed.*" The place and date—*witnesses*, under which two witnesses sign in the lower left-hand corner, and in the lower right-hand corner the inventor or his attorney signs.

Forms 17 to 22, Inclusive.

The form of oath might be improved by making it "*that I verily believe that I am the original, first and sole (or joint) inventor.*" A man might be an inventor, but unless he is an original or first inventor he is not entitled to a patent in Canada. Again, it should also be stated "*that the same has not been patented to himself (themselves) or to others, with his or their knowledge or consent, except in the following countries.* (Here insert, if previously patented, the country or countries in which it has been so patented, giving the date and number of each patent.) If not previously patented, erase the words "*except in the following countries*" and insert the words "*in any country.*" This would be after the U. S. Form, and the suggested alterations are material for the Canadian patent is limited to expire at the earliest date on which any foreign patent for the same invention expires, by section 8.

Forms 17 to 20, inclusive, should be altered as above indicated.

Form 21 should state that "*he is the original, first and sole inventor,*" etc. The consent of the assignees on reissue, referred to in the note to this Form 21, should be signed by them and filed, otherwise it is mere assertion.

Form 22 should read "that Thomas Tardy was, as I *verily believe*, the original, first and sole inventor"; the inventor only swears on belief, why then should an assignee be required to make

a positive statement as to a matter of which he can have no absolutely certain knowledge.

The oaths should not be stated to be taken before a J. P. only; now they may be taken before a Notary Public, Commissioner and others: See sub-sec. 2, sec. 10, Patent Act. A note to this effect should be made after each oath.

There is no form of oath for reissue by legal representatives, nor for an oath on application for a patent by legal representatives or by an assignee, if the inventor be dead in the case referred to in sub-sec. 2, of sec. 10. Nor is there any form provided for a license, a shop license, or for a territorial interest, forms which are constantly in demand, and liable to be registered in the Patent Office at Ottawa.

In Forms 24 and 25, the assignment should *not* be personal to the assignee, S. L., but to S. L., "*his legal representatives or assigns*" unless it is intended that S. L. should alone deal with the invention as now set out in these Forms: See cases noted on page 233. A receipt clause might also be added as well as "*signed, sealed and delivered in the presence of*" in the lower left-hand corner.

As to Disclaimer, Form 26, this should be revised and altered. It is only under exceptional circumstances that you can disclaim *a part* of a claim; that is when two or more inventions are included in one claim, when, if distinguishable, one may be expunged; in a case where a claim is worded "*with or without*" a certain element, either of the words "with" or "without" might be disclaimed, but you cannot disclaim a single element of a claim, for a claim is an entirety; by dropping a part out of a claim you may make a new combination which might be a subject for *reissue:* See note (*b*), section 24, Part VIII., where a new form is set out on pp. 199, 200.

As to the **Patent Office Record,** which is published monthly by the Government, there does not appear to be much use in merely giving the number of the trade mark, the date, and to whom granted, without giving the subject matter and an illustration, so one might know what the trade mark consisted of. **Designs** are not referred to at all, it would be a great improve-

ment if these were described and illustrated. The serial number of the application and the date of filing should also be given on the Letters Patent, this being very often required as bearing on the question of "*public use*," or being "*on sale*" (see section 7), "*abandonment*" (see section 46), *priority of invention, etc.* And reissues should have a serial number of their own so as to be distinguished, as in the (U. S.) O. G.

As the Patent Office Record, Canada, is not published for about six weeks after the date of issue of the Canadian patent, there is time for application for British and foreign patents before publication of the Record in Canada, or elsewhere, takes place. The Record is sent to public libraries in European countries, a few days after it is sent to regular subscribers; so prior publication should be guarded against when making foreign applications.

In the U. S. Official Gazette designs and trade marks are described and illustrated, and the information conveyed is very useful. Since January 16th, 1894, there has been added a list of expired patents, described and illustrated.

Rules and Regulations.

As to the rules and regulations, made by the Commissioner, he has held that he has no power to alter or suspend their operation, especially with relation to Rule 9, this is taken to be the subject for an appeal to the Governor-General-in-Council, so that the power to create has no power to either end or mend.

Under sub-sec. 44, sec. 7, of the Interpretation Act, R. S. C., it is provided "Whenever forms are prescribed, slight deviation therefrom not affecting the substances or calculated to mislead, shall not vitiate them."

By Patent Office Rule 6 (Can.), it is only where a form is not specially provided for any proceedings, that one is permitted to adopt a form conformable to the letter and spirit of the law, but slight deviations from the forms given, not affecting the substance or calculated to mislead, would be accepted.

Rule 9 of the Canadian Patent Office to the effect that an application for a patent in Canada must be perfected within two years after the lodging of the petition, in default of which it will be regarded as abandoned, and any fees paid will be forfeited,

has hitherto been very rigidly construed by the Commissioner of Patents in Canada.

With respect to application 57709 (filed August 24th, 1891), where the papers had been filed, but no fees paid, and the case had been neglected and allowed to stand for over two years without anything being done owing to the oversight, or neglect, or ill-health, of the Solicitor of Patents, who had meanwhile died, it was desired to pay the Government fee and have the case treated as a continuing application, owing to the fact that a little over a year previously an United States patent for the same device had been allowed to issue; it was also shown that the Canadian applicant had never any intention of abandoning the application, and it was only the death of her solicitor, who had failed to pay the fee, that caused enquiries to be made. The Deputy Commissioner held that there was no discretionary power to remove the case from the operation of this Rule 9.

It was urged in this case that in the States there was discretionary power under similar circumstances: See *Smith* v. *Dental Vulcanite Co.*, 93 U. S., 491 (1876) when extreme poverty was held sufficient excuse; incapacity to transact business through ill-health and mental disorder was sufficient excuse to negative *laches*: See *Ballard* v. *Pittsburgh*, 12 Fed. Rep., 784 (1882); and other reasons set out in section 91 of Walker on Patents.

An *abandoned application* in U. S. A., however, of a foreign applicant will not be revived upon a showing that the two years limit was allowed to expire without action, solely through the inadvertence of the associate attorney's clerk: *Ex parte Raeymaeckus*, 60 O. G., p. 1749 (1892).

And in *Ex parte Heine*, 64 O. G., p. 1006 (1893), failure to prosecute in U. S. Patent Office for more than two years after the last official action works abandonment by the statute, and in order to revive, unavoidable delay must be shown covering the entire period.

In the case of application No. 57729 (filed August 22nd, 1891), the papers had been returned from the Patent Office for amendment, but had been lost in the mail, and the two years had elapsed before any steps could be taken; the delay was further

rendered unavoidable, as the applicant lived in Australia. No neglect was shown by the applicant or his attorney, and the loss of the papers may have been due to neglect or carelessness in the Patent Office. It was also held here that there was no discretionary power under this Rule 9, and that the case had been abandoned.

As the Commissioner has power under this section 52 to make such rules and regulations and prescribe such forms as appear to him necessary and expedient for the purposes of the Act, subject to the approval of the Governor-in-Council, one would suppose that he would also have power to modify, enlarge, or have discretionary power over his own rules to meet the exigencies of such cases as we have just cited; but here there appears to be a rule which admits of no possible modification by him.

In this last case, however, if no foreign patent had been issued, or, if issued, a fresh application were filed in Canada within a year of the date of the first foreign patent, there is no reason why a fresh application should not be made, accompanied by the $20 fee—the fee previously paid being forfeited under rule 9—there being no abandonment to the public.

In the matter of this last-named application, No. 57729, there is an appeal to the Governor-General-in-Council pending.

Amendments to Pending Applications.

In Canada we have not, as is the case in the States, any form of *supplemental oath* to accompany a new or an enlarged claim in addition to that which was embraced in the claims originally made.

In Canada all sorts of amendments are allowed without any fresh oath; the new claims or amendments are usually initialled, although there is nothing to prevent you taking out whole pages and inserting others, so long as the page on which the name of the inventor is, be not destroyed.

It is suggested that the Patent Office Reports should contain reports of the judgments in patent trade mark, design and copyright cases, decided in the Provincial and Dominion Courts, the same as the U. S. Official Gazette; as matters now stand patent cases are rarely reported, there have been none reported in the

Ontario Reports since March, 1887, except one for a note given for a patent right: *Girvin* v. *Burke*, 19 Ont. Rep., 204 (1890), and *Johnson* v. *Martin*, of a similar nature, 19 App. Rep. (Ont.), p. 592, and *Noxon* v. *Patterson*, 16 Prac. Rep. (Ont.), and *Noxon* v. *Noxon*, 24 Ont. Rep.

In Quebec, since 1889, there has been only a headnote of a Supreme Court case from Ontario: *Wisner* v. *Coulthard*, reported in 1893, L. N., vol. 16, and none in the other Provinces; *Wisner* v. *Coulthard*, in the Supreme Court is fully reported in the Sup. Ct. Rep. (Can.), vol. 22, p. 178, *et seq.*, for comments on which see pages 38 and 39, *ante*.

53. The commissioner shall cause a report to be prepared annually and laid before Parliament of the proceedings under this Act, and shall, from time to time, and at least once in each year, publish a list of all patents granted, and may with the approval of the Governor-in-Council, cause such specifications and drawings as are deemed of interest, or essential parts thereof, to be printed, from time to time, for distribution or sale. 35 V., c. 26, s. 5; 36 V., c. 44, s. 1.

There is a list of patents published, monthly, in the "Canadian Patent Office Record," giving the serial numbers, dates, the claims and one or more of the principal figures of the drawings; this Record is now published by the Government, a couple of years ago it was a private enterprise, subsidized by the Government.

In 1889, there appear to have been 2,724 patents granted; in 1890, 2,428; in 1891, 2,342; while in 1892, the number of patents granted rose to 3,415; and in 1893, to 3,547; these numbers are serial numbers, and on December 31st, 1893, the number granted reached 44,989.

The first number of the "Canadian Patent Office Record" commenced in March, 1873; commencing with serial number 1,645, a patent for a sewing machine, dated 17th October, 1872, since which date up to the end of 1893, 43,344 patents have issued from the Canadian Patent Office. The number 1,645 mentioned, represents the number of patents issued since the Patent Act of 1872 came into force, before the "Record" was commenced.

In the U. S. at the close of the year 1891, the U. S. Patent

Office, at Washington, had issued 476,271 mechanical patents; at the close of 1892, 498,932 patents had been issued; and on December 5th, 1893, the number reached 510,394.

Volume 1, of the U. S. Official Gazette, commences with patent 122,304 for a car coupler, on the 1st January, 1872. The number of patents granted prior to the commencement of this series of numbering on July 28th, 1836, was 9,957.

Registration of labels in U. S. Patent Office practically ceased May 27th, 1891, under decision of the U. S. Supreme Court in *Higgins et al.* v. *Keuffel et al.*, 55 O. G., 1139. The last label was registered June 14th, 1892, as No. 6,545.

In the report of the Commissioner of Patents, U. S., see 62 O. G., p. 899 (1893), it appears in the U. S. Patent Office at Washington there are 605 employees, including 1 Commissioner, an Assistant Commissioner, 1 Chief Clerk, 2 Law Clerks, 3 Examiners-in-chief, an Examiner of Interferences, 32 Primary Examiners, 34 First Assistant Examiners, 38 Second Assistant Examiners, 43 Third Assistant Examiners, 52 Fourth Assistant Examiners and 136 Copyists.

There are in all 199 examiners, who have before them 40,000 applications for patents per year, involving 145,000 separate actions.

For the year ending December 31st, 1893, there were 37,293 applications for patents, 1,060 applications for designs, 120 applications for reissues, 2,247 caveats, 1,899 applications for trademarks, and 401 for labels. There were 23,670 patents granted, including designs; 99 patents were reissued and 1,677 trademarks were registered. The number of patents which expired was 14,172, the number of patents forfeited by operation of law for non-payment of final fees was 4,102.

At the beginning of 1894 the arrears of work amounted to 9,127 applications awaiting action, and one division was between seven and eight months behind.

At the date of the U. S. Commissioner's report for 1893, 521,700 American patents had been issued, and to the same period 817,362 foreign patents, so that in an examination as to novelty in the

U. S. Patent Office it had to be determined that the invention does not appear in any of these patents or in any book, pamphlet, periodical, or paper, in any language, either of U. S. A. or any other country: See report of Commissioner of January 31st, 1894, 66 O. G., p. 2051.

No Search as to Novelty, etc., and No Claims Before U. S. Act of 1836.

Prior to the U. S. Patent Act of 1836, during the era of imperfected patent law, patents were granted without examination by any Governmental agency for ascertainment of either the novelty or the utility of the asserted invention. It was sufficient that the petitioner "alleged" and "made oath" that he "believed" it to be new and useful. Upon this alone the patent issued, and the applicant was not required to, and did not, present any formal claim whatever.

Deficiency of Examiners in Canadian Patent Office.

As the United States Patent Office issues nearly ten times as many patents as we do in Canada, and has more than ten times the number of applications that we have here, and as 199 examiners are considered necessary to attend to this volume of business in the States, it follows that here in Canada, to efficiently attend to our examination of patents, we should have about twenty examiners, whereas the number is only three, or about one-seventh of what is considered indispensable in the United States. This does not arise from our examiners being in anywise more efficient.

As the U. S. Patent Office and American public suffer greatly from having unqualified persons practising therein as solicitors of patents; in the same report, 66 O. G., 31st January, 1894, the Commissioner reports as follows:

"PATENT BAR.

"The vast public and private interests involved in the just administration of the patent system demand that the practitioners before the Office, like those before the Federal Courts, shall be only those of ascertained moral and intellectual fitness. To this end it is respectfully recommended that legislation be had establishing a patent bar, which shall consist, in the first instance, of those counsellors-at-law

who are entitled to practice in the Federal Courts, and that the Commissioner of Patents, with the approval of the Secretary of the Interior, may establish rules and regulations for the admission, from time to time, of those found qualified, and who may be recommended for admission to the Federal bar of the State in which they reside, or in the manner and by those on whose recommendation admissions to the State bar are made by the State Courts where the applicants may reside. It is believed that under the guidance of a patent bar of recognized standing and repute the soliciting of patents would attain a regularity and dignity in the practice of the profession of the law which is otherwise unattainable, and that the first to gain under such a practice would be the meritorious inventors, and second only to them the industrial world and the public."

This recommendation is all applicable to Canada, where the status of Solicitors of Patents should be improved; as matters now stand in Canada, any person, without the slightest qualification, can hang out his sign as Solicitor of Patents, and call himself "*Counsellor and Expert in Patent causes.*"

As a matter of public policy Canadian inventors should have some protection, in this the most difficult and interesting branch of the law; a thorough legal training is absolutely necessary in order to ensure the best class of work, and the drawing of claims which may stand the test of a law suit; and fully as necessary is a technical training, such as is necessary for a mechanical or civil engineer; a patent solicitor should be well grounded in applied mathematics (mechanics, etc.), as well as in physical sciences (light, heat, electricity, chemistry, etc.), so as to be able to quickly and intelligently grasp all inventions pertaining to machines, as well as the physical sciences.

There should, undoubtedly, be some recognized standard of efficiency in Canada, embracing both the law and the subjects indicated, before one is permitted to practice in the Canadian Patent Office.

The Chartered Institute of Patent Agents.

In the United Kingdom by the Patent Act of 1888, section 1, "After the 1st July, 1889, a person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a patent agent, in pursuance of this Act."

It was further provided, among other things, that "If any person knowingly describes himself as a patent agent in contravention of this section, he shall be liable, on summary conviction, to a fine not exceeding twenty pounds."

Those who had been "*bonâ fide*" practising as patent agents at the date of the passing of the Act were entitled to registration without examination.

Since the passing of this Act it is necessary to qualify in order to become a member of "The Chartered Institute of Patent Agents," and the Board of Trade is empowered to pass rules, relative to qualification and admission.

On the 15th February, 1893, there were 232 firms of Patent Agents on the roll as practising in the United Kingdom; prior to this Act there were no means of excluding unqualified persons from practising as Patent Agents.

Qualification for Associate Members.

Foreign or colonial Patent Agents may become Associate Members without examination, provided they are, individually, upwards of twenty-five years of age, and in an established practice, and have no office and do not practice in the United Kingdom, but they must be proposed in writing by a Fellow and recommended by four Fellows of the Institute, all of whom must certify to a personal knowledge of the candidate and a full conviction of his qualifications.

Each foreign or colonial member must pay an entrance fee of two guineas and an annual subscription of one guinea.

PART XV.

Offences and Penalties.

54. Every patentee under this Act shall stamp or engrave on each patented article sold or offered for sale by him the year of the date of the patent applying to such article, thus: "Patented, 1886," or as the case may be; or when, from the nature of the article, this cannot be done, then by affixing to it, or to every package wherein one or more of such articles is or are enclosed, a label marked with a like notice; and any such patentee selling or offering for sale any such patented article not so marked, or not enclosed in a package so marked, shall be liable to a penalty not exceeding one hundred dollars, and in default of the payment of such penalty, to imprisonment for a term not exceeding two months. 38 V., c. 14, s. 3.

In the Act of 1872, sec. 49, there was a similar provision, except that the case of affixing a marked label to a package containing the patented article was not provided for. The foregoing is a copy of section 3 of the Patent Act Amendment of 1875 (Can.).

Article Must be Sold or Offered for Sale.

This section relates to a patented article "sold or offered for sale." So that if a patentee does not "sell or offer for sale" the patented article he is not liable to the penalty of one hundred dollars, even though he has manufactured the same and has neglected to mark the article as patented and with the year the patent issued. If the article itself is capable of being stamped or engraved, it must be so stamped or engraved under our Act; it is only when from the nature of the article itself that this cannot be done that it is permissible to mark a label and attach it to the article or to the package containing it.

In *Smith* v. *Walton* (decided May 31st, 1893), 64 O. G., p, 1789, because the article itself was not stamped "patented, etc.," when it was capable of being so stamped, but the mark was only on the crate, it was held that the defendants could not be liable. The provisions of the U. S. section are similar to ours in respect of marking.

By sec. 4900, U. S. Revised Statutes, it is declared to be the duty of the patentee, etc., to mark the patented article with the *day and year* the patent was granted, together with the word "*patented*" (in Canada the year alone suffices), so as to notify the public; the label for packages in the U. S. section is also provided for, our amendment in 1875 was no doubt adopted from this U. S. section; and in the States in any suit for infringement by the party so failing to mark, no damages shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement and continued after said notice, to make, use or vend the article so patented. The U. S. section relates to a person "*making or vending*" a patented article; ours to "*selling or offering for sale.*" The United States section, unlike the Canadian section 54, has no penalty in the nature of fine or im-

prisonment, but merely states that no damages may be recovered in an infringement suit: *Dunlap* v. *Schofield*, Sup. Ct., U. S. (March 7th, 1894), 67 O. G., p. 139.

Penalty in Canada for Failure to Mark.

In Canada we have no such provision with respect to damages in an infringement suit, and damages may be recovered whether the article was or was not marked *patented*, as required,—the penalty attached to not marking in Canada is fine not exceeding $100 or imprisonment not exceeding two months.

Illustrations in U. S.

In the United States the section has no application to a case where the infringer *makes and uses* the device: *Herring* v. *Gage*, 15 Blatch., 124.

The failure to mark in the States does not affect the right to an injunction, but only goes to the question of damages: *Goodyear* v. *Allen*, 3 Fish., 374.

It is for the defendant in U. S. A. to show the failure to mark the article "*patented*," and for complainant to show that the defendant was duly notified before suit brought: *Goodyear* v. *Allen*, *supra*.

The notice of infringement in the States may be either verbal or written: *New York Pharmical Association* v. *Tilden*, 14 Fed. Rep., 721.

A patentee in the States may enjoin another from issuing a circular stating that he manufactures articles under the patent, and the party issuing such circular can not in such a suit question the validity of the patent: *Washburn & Moen Manufacturing Company* v. *Haish*, 4 Ban. and Ard., 571. N. B.—In the same way and under similar circumstances there may be an estoppel in Canada, as to raising the invalidity of the patent.

The expression "stamp or engrave" in this section 54 is the same as in the U. S. Act of 1842. This has been changed in the present U. S. section of the Act of 1870 to "fixing thereon," and is the same as it now reads in U. S. Revised Statutes. A "painted notice" may not be said to be "*stamped or engraved*," and as the notices usually are painted, the term "fixing thereon" is

more comprehensive and applicable than the expression in the Canadian section.

As to Marking in France, Tunis, Turkey and Switzerland.

In France whoever in his advertisements, prospectuses, labels, stamps, etc., uses the word "*breveté*" or "*brevet*" (patented or patent), in connection with the patented article, without adding thereto, "*Sans garantie du Gouvernment*" (without guarantee of the Government), is liable to a fine of not less than $10, or more than $200. In the event of the offence being repeated the fine may be doubled. The initials *S. G. D. G.*, though almost universally used, have been held on one occasion not sufficient. The patentee is liable to the fine if he uses the mark after the patent has expired.

The law in Tunis and Turkey is the same as in France.

In Switzerland all patented articles must be marked with the Federal cross and the number of the patent.

No Provision in Canada for Marking the Package Itself.

In this section 54 no provision is made for marking the package itself containing the articles, but merely marking a label affixed to such package.

As to Marking as Patented in England and Germany.

In England, as in many other countries, there is no obligation to mark patented articles as such, but in most countries it is an offence to mark articles as patented which have not been protected.

In Germany, also, there is no obligation to mark the words "*Deutches Reichs Patent*" or the letters *D. R. P.*, which, however, it is recommended to put on the patented articles: See Edmund's, page 422.

The penalty for marking as patented that which was not patented, in England, is £5: See *Regina* v. *Crompton*, R. P. C., vol. 3, p. 367.

As to Marking "Patented" in U. S. A. After Expiry of Patent.

The manufacturer, in the U. S. A., of a patented article can continue to affix to it the word "patented" and the date, even after the patent has expired, without liability under sec. 4901, R. S., which prohibits the marking of any unpatented article "patented": *Wilson* v. *Singer Manufacturing Co.*, 9 Biss., 173, 12 Fed. Rep., 4 Ban. & Ard.

A manufacturer of a patented article, after the expiration of the patent has a right to represent that it is made according to the patent, and to use the name of the patentee for that purpose: *Wilcox & Gibbs S. M. Co.* v. *Gibben's Frame Co.*, 17 Fed. Rep., 623, 21 Blatch., 431.

55. Every person who writes, paints, prints, moulds, casts, carves, engraves, stamps or otherwise marks upon anything made or sold by him, and for the sole making or selling of which he is not the patentee, the name or any imitation of the name of any patentee for the sole making or selling of such thing, without the consent of such patentee,—or who, without the consent of the patentee, writes, paints, prints, moulds, casts, carves, engraves, stamps, or otherwise marks upon anything not purchased from the patentee, the words "patent," "letters patent," "Queen's Patent," "patented," or any word or words of like import, with the intent of counterfeiting or imitating the stamp, mark, or device of the patentee, or of deceiving the public and inducing them to believe that the thing in question was made or sold by or with the consent of the patentee or his legal representatives; or who offers for sale as patented any article not patented in Canada, for the purpose of deceiving the public, is guilty of a misdemeanour, and liable to a fine not exceeding two hundred dollars, or to imprisonment for a term not exceeding three months, or to both. 35 V., c. 26, s. 50.

The foregoing is practically the same as in the Act of 1872, with verbal alterations and rearrangement.

In the U. S. section 4901, which is to much the same effect as the foregoing, instead of "writes, paints, prints, etc.," it is "in any manner marks." The prolix wording which we retain, was taken from sec. 5 of the U. S. Patent Act of 1842. The U. S. section 4901 reads, "made, *used* or sold by him."

The Word "Used" Omitted from the Canadian Section.

The word "*used*" is omitted from the Canadian section, so that provided one does not *make* or *sell* in Canada a patented article falsely marked he is not within this section. The first part of the Canadian section refers to obtaining the consent of the patentee, the words "legal representatives or assigns" are in the U. S. section in this connection, but have been eliminated from ours, so no provision is made by us for the case of an assignee.

Although "the name or any imitation of the name of any patentee" is specifically referred to in the beginning of this section, it is not necessary or required either here or in the States to put the name of the patentee on the patented article, all that is necessary here is the word "*patented and the year*" when the article is patented (see section 54). In the U. S. it is in addition required that the day of the month should be added.

The Three Classes Covered by the Canadian Section 55.

Our section refers to three classes of events: (1) When a person makes or sells an article, for which another has obtained a patent, and who, without the authority of the patentee, marks the name or any imitation of the name of such patentee on the article made or sold by the unauthorized person.

(2) When a person makes an article, for which another has obtained a patent, and which was not purchased from the patentee, and without his consent, with the words "*patent*," "*Letters Patent*," "*Queen's Patent*," "*patented*," etc., with the *intent* of deceiving the public and inducing them to believe that such article was made or sold with the consent of the patentee or his legal representatives.

(3) When a person offers for sale as patented an article not patented in Canada, for the purpose of deceiving the public.

Our section should be more properly divided up into three distinct paragraphs.

A person is not complying with the law by merely putting a name on the article, or by merely putting the word *patent* or

patented on the article, as referred to in classes 1 and 2 *supra*; it should be "*patented*" *together with the year*, otherwise by section 54 he is liable to a penalty not exceeding $100, or in default of payment to imprisonment for not more than two months.

Under classes 2 and 3 *supra*, it will be necessary to show *an intent* to deceive the public, and under class 2 an intent to *counterfeit* or *imitate* the mark, etc., of the patentee.

Under class 2 the consent of the patentee or his legal representatives is, in one place, specifically referred to, whereas, in class 1 it is only the consent of the patentee, in both classes 1 and 2 it only refers to a "*making or selling*" in Canada, and not "*using*," and in class 2 it relates to an article not purchased from the patentee, it does not provide, as it should, for a purchase from a legal representative or an assignee.

Under class 3, a person might offer for sale, in Canada, an article which had been patented in the U. S., and there properly marked as "*patented*," with the day and year, and which had not been patented in Canada, in which case, provided it were shown that this was done for the purpose of deceiving the public, the party might be liable to the penalties of the section which are fine and imprisonment or both; it might, however, be difficult to prove an *intent* to deceive, for, in the instance just given, the whole transaction might have been *bonâ fide*, but done ignorantly.

In Canada there Must be an Offering for Sale.

Under class 3 there must, in Canada, be an "*offering for sale*," for the similar offence in the U. S. section the mere falsely marking constitutes the offence.

Under this 3rd class, at the end of our section 55, nothing is said about affixing to any unpatented article the word "patent" or anything importing that the same is patented, as is the case in the U. S. section 4901, paragraph 3; the wording of our section might cover a verbal offering for sale, as patented, an unpatented article, with intent to deceive. If *the marking as patented*, constitutes the offence, which is, probably, what is intended, it should be so stated.

This section 55 is distinctly a criminal one, and the commit-

ting of the offence set out therein is declared to be a "*misdemeanour.*" By section 535 of the Criminal Code of 1892, which came into force 1st July, 1893, it is provided: "After the commencement of this Act the distinction between felony and misdemeanour shall be abolished, and proceedings in respect of all indictable offences (except so far as they are herein varied), shall be conducted in the same manner."

In *Smith* v. *Walton*, 61 O. G. (U. S.), p. 289, the action was to recover $220,000 for affixing to 2,200 crates the words "patented" and "oval wooden dish," to imitate the mark of the plaintiff, the claim being under sec. 4901 R. S. (U. S.), being $100 for each separate offence.

It was held that the marks being on the crates and not on the articles sold, were outside the law and outside this section, and no penalty attached.

The Article Itself must be Falsely Marked.

In the same way, our section 55 does not relate to falsely marking a label attached to a package or the package itself, containing one or more of the articles (see section 54); this case is not provided for.

In our section 55, then, to constitute an offence, it will be necessary to falsely mark the article itself; a false mark on a package containing the articles, or on a label attached to such package, will no more suffice here to constitute an offence than is the case in the States.

Does Not Relate to a "Process."

It is also to be noted that neither this section 55 nor section 54 can relate to a "*process*" patent, as to which no penalty can attach under either of these sections.

In the U. S. sec. 4901, which corresponds to our section 55, there is a penalty attached of not less than $100 with costs, half of which go to the person who shall sue for the same and the other half to the use of the United States, to be recovered in any District Court of the United States within whose jurisdiction such offence may have been committed.

As to Penalty in Canada.

In Canada it is not stated what disposition shall be made of the money penalties under sections 54 and 55, nor is it stated that the person informing shall receive the half or any portion of the penalty.

Illustrations.

A corporation is responsible for the conduct of its superintendent in affixing the word *patented* to unpatented articles: *Tompkins* v. *Butterfield*, 25 Fed. Rep., 556.

Although a person affixes the word "*patent*" to an article with intent to imitate the mark or device of a patentee yet he is not liable unless the article is covered by the patent: *French* v. *Foley*, 11 Fed. Rep., 804.

With relation to the third class of cases, where the provision is nearly the same as in paragraph 3 of the U. S., sec. 4901, except that in Canada there must be an "*offering for sale*," and the *marking* is not specifically referred to, the following cases have been decided in the U. S. courts, which have a bearing also on our class 3. The penalty is incurred by marking an unpatented article with the word "patent," whether patentable or not: *Oliphant* v. *Salem Flouring Mills*, 3 Ban. & Ard., 256; *contra*, *U. S.* v. *Morris*, 3 Fish., 72.

If the article is patented, a person is not liable under this clause for affixing the word "*patent*," although he also puts on the article the date of another patent: *French* v. *Foley*, 11 Fed. Rep., 804.

The plaintiff must prove beyond a reasonable doubt in the States:—1. That the defendant affixed the word "patented" upon the article. 2. That the defendant has no patent. 3. That the defendant affixed the word with intent to deceive the public: *Nicholls* v. *Newell*, 1 Fish., 647.

What it is Necessary to Show in Canada.

In Canada it would be necessary to show beyond doubt:—1. That the defendant offered for sale as patented any article not patented (nothing is said about affixing the word "patent" or

"patented," nor is there anything to show that it may be more than a verbal representation). 2. That the defendant has no patent. 3. That the defendant offered for sale, as patented, an unpatented article, with intent to deceive the public.

There Must be Intent to Deceive.

In the States, the "*marking*" must be done "*malo animo*" with an intent to deceive; and this ingredient of the offence, which is essential to make it complete, must be left to and found by the jury: *Walker* v. *Hawxhurst*, 5 Blatch., 494. In the same way in Canada the Act must be done "*malo animo*" with intent to deceive.

Whether the alleged false marking was done with intent to deceive the public is, in ordinary cases, a question of fact, and the presumption is, until the contrary appears, that it was done with intent to deceive: *Oliphant* v. *Salem Flouring Mills*, 3 Ban. & Ard., 256.

A man is to be held to intend that which is the necessary consequence of his acts, or what he infers will be the consequence of his acts, and the burden of proof is upon the plaintiff: *Nichols* v. *Newell*, *supra*.

In the States the action cannot be prosecuted in the name of the United States; it should be prosecuted by an informer, who shall be responsible in case the action be not sustained for costs or other consequences resulting from its failure: *United States* v. *Morris*, 3 Fish., 72.

The penalty may be recovered in an action of debt, in the States, and the action may be brought at any time within five years after the commission of the offence: *Stimpson* v. *Pond*, 2 Curtis, 502.

Maximum Fine in Canada, $200.

There is nothing said as to the manner of recovering the $200 fine in Canada, or as to the infliction of the imprisonment, or what Courts have jurisdiction. In Canada the maximum money fine which may be inflicted is $200, no matter how many articles may have been falsely marked.

In the U. S. $100 for Each Offence.

In the U. S. not less than $100 is payable for each offence, the falsely marking each article constitutes each a separate offence, and we have shown in *Smith* v. *Walton*, 61 O. G., p. 289, the amount claimed may in this way be enormous.

There is nothing to show that the penalty, in Canada, is recoverable in an action for debt as is the case in the States.

False Trade Marks.

Sections 448–50, of the Criminal Code of 1892 (Can.), relate to selling goods, falsely marked with a forged trade mark or false trade descriptions.

56. Every person who wilfully makes or causes to be made any false entry in any register or book, or any false or altered copy of any document relating to the purposes of this Act, or who produces or tenders any such false or altered document in evidence, knowing the same to be such, is guilty of a misdemeanour, and shall be liable to be punished by fine and imprisonment accordingly. 35 V., c. 26, s. 51.

NOTE.—This is the same as in the Act of 1870, with a few verbal alterations and with the words "in evidence" inserted, referring the subject matter of the sections now to some judicial proceeding.

The section relates more particularly to employees of the Patent Office, but may include any one who falsifies a document issued from the Patent Office, or falsifies an award of arbitrators, or any other document referred to by this Act, as well as to those tendering the falsified document in evidence.

It is not stated what the extent of the penalty may be, but merely that it may consist of fine and imprisonment.

PART XVI.

Patents Issued Under Former Acts.

57. Every patent issued under any Act of the Parliament of Canada, or of the legislature of the late Province of Canada, or of the legislature of any Province now forming part of Canada, shall remain in force for the same term and for the same extent of territory as if the Acts under which they were issued had not been repealed, but subject to the provisions of this Act in so far as the same are applicable to them:

2. The commissioner may, upon the application of the patentee named in any such patent, who is the inventor of the subject matter of the patent, if the subject matter of the patent has not been known or used, and has not, with the consent of the patentee, been on sale in any of the other Provinces of Canada, issue, on payment of the proper fees in that behalf, a patent under this Act, extending such Provincial patent over the whole of Canada, for the remainder of the term mentioned in the Provincial patent. 35 V., c. 26, s. 32;—38 V., c. 14, s. 6.

Note.—Sub-section 1 can hardly have any force now, as any patents issued, therein referred to, must now have expired.

The Patent Act of 1869 was the first Patent Act passed since the Confederation of the Provinces of Upper and Lower Canada, Nova Scotia and New Brunswick by the British North America Act of 29th March, 1867, and it was thereby provided that all patents issued by the Province of Canada (which embraced Upper and Lower Canada), and of Nova Scotia and New Brunswick, and all patents issued for the Provinces of Ontario and Quebec by the Legislature of Canada, were to remain in force as provided in this sub-section 1. As the life of a patent was, prior to the Act of 1869, fourteen years, and since that time up to 1892 (when it became eighteen years), fifteen years, the patents here referred to have long ago expired.

By the Act of 1872, Consolidated Statutes of Canada, c. 34, 1859; c. 117, of the Revised Statutes of Nova Scotia (3rd series); c. 118, of the Revised Statutes of New Brunswick, and the Patents Ordinance (1867) of British Columbia, and the Patent Act of 1869 (Can.), and any Acts amending them, or any other

Act relating to patents, are repealed, so far as inconsistent with the Patent Act of 1872 (Can.).

By sec. 6, of the Act of 1875, 38 Vic., c. 14, s. 6, existing patents in Prince Edward Island were to remain in force, and might be extended to the Dominion on payment of proper fees. The Provincial Acts were repealed, and the provisions of the Patent Act of 1872 were extended to Prince Edward Island; and the records of the the Patent Office were directed to be handed over to the Patent Office, Ottawa, (Can.).

Sub-section 2 relates only to a patentee who is an inventor; it does not cover the case of a patentee who is assignee of the inventor and who obtains the patent as such assignee.

If the invention has not been "known or used" in any of the other Provinces, and has not been on sale in any of these other Provinces, with the consent of the patentee, the Provincial patent may be extended over the whole of Canada.

The term "known or used" have been discussed under note (*d*) and (*e*), sec. 7. "Public use" in the Provinces is not referred to.

The whole of this section is antiquated.

58. Every patent heretofore issued by the Patent Office in respect of which the fee required for the whole or for any unexpired portion of the term of fifteen years, has been duly paid according to the provisions of the law under which such patent was issued in that behalf, has been and shall be deemed to have been issued for the terms of fifteen years, subject, in case a partial fee only has been paid, to its ceasing on the same conditions in which patents hereafter issued are to cease under the operation of this Act. 46 V., c. 19, s. 1, *part.*

NOTE.—Section 17 of the Patent Act of 1872, which provided that patents should be valid for five, ten or fifteen years at the option of the applicant, but at or before the expiration of five or ten years the holder might obtain an extension, was repealed. And by 46 Vic., c. 19, sec. 1, patents were deemed to have been issued for *fifteen years*, but partial fees might be paid; but in such case the patent was to lapse at the end of five or ten years unless the remainder of the fee for the term of fifteen years was paid. The foregoing section 58, with two or three verbal alterations, forms the latter part of this sec. 1, c. 19, 46 Vic. (1875).

This legislation became necessary and was made retrospective owing to the fact that several Canadian patents, issued under the Act of 1872, had been held in U. S. A. to have been patents only for five years, and that the United States patents, granted for inventions previously patented in Canada, were held to have expired at the expiration of the first five years for which the Canadian patents had been granted.

In the case of *James Canan* v. *The Pound Manufacturing Co.*, tried in January, 1885, in the Circuit Court of the Northern District of New York, U. S. patent 218427, dated 12th August, 1879, was held to have expired on the 5th December, 1883, after the first five year term of Canada patent No. 9440. This case is reported in 23 Blatch., 173, also in 31 O. G., p. 119.

In *Reissner* v. *Sharp*, 16 Blatch., 383, tried in the Circuit Court of the Southern District of New York, in June, 1879, the U. S. patent granted 20th October, 1874, for seventeen years, was held to have expired on the 15th May, 1878—because a patent was granted in Canada for the same invention on the 15th May, 1873, for five years from that date, although in March, 1878, the Canada patent was extended for five years from the 15th May, 1878, and also five years from the 15th May, 1883.

In *Bate Refrigerating Company* v. *Gillett*, 13 Fed. Rep., 533, in the Circuit Court for District of New Jersey, August, 1882, and in the same Court in August, 1887, *Bate Refrigerating Company* v. *Hammond*, 31 Fed. Rep. 809, on the same facts, it was held that the United States patent expired when the original five year term of the Canadian patent expired.

This latter case, *Bate Refrigerating Company* v. *Hammond*, was appealed to the Supreme Court of U. S., which gave judgment on January 21st, 1889, reversing the Circuit Court decision and holding that "Where the Canadian statute under which the extension of the Canadian patent were granted, was in force when the U. S. patent issued, and also when that patent was applied for, and where, by the Canadian statute, the extension of the patent for Canada was a matter entirely of right, at the option of the patentee, on his payment of a required fee, and where the fifteen years' term of the Canadian patent had been continuous and without interruption, the United States patent does not expire before the end of the fifteen years' duration of the Canadian patent.

This case in the Supreme Court is reported in 19 Brodix, p. 231, 129 U. S., 151; see also *Consolidated Roller Mill Company* v. *Walker*, 54 O. G. 136 (September, 1890), where the expiry of a previous Austrian patent after five years, which might at the option of the patentee have been renewed for fifteen years, did not affect the life of the U. S. patent until the full fifteen year Austrian period had expired.

When the Expiry of a Foreign Patent Limits the Life of U. S. Patent.

In *Bate Refrigerating Company* v. *Sulzberger* (decided January 7th, 1893), U. S. Circ. Ct., S. Dist., N. Y., 65 O. G., p. 135, it was held that under R. S. sec. 4887, a U. S. patent expires with the date of a foreign patent granted prior to the date of the U. S. patent but subsequent to the application therefor, following *Bate Refrigerating Company* v. *Gillett, supra;* so that whether the foreign patent issues before or after the date of the U. S. applications appears to be immaterial. The U. S. section refers to an invention "which has been previously patented in a foreign country."

59. Every patent issued prior to the eighth day of April, one thousand eight hundred and seventy-five, under the Acts respecting patents then in force in Canada, shall extend over the Province of Prince Edward Island for the remainder of the term mentioned therein: 38 V., c. 14, s. 4, *part.*

The date mentioned in this section is the date on which 38 Vic., c. 14, was assented to when the Patent Act of 1872, and its amending Acts were extended to Prince Edward Island, and all patents for the Dominion of Canada issued prior to that date were extended to Prince Edward Island for the remainder of their respective terms.

The Patent Act of 1869 embraced the Provinces of Ontario, Quebec, Nova Scotia and New Brunswick. The Act of 1872 took in besides, British Columbia, Manitoba and the North-West Territories and Keewatin, while this Act of 1875, 38 Vic., c. 14, embraces Prince Edward Island, which completes the Dominion of Canada as now constituted.

N. B.—The foregoing may be said to complete the Revised Patent Act of 1886, and its amending Acts up to date. There

are, however, two small sections which have not been noted, and owing to the manner in which they are placed in the Amending Act of 1892, 55-56 Vic., c. 24, have not been embodied in the sections of the Patent Act of 1886. They, however, form part of the Act, and are as follows:—

SECTIONS 8 AND 9 OF 55-56 VIC., C. 24 (1892).

Sec. **8**. (Amending Act of 1892.) **On each application for a patent, a thorough and reliable examination shall be made by competent examiners to be employed in the Patent Office for that purpose. 55-56 V., c. 24, s. 8.**

In the note to *section 53*, it has been pointed out that, taking the U. S. Patent Office as a standard, where 199 examiners are employed, that in Canada we should have twenty examiners, whereas, we have only three, it could hardly be expected that these three could do as effectual work as twenty. To carry out the intention of this section (sec. 8, 55-56 Vic. [1892]), there does not appear at present to be enough examiners in the Canadian Patent Offices. This section 8 came into force 9th July, 1892: See section 9, *infra*.

Sec. **9**. (Amending Act of 1892.) **This Act shall only apply to patents issued after the passing hereof: 55-56 V., c. 24, s. 9.**

NOTE.—The Act referred to is the Patent Act Amendment, *supra*, which was assented to July 9th, 1892, and by it sec. 8, sub-sec. 3 of sec. 10, sec. 14, sec. 15, sec. 22, sub-sec. 1 of sec. 37, and sec. 39 of the said Patent Act of 1886, R. S. C. c. 61, were repealed and amended as hereinbefore set out: For amendments *vide* foregoing sections.

NOTE.—**In Appendix III.** appears the full text of the Patent Act of Canada as it stands amended subsequent to the Session of the House of Commons of Canada in 1894; it was proposed to amend the Patent Act in the recent session of 1894 in view of the decision in *The Queen* v. *La Force*, referred to in this work, but no amendment has been made.

The Act is c. 61, Revised Statutes of Canada (1886), as amended by the Amending Acts of 1888, 1890, 1891, 1892 and 1893, referred to on page 21 of this work.

CHAPTER III.

"On Bills or Notes Given for Patent Rights."

By sub-sections 4, 5 and 6 of section 30, of the Bills of Exchange Act (D), c. 33, 53 Vict. (1890), it is provided as follows:—

Sec. 30, s. s. 4. Every bill or note the consideration of which consists, in whole or in part, of the purchase money of a patent right, or of a partial interest, limited geographically or otherwise, in a patent right, shall have written or printed prominently and legibly across the face thereof, before the same is issued, the words "given for a patent right": and, without such words thereon such instrument and any renewal thereof shall be void, except in the hands of a holder in due course without notice of such consideration:

S.s. 5. The indorsee or other transferee of any such instrument having the words aforesaid so printed or written thereon, shall take the same subject to any defence or set off in respect of the whole or any part thereof which would have existed between the original parties:

S. s. 6. Every one who issues, sells or transfers, by indorsement or delivery, any such instrument not having the words "given for a patent right" printed or written in manner aforesaid across the face thereof, knowing the consideration of such instrument to have consisted. in whole or in part, of the purchase money of a patent right, or of a partial interest, limited geographically or otherwise, in a patent right, is guilty of a misdemeanour, and liable to imprisonment for any term not exceeding one year, or to such fine, not exceeding two hundred dollars, as the court thinks fit."

The foregoing sub-sections 4, 5 and 6 are a re-enactment, with alterations and additions, of 47 Vic., c. 38 (1884), being "An Act for the better prevention of Fraud in connection with the Sale of Patent Rights" (assented to 19th April, 1884). This Act of 1884 appears in the Revised Statutes of Canada (1886), as secs. 12, 13 and 14 of c. 123, "An Act respecting Bills of Exchange and Promissory Notes."

Addition to Revised Statutes of Canada (1886), c. 123, s. 12.

In sub-sec. 4 of sec. 30, 53 Vic., c. 33, Bills of Exchange Act (1890), where "every bill or note" occurs, the original Act of 1884 had "a bill of exchange or promissory note," but there is an important

addition at the end of this sub-section 4 of section 30, which there appears for the first time, viz.: "And without such words thereon such instrument and any renewal thereof shall be void, except in the hands of a holder in due course without notice of such consideration."

Decision in Girvin v. Burke, 19 Ont. Rep.

This addition was made in consequence of a decision of the C. P. Divisional Court (Ont.) in *Girvin* v. *Burke*, 19 Ont. Rep., p. 204 (1890), in which it was held, that the omission of the prescribed words did not make the note void as between the maker and the payee, and that it was the intention of the Act to put the transferee into the position of the payee as to any defence the maker might have against the payee, and even if the words were necessary, the maker had a right to and could waive having the same thereon.

So that *now*, since the Bill of Exchange Act (1890), unless the words **"given for a patent right"** are written or printed prominently and legibly across the face of such bill or note, or any renewal thereof, it is void between the original parties; but if such words are not written or printed thereon, even though given for a patent right, such note may be good in the hands of a holder in due course without notice of such consideration.

A Holder in Due Course Defined.

"A holder in due course" by sec. 29 of the said Bills of Exchange Act (1890), "is a holder who has taken a bill, complete and regular in the face of it, under the following conditions, namely:—

"(*a*) That he became the holder of it before it was overdue and without notice that it had been previously dishonoured, if such was the fact;

"(*b*) That he took the bill in good faith and for value, and that at the time the bill was negotiated to him he had no notice of any defect in the title of the person who negotiated it."

When Title is Defective.

By sub-section 2 of section 29, Bills of Exchange Act: "In particular, the title of a person who negotiates a bill is defective within the meaning of this Act when he obtained the bill, or the acceptance thereof, by fraud, duress, or force and fear, or other unlawful means, or for an illegal consideration, or when he negotiates it in breach of faith, or under such circumstances as amount to a fraud": 53 V. c. 33, s. 29, s. s. 2.

Right of Subsequent Holder.

By sub-section 3 of section 29, Bills of Exchange Act: "A holder, whether for value or not, who derives his title to a bill through a holder in due course, and who is not himself a party to any fraud or illegality affecting it, has all the rights of that holder in due course as regards the acceptor and all parties to the bill prior to that holder." 53 V., c. 33, s. 29, s. s. 3.

By sub-sec. 5, sec. 30, Bills of Exchange Act (1890), the alteration made in the original Act of 1884, is immaterial, the word "indorsee" being merely substituted for "endorsee"; the former is also the reading in R. S. C., c. 123, s. 13.

By sub-sec. 6, sec. 30, Bills of Exchange Act, the alterations made in the original Act (1884), are also immaterial, "Every one" being substituted for "Any one," "is guilty" is substituted for "shall be guilty," and "liable to imprisonment" is substituted for "be imprisoned in any goal or other place of confinement," and it now reads, "as the court thinks fit," instead of as formerly in the Act of 1884 "as the judge may think fit." These changes first appear in the Revised Act (1886), c. 123, s. 14.

Sub-section 6, sec. 30 of the Bills of Exchange Act (1890), is the only part of the said Act in which a criminal offence is imputed, and provided for, the Act otherwise relating to civil rights and remedies, to notes and bills of exchange.

The meaning of the term "*issues*" in this sub-section 6, section 30, of the Bills of Exchange Act of 1890, means "*the first delivery of a bill or note complete in form to a person who takes it as a holder*": See Chalmers on Bills, 3rd ed., p. 6; see also *Attorney-General* v. *Birkbeck*, 12 L. R., Q. B. D., 605, at p. 610.

As the C. P. Divisional Court (Ont.) in *Girvin* v. *Burke*, 19 Ont. R. 210, held that the prescribed words **"given for a patent right"** were designed for the makers protection as against transferees for value from the payee, and that the prescribed words might be omitted at the pleasure of the maker without making him amenable to the penal clause contained in the 14th section of the Revised Act (1886), c. 123. This 14th section, according to this view of the state of the law, appears nugatory: but see *Johnston* v. *Martin*, 19 App. R. 592, *infra*.

The Object of Words "Given for a Patent Right."

In *Girvin* v. *Burke*, MacMahon, J., in his judgment in the Divisional Ct. C. P. of March 8th, 1890, states, on p. 209, "in the judgment of my brother Rose at the trial, he, I think, clearly interprets what was the object of the Legislature in requiring the words 'given for a patent right' to be written or printed prominently and legibly across the face of such notes: viz., to give the indorsee or transferee notice, and to put him 'in the position of payee as to any defence which the maker may have against a claim by the payee.'"

Mr. Justice Rose states that the cases are collected, and the law summarized in the 2nd ed., Maxwell on Statutes, p. 487, *et seq.*

In *Girvin* v. *Burke*, p. 211, *supra*, it is laid down "that nothing is better settled than that between the original parties to a note for a patent right it is a good defence to show that the alleged patent right is void; in other words that it is no patent right at all, and that the consideration has therefore entirely failed."

Johnson v. *Martin*, 19 App. R. Ont., p. 592, was the case of a promissory note made before the coming into force of the Bills of Exchange Act, 1890, in which judgment was given in the Court of Appeal (Ont.), Oct. 3rd, 1892.

The consideration for the note was the purchase money of a patent right without having the words "**given for a patent right**" written or printed across its face when taken by the payee, or when transferred by him as required by R. S. (Can.), c. 123, secs. 12-14; it was held void in the hands of an indorsee for value, with notice of the consideration. The judgment of the County Court Judge of Lennox and Addington was reversed.

The new clause added at the end of sub-section 4, sec. 30, of the Bills of Exchange Act (1890), if it had been in force, would most certainly have barred the claim, but even without this clause the claim was barred by the Court of Appeal (Ont.).

As to the statement of the C. P. Divisional Court in *Girvin* v. *Burke*, p. 210, 19 Ont. Rep., that the words "*given for a patent right*" might be omitted at the pleasure of the maker without making him amenable to the penal clause, Hagarty, C. J., in his judgment in *Johnson* v. *Martin*, *supra*, takes the opposite view and refers to Pollock on Contracts, 5th ed., p. 279. It is there stated as fully established by *Bensley* v. *Bignold*, 5 B. & Ald., 335:

"The imposition of a penalty by the Legislature on any specific act or omission is *prima facie* equivalent to an express prohibition."

And again at p. 280 (Pollock): "What the law forbids to be done directly cannot be made lawful by being done indirectly." Citing *Booth* v. *Bank of England*, 7 Cl. & F., 509, at p. 540.

As to the law as it now stands. Osler, J. A., in his judgment in *Johnson* v. *Martin*, states, 19 App. R. (Ont.), p. 599, as follows:

"An amendment of the Act, now section 30, sub-secs. 4, 5 and 6 of the Bills of Exchange Act, made since this action was commenced, which declares that notes not stamped with the words 'given for a patent right' shall be void, except in the hands of a holder in due course without notice of such consideration, does not appear to me to affect the case. I cannot regard it as in effect declaratory of the former law, by implication affirming that until it was passed there was no defence to the holder of such a note not stamped who took it with notice of the consideration. The law is now made more stringent, and places the holder, whether payee or transferee with notice in a worse position than he formerly was."

Johnson v. *Martin*, reported in Can. L. J., vol. 28, p. 540 (1892). *Held*, that the original holder, having committed a misdemeanour in accepting the notes without the words "*given for a patent right*" and a further misdemeanour, in which plaintiff participated, in transferring them to the plaintiff without these words, the plaintiff could not in any event recover.

Penalties Prescribed.

Giving a bill or note now or transferring such by endorsement or delivery, the consideration being the purchase money or partial purchase money of a patent right, or for a license, without the words "given for a patent right" printed or written across the face of such bill or note is a misdemeanour, and renders a person so offending liable to imprisonment for any term not exceeding one year or to such fine not exceeding two hundred dollars as the Court thinks fit.

The penalty for not using the prescribed words is fine or imprisonment and not both, this penalty is a very important consideration, and is liable to be overlooked when buying or selling Letters Patent of Invention or an interest therein.

When a Note is Good Without the Prescribed Words.

If, however, the note or bill or any renewal thereof without the prescribed words was taken without notice of the considera-

tion, before it was overdue, or without notice that it had previously been dishonoured, and that it was taken for value and in good faith, and that at the time the note or bill was negotiated the holder had no notice of any defect in the title of the person who negotiated it, then it is a valid note, even though the words "*given for a patent right*" are not written or printed prominently and legibly across its face. (See definition of holder in due course on p. 642.)

The Prescribed Words to be on the Face of the Note.

It is to be noted that these words may be written or printed legibly, and must be on the face of the note and not endorsed on it.

Provisions Extend to Licenses, etc.

The expression "a patent right, or of a partial interest, limited geographically or otherwise, in a patent right," which occurs in sub-sections 4 and 6 of section 30 of the Bills of Exchange Act, 1890, indicates that this portion of the Act relates also to bills or notes given for licenses to make or use the patented invention in Canada or any part thereof, and covers an act or process, a machine, a manufacture or composition of matter as defined in note to sub-section *(c)*, section 2, on pages 22, 23, 24 and 25 of this work.

In *Samuel* v. *Fairgrieve*, 24 O. R., p. 486, *et seq.*, the head-note is :—

Where part of the consideration for the transfer of a patent right from one partner to another was the giving, at the plaintiff's suggestion, of the notes of the firm for the individual debt of the transferor to the plaintiffs :—

Held, that under sub-section 4 of section 30 of the Bills of Exchange Act, 53 Vic., ch. 33 (D.), the words "given for a patent right" should have been written across the notes so given : and in the absence thereof, the plaintiffs could not recover. (Reported also in 30 Can. L. J., p. 278.)

The action was on three promissory notes made by the defendants, payable to the order of the plaintiffs. The defence was that part of the consideration for the notes was the assignment of a patent right, and that the notes should have had the words "given for a patent right" endorsed thereon.

At the Autumn Chancery Sittings, Robertson, J., found for the plaintiffs. On appeal to the C. P. Divisional Court, by judg-

ment of December 30th, 1893, the original judgment was unanimously reversed.

In this case Fairgrieve was individually indebted to plaintiffs, subsequently he entered into partnership with Craig as "Fairgrieve & Craig." In order to get this firm's notes to cover Fairgrieve's individual indebtedness, it was suggested by one of the plaintiff firm that Craig should purchase one-half interest in Fairgrieve's patent, which was accordingly done, $500 of the consideration being represented in the three notes, amounting in all to $1,000, given by Fairgrieve and Craig to plaintiffs.

The original judgment against the defendant Fairgrieve was not moved against, but the appeal of Craig was allowed, as the words required by the section were not written or printed across the notes sued on.

McMahon, J., states: "If the argument of counsel for the plaintiffs were to prevail, the Act might be contravened, and such bills or notes rendered valid, if a creditor could show a legal liability on the part of the debtor in payment of which the debtor had given the joint and several note of himself, and a person to whom he had assigned a part interest in a patent. * *

"The Act is aimed at bills and notes where the consideration therefor is wholly or partially for an interest in a patent right."

On May 15th, 1894, the foregoing judgment in *Samuel* v. *Fairgrieve*, 24 Ont. Rep., p. 486, was appealed against in the Court of Appeal (Ont.), on the part of the plaintiffs, and judgment was reserved.

Marking Notes Given for Patent Rights in U. S. A.

State statutes compelling under penalty a distinguishing mark to be placed on notes given for patent rights, have been declared invalid, being in conflict with the Constitution of the United States: See *Ohio State* v. *Peck*, 25 Ohio St., 26; *Helm* v. *First National Bank*, 43 Ind., 167; *Cranson* v. *Smith*, 37 Mich., 309; *Holliday* v. *Hunt*, 70 Ill., 109; *Wisconsin State* v. *Lockwood*, 43 Wis., 403; *Bowen* v. *Kemmun*, 2 Pearson (Pa.), 250; *Haskcall* v. *Whitmore*, 19 Me., 102; *Patterson* v. *Commonwealth*, 11 Bush. (Ky.), 311; *Welch* v. *Phelps*, 25 O. G. 981.

In *Pennsylvania*, however, such statutes have been upheld: See *Haskell* v. *Jones*, 86 Pa. St., 170.

RULES AND FORMS

OF THE

CANADIAN PATENT OFFICE.

1892.

APPENDIX I.

PATENTS OF INVENTION.

RULES, REGULATIONS AND FORMS

OF THE

CANADIAN PATENT OFFICE.

1. A personal appearance of the applicant or his representative at the Patent Office is not required unless specially called for by the Commissioner or Deputy Commissioner.

2. In all cases the applicant or depositor of any paper is responsible for the merits of his allegations and the validity of the instruments furnished by him or his agent.

3. Correspondence may be carried on either with the applicant, or his agent, but only with one person, and will be conveyed through the Canadian mails free of charge.

4. All documents must be legibly and neatly written or printed on foolscap paper (13 inches long and 8 wide), with an inner margin of one inch and a-half wide.

5. All communications are to be addressed—"*The Commissioner of Patents, Ottawa, Canada.*" Papers forwarded to the Office should be accompanied by a letter, and a separate letter should be written on every subject.

6. As regards proceedings not specially provided for in the accompanying forms, any other form being conformable to the letter and spirit of the law may be accepted, and if not conformable therewith will be returned for correction.

7. Models must be neat and substantial working ones, not exceeding 12 inches on the longest side, unless otherwise allowed by special permission; models must be so constructed as to show exactly every part of the invention claimed and its mode of working. In cases where samples of ingredients are required by law, they must be contained in glass bottles properly arranged; but dangerous or explosive substances must not be sent. Both models and bottles must bear the name of the inventor, the title of the invention and date of the application; they must be furnished to the Patent Office free of charge and in good order.

8. All fees required by law should be transmitted with the application for any action by the office, in current bankable funds, inclosed in registered letters. Bank drafts, money orders, and cheques which must be certified, should be made payable to "The Commissioner of Patents, Ottawa." *In no case should money be inclosed with models.*

9. An application for a patent must be proceeded with and perfected within two years after the lodging of the petition, in default of which it will be regarded as abandoned, as well as all proceedings had in relation thereto, and any fees paid will be held at the expiration of that period to be forfeited.

10. Two or more separate inventions cannot be claimed in one application, nor included in one patent. But if separate matters are represented to be so dependent on, and connected with each other as to be necessarily taken together, to obtain the end sought for by the inventor, the Commissioner of Patents shall be the judge whether or not the pretentions of the applicant in such respect can be entertained.

11. The filing of a protest against the issuing of a patent shall not be taken in itself as sufficient reason to withhold the granting of such patent to an applicant.

12. A *Caveat* can only be filed by an inventor and shall be composed of a specification (*and drawings*), certified on oath [Form No. 23] and the applicant may, while it is pending, lodge additional papers, provided they relate exclusively to the same

invention. The person filing a *Caveat* will not be entitled to notice of any application pending at the time of filing his *Caveat*. A *Caveat* must be limited to a single invention.

The specification of a *Caveat* should be sufficiently precise to enable the Office to judge whether there is a probable interference when a subsequent application is filed.

13. Drawings in duplicate to be attached to the duplicate specification must be made in India or carbon ink, on sheets of tracing linen (eight by thirteen inches), neatly executed and without colours. [Form No. 14].

All drawings must be clear, sharp, well-defined, not too fine *and perfectly black.*

Lines that are pale, ashy, very fine, ragged or rotten, give bad results when photo-lithographed.

Brush-shading, tinting and imitation surface graining should never be used; and in fine shading the result should be attained with as few lines as possible.

Section lines also should be as open in their spacing as the case will admit of, and these, as well as all right lines, in order to insure clearness, should be made with a ruling pen. The shading of convex and concave surfaces may be dispensed with when the invention is otherwise well-illustrated.

Shade lines may sometimes be used with good effect, but heavy shadows where they would obscure lines or letters of reference, should be avoided.

With each application an extra drawing must be supplied for the Patent Office Record, on a sheet of Bristol Board 8 by 13 inches, without writing on its face, merely the usual lettering; no title, certificate, nor signatures; on the back of the sheet the name of the inventor and the title of the invention must be written in pencil.

Where several figures are furnished, any one figure which will best give a general idea of the invention will be sufficient.

The cardboard to be used must have a smooth or calendered surface; a sheet of "double thick Bristol Board," or "Whatman's drawing paper," is recommended.

The cardboard drawing should be rolled on a roller for transmission to the Office, as folding will prevent its usefulness for photo-lithographing.

A sample cardboard drawing will be furnished on application.

14. In the matter of a reissue, under section 23 of the Act, whatever is really embraced in the original application and so described or shown in the same, that it might have been embraced in the original patent, may be ground for a reissue. No new matter can be introduced into the specifications, nor shall the models or drawings be amended except each by the other. In the absence of model or drawing, the reissue may contain amendments, upon satisfactory proof to the Commissioner that such amendments were part of the invention, although omitted in the original application. Separate patents may be issued for each separate and distinct part of the invention, comprehended in the original patent.

15. Information in relation to pending cases will be furnished only so far as it becomes necessary in conducting the business of the Office.

16. The Office can not respond to inquiries as to the probability of an alleged invention being patented in advance of an application for a patent; nor to inquiries founded on brief or imperfect descriptions, propounded with a view of ascertaining whether alleged improvements have been patented, nor unless the name of the patentee, and, as nearly as possible, the date of the patent be given; nor can it act as an expounder of the Patent Law, nor as counsellor for individuals, except as to questions within the Office.

In order to avoid unnecessary explanations and useless loss of time and labour, it is particularly recommended that reference be made to the law before writing on any subject to the Patent Office.

A copy of the Rules with a particular section marked, sent to any person making an enquiry, will be deemed a respectful answer by the Office.

17. It is desirable, in the interest both of the applicant and of the public service, that the papers and drawings should be prepared by competent persons, as despatch and regularity in the proceedings will be thereby promoted.

18. All business with this Office should be transacted in writing. The action of the Office will be based exclusively on the written record. No attention will be paid to any alleged verbal promise or understanding in relation to which there is any disagreement or doubt.

19. Assignments of patents are to be accompanied by a copy thereof; the original will be kept in the Patent Office, and the copy will be returned to the person sending it, with certificate of registration thereon.

20. All cases connected with the intricate and multifarious proceedings arising from the working of the Patent Office, which are not specially defined and provided for in these Rules, will be decided in accordance with the merits of each case under the authority of the Commissioner; and such decision will be communicated to the interested parties in writing.

PATENT OFFICE FORMS.

PETITIONS.

Form 1.

BY A SOLE INVENTOR.

To the Commissioner of Patents, Ottawa :

The petition of John Smith, of the City of Toronto, in the Province of Ontario, carpenter, showeth :

That he hath invented new and useful improvements in machines for breaking stones, not known or used by others before his invention thereof, and not being in public use or on sale, with his consent or allowance as such inventor, for more than one year previous to his application, for a Patent therefor in Canada.

Your petitioner therefore prays that a Patent may be granted to him for the said invention, as set forth in the specification in duplicate relating thereto, and, for the purposes of the Patent Act, your petitioner elects his domicile in the City of Ottawa, Province of Ontario.

John Smith.

Toronto, 1st September, 1887.

See note to sec. 52, p. 435.

Form 2.

BY JOINT INVENTORS.

To the Commissioner of Patents, Ottawa :

The petition of James Thomas, blacksmith, and George Robert Major, tinsmith, both of the City of Ottawa, in the County of Carleton, in the Province of Ontario, showeth :

That they have jointly invented a new and useful improvement in the art or process of separating smut from wheat, not known or used by others before their invention thereof, and not being in public use or on sale, with their consent or allowance as such inventors for more than one year previous to their application for a Patent therefor, in Canada.

Your petitioners, therefore, pray that a Patent may be granted to

them jointly for the said invention as set forth in the specification in duplicate relating thereto, and, for the purposes of the Patent Act, your petitioners elect their domicile in the City of Ottawa, Province of Ontario.

JAMES THOMAS.
GEORGE ROBERT MAJOR.

OTTAWA, 1st September, 1887.

See note to sec. 52, p. 435.

FORM 3.

BY AN ASSIGNEE, OR LEGATEE, "MUTATIS MUTANDIS."

To the Commissioner of Patents, Ottawa:

The petition of Solomon Lang, of the City of Boston, State of Massachusetts, one of the United States of America, laborer, showeth:

That Thomas Tardy, of the City of Ottawa, Province of Ontario, saloon-keeper, hath invented new and useful improvements in planing machines not known or used by others before his invention thereof, and not being in public use or on sale, with the consent or allowance of the said Thomas Tardy as such inventor, for more than one year previous to this application, for a Patent therefor in Canada.

That your petitioner, by assignment bearing date 1st September, 1887, acquired the right of obtaining a Patent from Thomas Tardy, aforesaid, for the said invention.

Your petitioner therefore prays that a Patent may be granted to him, as the assignee of the said Thomas Tardy, for the said invention as set forth in the specification in duplicate relating thereto, and for the purposes of the Patent Act, your petitioner elects his domicile in the City of Ottawa, Province of Ontario.

SOLOMON LANG.

NEW YORK, 1st September, 1887.

See note to sec. 52, p. 435.

FORM 4.

BY AN INVENTOR AND AN ASSIGNEE.

To the Commissioner of Patents, Ottawa:

The petition of John Smith, of the City of Toronto, in the Province of Ontario, carpenter, and David Brown, of the City of New York, in the State of New York, one of the United States of America, painter, showeth:

That the said John Smith hath invented new and useful improvements in machines for breaking stones, not known or used by others

before his invention thereof, and not being in public use or on sale, with his consent or allowance as such inventor, for more than one year previous to this application, for a Patent therefor in Canada.

That by assignment, dated on the 1st September, 1887, the said John Smith transferred to the said David Brown, an undivided one half interest in the said invention

Your petitioners therefore pray that the Patent may be granted to them jointly for the said invention as set forth in the specification in duplicate relating thereto, and, for the purposes of the Patent Act, your petitioners elect their domicile in the City of Toronto, Province of Ontario.

JOHN SMITH,
DAVID BROWN.

TORONTO, 1st September, 1887.

See note to sec. 52, p. 435.

FORM 5.

BY AN ADMINISTRATOR OR EXECUTOR.

To the Commissioner of Patents, Ottawa:

The petition of James Clayton, of the City of Kingston, in the Province of Ontario, stone-cutter, administrator of the estate (or executor of the last will and testament) of Thomas Clayton, in his lifetime, of the said City of Kingston, deceased, millwright (as reference to the duly certified copy of letters of administration (or letters testamentary) hereto annexed will more fully appear), showeth:

That the said Thomas Clayton did invent a new and useful composition of matter for making artificial stone, not known or used by others before his invention thereof, and not being in public use or on sale, with the consent or allowance of the said Thomas Clayton as such inventor, for more than one year previous to this application for a Patent therefor, in Canada.

Your petitioner therefore prays that a Patent may be granted to him as administrator (or executor) of the estate of the said Thomas Clayton for the said invention, as set forth in the specification in duplicate relating thereto, and for the purposes of the Patent Act, your petitioner elects his domicile in the City of Ottawa, Province of Ontario.

JAMES CLAYTON.

KINGSTON, 1st September, 1887.

See note to sec. 52, p. 435.

FORM 6.

FOR A REISSUE (BY THE INVENTOR).

To the Commissioner of Patents, Ottawa:

The petition of Thomas Brown, in the City of Ottawa, in the Province of Ontario, lumber manufacturer, showeth:

That your petitioner obtained a Patent bearing date the twelfth day of August, A.D. 1886, for a new and useful improvement in churns.

That the petitioner is advised that the said Patent is deemed defective or inoperative by reason of insufficient description or specification, and that the errors arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention.

Your petitioner being desirous of obtaining a new Patent in accordance with the amended description and specification in duplicate, therefore prays that he may be allowed to surrender the aforesaid Patent, and a new Patent be granted to him, in accordance with the amended description and specification of the said invention, for the unexpired period for which the original Patent was granted.

THOMAS BROWN.

OTTAWA, 1st September, 1887.

See note to sec. 52, p. 435.

FORM 7.

FOR A REISSUE (BY THE ASSIGNEE).

To the Commissioner of Patents, Ottawa:

The petition of David Lane, of the Town of Cobourg, in the County of Northumberland, Province of Ontario, tanner, showeth:

That your petitioner, by assignment, bearing date the 24th day of June, 1887, obtained the exclusive right to a Patent granted to Thomas Tardy, of the City of Ottawa, Province of Ontario, broom maker, on the 1st of July, 1885, for new and useful improvements in planing machines.

That your petitioner is advised that the said Patent is deemed defective or inoperative by reason of insufficient description or specification, and that the error arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention.

Your petitioner being desirous of obtaining a new Patent in accordance with an amended description and specification in duplicate, therefore prays that he may be allowed to surrender the aforesaid Patent, and that a new Patent be granted to him, as assignee of the said Thomas Tardy, in accordance with the amended description and specification of

the said invention, for the unexpired period for which the original Patent was granted.

DAVID LANE.

COBOURG, 1st September, 1887.

(The above form is to be altered to suit the case, when the reissue is to the administrator or executor of a deceased inventor.)

See note to sec. 52, p. 435.

FORM 8.

SURRENDER TO BE WRITTEN ON THE ORIGINAL PATENT.

To all to whom these presents shall come, Thomas Brown, of the City of Ottawa, in the Province of Ontario, lumber manufacturer, within named, sends greeting:—

Whereas the within written Patent, for an improvement in churns, is deemed defective or inoperative by reason of insufficient description or specification, and the error arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention, and the Commissioner of Patents accordingly, in pursuance of the statute in such respects, hath agreed to accept the surrender of the same;

Now, know ye that the said Thomas Brown, within named, doth by these presents, surrender and yield up the within written Patent, granted to him for improvements in churns, and bearing date the 8th day of June, 1886.

In witness whereof the said Thomas Brown hath set his hand and affixed his seal this first day of September, A.D. 1887.

THOMAS BROWN. [L.S.]

Signed, sealed and delivered at the City of Ottawa, in the County of Carleton, in the Province of Ontario, in the presence of

HENRY COCKBURN.

FORM 9.

FOR THE CERTIFICATE OF PAYMENT OF FEE FOR FURTHER TERM (INVENTOR).

To the Commissioner of Patents, Ottawa:

The petition of Martin Scott, of the City of Montreal, in the Province of Quebec, cooper, showeth:

That on the 23rd June, 1883, your petitioner obtained a Patent for new and useful improvements in churns on which the partial fee for five (or ten) years was paid.

That he is the holder of the said Patent, and therefore prays that the usual certificate of payment of fee for a second (or third) term may be attached thereto.

Signed this first day of September, 1887.

MARTIN SCOTT.

FORM 10.

FOR THE CERTIFICATE OF PAYMENT OF FEE FOR FURTHER TERM (ASSIGNEE).

To the Commissioner of Patents, Ottawa:

The petition of Simon Smith, of the City of Halifax, in the Province of Nova Scotia, mariner, showeth:

That by assignment, dated 1st July, 1887, he obtained from John Brown, of the Village of Bridgetown, in the County of Annapolis, in the Province of Nova Scotia, stonemason, the exclusive right to a Patent granted on the 27th June, 1886, to the said John Brown, for new and useful improvement in ploughs, on which the partial fee for five (or ten) years was paid.

That your petitioner being the holder of the said Patent therefore prays that the usual certificate of payment of fee for a second (or third) term may be attached thereto.

Signed this first day of September, 1887.

SIMON SMITH.

FORM 11.

POWER OF ATTORNEY.

To the Commissioner of Patents, Ottawa:

The undersigned, John Brown, of the Town of Cornwall, in the county of Stormont, in the Province of Ontario, storekeeper, hereby appoints John Smith, of the City of Ottawa, Province of Ontario, his attorney, with full power of substitution and revocation, to prosecute an application for new and useful improvements in sewing machines; to sign the drawings, to receive the Patent and to transact all business in the Patent Office connected therewith.

Signed at Cornwall, this first day of September, 1887.

In the presence of JOHN BROWN.

JOHN SMITH.

FORM 12.

REVOCATION OF POWER OF ATTORNEY.

To the Commissioner of Patents, Ottawa:

The undersigned, John Brown, of the Town of Cornwall, in the County of Stormont, in the Province of Ontario, storekeeper, having on or about the 1st September, 1887, appointed John Smith of the City of

Ottawa, Province of Ontario, his attorney, to prosecute an application for a Patent for new and useful improvements on sewing machines, hereby revokes the power of attorney then given.

Signed at Cornwall, this thirteenth day of September, 1887.

In the presence of JOHN BROWN.

JOHN SMITH.

SPECIFICATIONS.

(*To be in duplicate.*)

FORM 13.

FOR A MACHINE.

To all whom it may concern:

Be it known that I, William Woodworth, of the Town of Poughkeepsie, in the County of Duchess, in the State of New York, gentleman, having invented certain new and useful improvements in planing machines, do hereby declare that the following is a full, clear, and exact description of the same, reference being made to the accompanying drawing in which:

Figure 1 is a side elevation of a machine embodying my invention.

Figure 2 is a plan of the same.

Figure 3 is an elevation showing the end of the machine which is at the right hand in figure 1.

Figure 4 is a vertical traverse, section showing those parts of the machine which are at the right hand of the line x x drawn across figures 1 and 2.

The first part of my invention relates to the combination of rotary cutters and feeding rollers, etc.

The second part of my invention relates to the combination, with feeding rollers and rotary cutters, etc.

(Here follows a full description of the machine and drawing.)

I make no claim to the mode in which the cutters are secured upon their shaft, nor to the adjustable bearings, which permit of the elevation or depression of the shaft, for I am aware that these are not new; but what I claim as my invention, and desire to secure by Patent, is:

1st. The combination of the cutters E, E, and the feeding rollers I, I, J, J, substantially as and for the purpose hereinbefore set forth.

2nd. The combination, with the cutters E, E, and the feeding rollers

I, I, J, J, of the cutters L, M, substantially as and for the purpose hereinbefore set forth.

WILLIAM WOODWORTH.

POUGHKEEPSIE, 4th September, 1887.

Signed in the presence of
JETHRO WOOD,
OLIVER EVANS.

N. B.—In this case the drawings shown in the Patent Office Forms as connected with this specification, do not relate thereto at all, being for a different device altogether, they have been inserted by mistake, and are not inserted in this work.

See note to sec. 52, pp. 435–6.

FORM 14.

DRAWINGS.

(*To be in duplicate.*)

Each sheet on tracing linen shall contain the following: The title of the invention on the top of the sheet; the following certificate at the bottom: "Certified to be the drawings referred to in the specification hereunto annexed," and signed by the inventor or his attorney; place, date, and signature of two witnesses.

NOTE BY EDITOR.—*The title of the invention is never required now to be on the top of the sheet.*

See note to sec. 52, p. 436.

FORM 15.

FOR AN ART OR PROCESS.

To all whom it may concern:

Be is known that we, Marion Ellsworth, of Chicago, County of Cook, and State of Illinois, gentleman, and Joseph Richard Shaw, of Indianapolis, County of Marion, and State of Indiana, gentleman, have jointly invented a new and useful improvement in the art or process of separating smut and other impurities from wheat, and we do hereby declare that the following is a full, clear and exact description of the same:

Take of lime, newly slaked and while yet warm, one and a half pounds to each one hundred pounds of wheat. Mix the lime well with the wheat, let it stand one hour, then pass it through a smut mill in the usual way and it will be found that all the lime, smut, dirt and other impurities of every kind attached to the wheat, and which no smut mill without our liming process will fully separate, will be entirely

removed, and the flour will be as white and as sweet as though made from the best of wheat.

We are aware that lime has before been used for the purpose of cleaning wheat, being first mixed with the grain, as above proposed, and the whole being then passed through a smut mill; but in all previous processes, so far as we are aware, the lime has been used in a cold state, and for this reason such processes prove ineffectual. We propose to take lime *newly slaked, and while yet warm.*

What we claim as our invention, and desire to secure by Patent, is: the process of cleaning wheat by mixing with it lime newly slaked and warm before passing it through a smut mill, so as to cleanse the wheat from all impurities, substantially as described.

MARION ELLSWORTH.
JOSEPH R. SHAW.

CHICAGO, 1st September, 1887.

Signed in the presence of
MAURICE JONES,
HENRY ELIAS.

FORM 16.

FOR A COMPOSITION OF MATTER.

To all whom it may concern:

Be it known that I, Ebenezer Whitney, of the City of Charleston, in the District of Charleston and State of South Carolina, gentleman, am the administrator of the estate of Benjamin Browning, in his lifetime of the said city, gentleman, and that the said Benjamin Browning did invent a certain new and useful composition of matter to be used in the manufacture of wool, and I do hereby declare that the following is a full, clear and exact description of the same:

The nature of the invention of the said Benjamin Browning consists of mixing olive, lard or rape-seed oil, with a solution of soap dissolved in hot water.

To prepare the wool oil, take a quantity of oil soap of any kind, provided the quality is good, and dissolve the same in hot water, say about thirty pounds of oil soap in thirty gallons of water, or a sufficient quantity of soap to saturate the water. Then take equal parts, by measure, of olive, lard, rape-seed, or any other kind of oil which can be used on wool in the process of its manufacture, and mix it with the preparation aforesaid, to wit, the soap solution; which, after such mixture, is ready to be used on wool with as beneficial an effect as if pure oil only had been used. This wool oil will not decompose by age, because the oil of soap neutralizes the stearine in the oil, hence there is nothing to decom-

pose. And for the same reason spontaneous combustion cannot be produced.

What I claim as the invention of the said Benjamin Browning, and desire to secure by Patent is: a compound composed of any of the oils ordinarily used on wool in its manufacture, and a solution of oil soap, substantially in the proportions and for the pusposes set forth.

EBENEZER WHITNEY,
Administrator.

CHARLESTON, 1st September, 1887.

Signed in the presence of
JOHN JAMES,
HENRY SMITH.

OATHS.

NOTE.—Where oaths are made out of Canada, and before a judge, the seal of the court, presided over by such judge, should be affixed, and if before a notary public, his seal should be affixed to such oaths.

When the invention has been assigned before the issue of Patent the affidavit must be made by the "inventor," not by the "assignee."

If the inventor is dead, the administrator or executor will make the affidavit that the person named as inventor was the inventor.

See note to sec. 52, pp. 436–7.

FORM 17.

BY SOLE INVENTOR FOR HIMSELF.

CANADA,
PROVINCE OF ONTARIO,
County of York.

I, John Smith, of the City of Toronto, in the County of York, in the Province of Ontario, carpenter, make oath and say, that I verily believe that I am the inventor of the new and useful improvements in machines for breaking stone, described and claimed in the specification in duplicate relating thereto, and for which I solicit a Patent by my petition, dated 1st of September, 1887. And I further say that the several allegations contained in the said petition are respectively true and correct.

JOHN SMITH.

Sworn before me, at the City of Toronto, the first day of September, 1887.

THOMAS BROWN,
J. P. for the County of York.

See note to sec. 52, pp. 436–7.

FORM 18.

JOINT INVENTORS.

CANADA,
PROVINCE OF ONTARIO,
County of Carleton.

We, James Thomas, of the City of Ottawa, in the County of Carleton, in the Province of Ontario, in the Dominion of Canada, blacksmith, and George Robert Major, of the same place, tinsmith, do hereby severally make oath and say,

1st. I, this deponent, James Thomas, for myself do hereby make oath and say that I verily believe that I and the said George Robert Major are the inventors of the new and useful improvement in the art or process of separating smut from wheat, described and claimed in the specification in duplicate relating thereto, for which we solicit a Patent by our petition to the Commissioner of Patents, dated 1st September, 1887. And I further say that the several allegations contained in the said petition are respectively true and correct.

2nd. I, this deponent, George Robert Major, for myself do hereby make oath and say that I verily believe that I and the above named James Thomas are the inventors of the new and useful improvement in the art or process of separating smut from wheat, described and claimed in the specification in duplicate, relating thereto, for which we solicit a Patent by our petition to the Commissioner of Patents, dated first September, 1887. And I further say that the several allegations contained in the said petition are respectively true and correct.

JAMES THOMAS,
GEORGE ROBERT MAJOR.

Sworn before me, by the said James Thomas and George Robert Major, the first day of September, 1887, at the City of Ottawa.

JOHN SMITH,
J. P. for the County of Carleton.

See note to sec. 52, pp. 436–7.

FORM 19.

BY SOLE INVENTOR FOR HIMSELF AND ASSIGNEE.

CANADA,
PROVINCE OF ONTARIO,
County of York.

I, John Smith, of the City of Toronto, in the County of York, in the Province of Ontario, carpenter, make oath and say, that I verily believe that I am the inventor of the new and useful improvements in

machines for breaking stone, described and claimed in the specification in duplicate relating thereto, and for which I (and Edwin Morrison) solicit a Patent by our petition, dated 1st of September, 1887. And I further say that the several allegations contained in the said petition are respectively true and correct.

JOHN SMITH.

Sworn before me, at the City of Toronto, the first day of September, 1887.

THOMAS BROWN,
J. P., for the County of York.

See note to sec. 52, pp. 436–7.

FORM 20.

BY SOLE INVENTOR FOR ASSIGNEE ONLY.

CANADA,
PROVINCE OF ONTARIO,
County of York.

I, John Smith, of the City of Toronto, in the County of York, in the Province of Ontario, carpenter, make oath and say, that I verily believe that I am the inventor of the new and useful improvements in machines for breaking stone, described and claimed in the specification in duplicate relating thereto, and for which James Goodwin solicits a Patent by his petition, dated 1st of September, 1887. And I further say that the several allegations contained in the said petition are respectively true and correct.

JOHN SMITH.

Sworn before me, at the City of Toronto, the first day of September, 1887.

THOMAS BROWN,
J. P. for the County of York.

See note to sec. 52, pp. 436–7.

FORM 21.

FOR A REISSUE (INVENTOR).

CANADA,
PROVINCE OF ONTARIO,
County of Carleton.

I, Thomas Brown, of the City of Ottawa, in the Province of Ontario, lumber manufacturer, make oath and say that the several allegations contained in my petition to the Commissioner of Patents, dated 1st of

September, 1887, for a reissue of the Patent granted to me on the 4th of September, 1886, for a new and useful improvement in churns are respectively true and correct;

That I am the sole owner of the said Patent;

And that I am the inventor of the improvement set forth and claimed in the amended specification in duplicate relating thereto.

THOMAS BROWN.

Sworn before me, at the City of Ottawa, in the County of Carleton, in the Province of Ontario, this first day of September, 1887.

WILLIAM MILLS,
J. P. for the County of Carleton.

NOTE.—If the Patent has not been exclusively assigned, the affidavit must state that the application for reissue is made with the consent of the assignees.

See note to sec. 52, pp. 436–7.

FORM 22.

FOR A REISSUE (ASSIGNEE OF THE ENTIRE INTEREST).

CANADA,
PROVINCE OF ONTARIO,
County of Carleton.

I, David Lane, of the Town of Cobourg, in the County of Northumberland, Province of Ontario, tanner, make oath and say that the several allegations contained in my petition to the Commissioner of Patents, dated 1st September, 1887, for a reissue of the Patent granted to Thomas Tardy, of the City of Ottawa, Province of Ontario, broom maker, for new and useful improvements in planing machines, are respectively true and correct;

That I am the sole owner of the said Patent;

And that Thomas Tardy was the inventor of the improvements set forth and claimed in the amended specification in duplicate relating thereto.

DAVID LANE.

Sworn before me, at the Town of Cobourg, in the County of Northumberland, Province of Ontario, this first day of September, 1887,

THOMAS PARSONS,
J. P. for the County of Northumberland.

See note to sec. 52, pp. 436–7.

FORM 23.

CAVEAT.

To the Commissioner of Patents, Ottawa:

The undersigned, James Thompson, of New Edinburgh, in the County of Russell, in the Province of Ontario, school teacher, an intending applicant for a Patent, who has made certain new and useful improvements in locomotive engines, and has not perfected his invention, prays that his specification may be filed as a *Caveat* in the Patent Office. (Here describe the invention as far as possible, and refer to letters in drawing, as in specification given before. Form No. 13.)

JAMES THOMPSON.

CANADA,
PROVINCE OF ONTARIO,
County of Russell.

I, James Thompson, of New Edinburgh, in the County of Russell, Province of Ontario, school teacher, make oath and say that I am the inventor of the invention described in the foregoing specification, and that the allegations contained therein are respectively true and correct.

JAMES THOMPSON.

Sworn before me, at New Edinburgh, the first day of September, 1887.

ALEXANDER BUSH,
J. P. for the County of Russell.

ASSIGNMENTS.

FORM 24.

OF AN ENTIRE INTEREST (OR AN UNDIVIDED ONE-HALF INTEREST) IN AN INVENTION BEFORE THE ISSUE OF PATENT.

In consideration of the sum of ten dollars, to me paid by Solomon Lang, of the City of Montreal, I do hereby sell and assign to the said Solomon Lang all (or an undivided half of all) my right, title, and interest in and to my invention for new and useful improvements in planing machines, as fully set forth and described in the specification which I have signed preparatory to obtaining a Patent. And I do hereby authorize and request the Commissioners of Patents, to issue the said

Patent to the said Solomon Lang (or jointly to myself and the said Solomon Lang) in accordance with this assignment.

Witness my hand and seal this first day of September, 1887, at the City of Montreal. THOMAS LORD. [L.S.]

See note to sec. 52, p. 437.

FORM 25.

OF AN ENTIRE INTEREST IN A PATENT.

In consideration of five hundred dollars, to me paid by Nathan Wilcox, of Keokuk, Iowa, I do hereby sell and assign to the said Nathan Wilcox, all my right, title and interest in and to the Patent of Canada, No. 23,460, for an improvement in locomotive head lights, granted to me July 30, 1878, the same to be held by and enjoyed by the said Nathan Wilcox to the full end of the term for which said Patent is granted, as fully and entirely as the same could have been held and enjoyed by me if this assignment and sale had not been made.

Witness my hand and seal this first day of September, 1887, at Keokuk, Iowa. HORACE KIMBALL. [L.S.]

See note to sec. 52, p. 437.

FORM 26.

DISCLAIMER.

(*To be in duplicate.*)

I, William Lookup, of the City of Hull, in the County of Ottawa, in the Province of Quebec, having on the 1st September, 1887, obtained a Patent for the Dominion of Canada, for new and useful improvements in waggon brakes:

And through mistake, accident or inadvertence, without any wilful intent to defraud or mislead the public, I have made the claim in my specification too broad (or as being the inventor of a material or substantial part of the invention patented of which I was not the inventor, and to which I had no legal right):

I, therefore, hereby disclaim the part of the claim in the specification, which is in the following words:

"I also claim the use of the lever A, in combination with crank D, as described." WILLIAM LOOKUP.

HULL, 30th September, 1887.

Signed in duplicate in the presence of
DAVID BROWN,
FRANCIS LEMIEUX.

See note to sec. 52, p. 437, also note to sec. 24, pp. 199, 200, where a new form is set out.

APPENDIX II.

GENERAL FORMS AND FORMS IN THE EXCHEQUER COURT (CAN.).

Form 27.

SUMMONS.

In the Exchequer Court of Canada.

See Form following Form 41.

Form 28.

WARRANT FOR PARTICULARS.

In the Exchequer Court of Canada.

See Form after Form 27 (following Form 41.)

Form 29.

ASSIGNMENT BY AGENT IN ENGLAND WHO HAS TAKEN OUT PATENT FOR THE UNITED KINGDOM AS A COMMUNICATION FROM ABROAD TO AN ASSIGNEE, AT REQUEST OF INVENTOR.

This Indenture made the day of , 18 .

Between of in the City of , Fellow of the Institute of Patent Agents, of the first part; of , France, Engineer, of the second part; and , carrying on business at , hereinafter called the assignee, of the third part.

Whereas the said is the grantee of Letters Patent for (title) dated the day of , 18 , No.

And whereas the invention, the subject of the said Letters Patent, was communicated to the said by the said and the said Letters Patent were applied for and obtained, and are now held by the said on behalf of and as trustee for the said .

And whereas the said has requested the said to assign the whole interest in the said Letters Patent to the said assignee.

Now this Indenture witnesseth, that in pursuance of such request, and in consideration of the sum of by the said assignee to the said well and truly paid, the receipt whereof is hereby acknowledged, the said hereby assigns unto the said assignee, his heirs, executors, administrators and assigns, and which assignment the said confirms by his signature to, and execution of these presents, all those the Letters Patent respectively hereinbefore mentioned, and the full and exclusive benefit and advantage, and all the right, title, interest, benefit, property, claim and demand whatsoever of him the said into, upon, or in respect of the said Letters Patent, to have, hold, use, exercise and enjoy the said Letters Patent unto and by the said assignee, his heirs, executors, administrators and assigns, for their sole use and benefit. And the said doth hereby for himself, his heirs, executors, and administrators, covenant with the said assignee, his heirs, executors, administrators and assigns that he hath not at any time heretofore made, done, committed, or suffered any act, deed, matter, or thing whatsoever, whereby or by reason whereof, the said Letters Patent and premises, or any of the privileges thereby granted, have been affected, encumbered, or impeached in title, estate, or otherwise whatsoever.

In witness whereof, the parties hereto have hereunto set their hands and seals, the day and year first above written, at the City of

Signed, sealed and delivered, }
in presence of }

Form 30.

FORM OF ASSIGNMENT OF PATENT FOR THE UNITED KINGDOM TO INVENTOR BY COMMUNICANT.

This Indenture, made the day of , 18 ,
Between , hereinafter called the Assignor, of the first part; and , hereinafter called the Assignee, of the second part.

Whereas, by Letters Patent, dated the day of , 18 , and numbered , Her present Majesty Queen Victoria did give and grant to the Assignor her especial license, full power, sole privilege and authority that the Assignor, his executors, administrators, assigns, by himself, his agents, or licensees, and no others, might at all times thereafter during the term of fourteen years from the date of the said Letters Patent, make, use, exercise, and vend within the United Kingdom of Great Britain and Ireland and Isle of Man, in such manner as to him or them might seem meet an invention of , being a communication to him from abroad by the Assignee.

And whereas, the said Letters Patent were so obtained as aforesaid by the Assignor, as agent for and on behalf of the Assignee. And the

Assignor is possessed of the said invention and Letters Patent as a trustee for the Assignee. And whereas the Assignee requested the Assignor to execute such an assignment of the said invention and Letters Patent as is hereafter contained.

Now, this Indenture witnesseth that in pursuance of the said request, and in consideration of the premises, the Assignor doth hereby, as trustee, assign and convey unto the Assignee , executors, administrators, and assigns, all that the said invention hereinbefore mentioned, and the hereinbefore recited Letters Patent, and the full and exclusive benefit and advantage thereof respectively, and of any extension of the term of the said Letters Patent, and all rights, benefits, and advantages whatsoever to the same invention, Letters Patent, and premises belonging, to hold the same unto the Assignee , executors, administrators and assigns, during all the residue now unexpired of the said term of fourteen years by the said Letters Patent granted, and during any extension of the said term.

In witness whereof the Assignor has hereunto set his hand and seal the day and year first above written, at the City of .

Signed, sealed and delivered by the above named , in the presence of }

FORM 31.

LICENSE—SHOP RIGHT.

In consideration of the sum of dollars, paid by , of , in the County of , Province of , Canada, the receipt whereof is hereby acknowledged, I do hereby license and empower the said to manufacture in said (place agreed upon), and not elsewhere the (title of invention) for which Letters Patent of the Dominion of Canada, No. were granted to me on the day of , 18 , and to sell the machines so manufactured throughout the Dominion of Canada, to the full end of the term for which said Letters Patent or any reissue thereof are or may be granted.

Signed at the of , in the County of , and Province of , Canada, this day of , A.D. 18 .

Witness. A. B.

N.B.—This may be an instrument under seal, when it will conclude as signed and sealed, etc., and signed, sealed and delivered, in the presence of (witness or witnesses).

FORM 32.

LICENSE (NOT EXCLUSIVE) WITH ROYALTY.

This Agreement made this day of , 18 ,
Between of in the County of and Province of , Canada, of the first part, and of the County of and Province of , Canada, of the second part.

Witnesseth, that whereas Letters Patent of the Dominion of Canada, No. , for *(title of invention)*, were granted to the party of the first part under date of , 18 .

And, whereas, the party of the second part is desirous of manufacturing containing said patented improvement (or manufacturing the article or device disclosed in said Letters Patent, or of putting in practice the process disclosed in said Letters Patent, *as the case may be*).

Now, therefore, the said parties have agreed as follows:—

1. The party of the first part hereby licenses and empowers the party of the second part to manufacture, subject to the conditions hereinafter named, at their Factory in , and in no other place or places, to the end of the term for which said Letters Patent or any reissue thereof are or may be granted, containing the patented improvements described in said Letters Patent, and to sell the same within the Dominion of Canada.

2. The party of the second part agrees to make full and true returns to the party of the first part (under oath, or *as the case may be*) upon the days of and in each year, of all containing the patented improvements manufactured (or manufactured and sold) by the said party of the second part.

3. The party of the second part agrees to pay to the party of the first part dollars as a license fee upon every manufactured (or manufactured and sold) by the said party of the second part containing the patented improvements, *provided that* if the said fee be paid upon the days provided herein for (monthly, quarterly or semi-annual returns, *as the case may be*), or within ten days thereafter, a discount of per cent. shall be made from said fee for prompt payment *(or without this proviso)*.

4. Upon a failure of the party of the second part to make returns or to make payment of license fees, as herein provided, for thirty days after the days herein named, the party of the first part may terminate this license by serving a written notice upon the party of the second part; but the party of the second part shall not thereby be discharged from any liability to the party of the first part for any license fees due at the time of the service of said notice.

In witness whereof the parties above named have hereunto set their hands and seals the day and year first above written at in the County , Province of , Canada.

Signed sealed and delivered in the presence of . A. B. . C. D. .

FORM 32*a*.

EXCLUSIVE LICENSE—WITH ROYALTY AND COVENANTS.

This Agreement made this day of A. D. 189 .
Between , of , in the County of ,
and Province of , Canada, of the first
part; and , of the , County of ,
and Province of , Canada, , of the second part.

Witnesseth that whereas Letters Patent of the Dominion of Canada, No. , for *(title of invention)*, were granted to the party of the first part under date of day of , 189 .

And whereas the party of the second part is desirous of obtaining the exclusive right to manufacture and sell in the Dominion of Canada, , containing said patented improvement (or manufacturing the article or device disclosed in said Letters Patent, or putting in practice the process disclosed in said Letters Patent, *as the case may be*).

Now, therefore, the said parties have agreed as follows:—

1. The said party of the first part hereby grants unto the said party of the second part (his legal representatives and assigns, *as the case may be*), an exclusive license to manufacture and sell in the Dominion of Canada, , being the invention described in said Letters Patent, to the full end of the term for which Letters Patent have been granted.

2. The party of the second part agrees to make full and true returns to the party of the first part (under oath or *as the case may be*), upon the days of and in each year of all , containing the patented improvements, manufactured (or manufactured and sold), by the said party of the second part, and that the party of the first part may have access, during office hours, to the books of the said party of the first part, containing entries relating to such manufacture or sale.

3. The said party of the second part agrees to pay to the party of the first part dollars as a license fee or royalty upon each and every manufactured (or manufactured and sold), by the said party of the second part, containing the patented improvement, *provided that* if the said fee be paid upon the days provided herein for (monthly, quarterly or semi-annual returns, *as the case may be*), or within ten days thereafter, a discount of per cent. shall be made from said fee for prompt payment *(or without this proviso.)*

4. Upon a failure of the party of the second part to make returns, or to make payment for license of license fees, as herein provided, for days after the days herein named, the party of the first part may terminate this license by serving a written notice upon the party of the second part; but the party of the second part shall not thereby be discharged from any liability to the party of the first part for any license fees due at the time of the service of said notice.

5. And the said party of the second part hereby agrees to keep proper books of account to contain entries of each and every article or thing manufactured or sold by virtue of this exclusive license, and to manufacture the same in a good and workmanlike manner out of good material, and to mark each and every article so manufactured, as patented and when so patented.

6. And the said party of the first part (for himself and legal representatives) hereby covenants with the party of the second part (his legal representatives or assigns) that he will pay all Government fees as the same shall become due, and that he will not import or cause to be imported in an unauthorized manner, the said patented improvement, or any article or thing containing the same, and that he will keep said Letters Patent alive to the full end of the term for which they are granted, in order that an exclusive right may enure to the party of the second part, and that in the event of the said party of the first part causing the said Letters Patent to lapse by reason of non-payment of fees, importation or otherwise, that he the said party of the first part will pay and forfeit to the said party of the second part the sum of dollars, and the licensee will be relieved of the payment of all (or as the case may be) payment of royalty.

(*Or it may be provided that the exclusive licensee shall pay all Government fees, which in the event of an exclusive license would probably be the course adopted.*)

7. And the said party of the first part (for himself and legal representatives) hereby further covenants with the party of the second part (his legal representatives or assigns) that he will at his own cost (or as the case may be), prosecute infringers of said Letters Patent, in order that the said party of the second part may be secured in the exclusive right hereby granted.

8. And the said party of the second part (for himself and legal representatives) hereby covenants with the party of the second part (his legal representatives or assigns) that he will manufacture or cause to be manufactured each and every year during the existence of this exclusive license, not less than (here state the number agreed on for manufacture.)

9. It is hereby mutually agreed that failure to observe any of the conditions or provisions contained in this agreement on the part of either of the parties hereto shall work a forfeiture of this exclusive license, and that the said conditions and provisions and covenants shall be applicable to and binding on the legal representatives or assigns of the parties hereto.

In witness whereof the parties above named have hereunto set their hands and seals the day and year above written at the in the County of Province of , Canada.

Signed, sealed and delivered in the presence of 3.

N. B.—In the event of an exclusive license and covenant to pay an annual sum or royalty, if the licensee does not arrange to pay the Government fees, he should obtain a covenant from the licensee to do so, as

well as not to import in an unauthorized manner, or do anything which the title to the Letters Patent may be prejudicially affected, otherwise the licensee may be held liable to make payments, notwithstanding the lapse of the Patent for non-payment of fees: following *Mills* v. *Carson*, 9 R. P. C., p. 338 (cited on p. 230 of this book), which related to an exclusive license, which was held tantamount to an assignment, and where no implied covenant to pay fees on the part of the licensor was implied: See also *In re Railway and Electric Appliance Co.*, 38 Ch. D. 597.

FORM 33.

ASSIGNMENT OF TERRITORIAL INTEREST AFTER GRANT OF PATENT.

Whereas I, , of the of , County of , and Province of Ontario, Canada, did obtain Letters Patent of the Dominion of Canada for (title), which Letters Patent are numbered , and bear date the day of , in the year 18 ;

And, whereas, I am now the sole owner of the said Patent and of all rights under the same in the below cited territory;

And, whereas, , of County of , and Province of , Canada, is desirous of acquiring an interest in the same;

Now, therefore, to all whom it may concern, be it known that for and in consideration of the sum of dollars to me in hand paid (the receipt of which is hereby acknowledged), I, the said , have sold, assigned and transferred, and by these presents do sell, assign and transfer unto the said all the right, title and interest in and to the said invention, as secured to me by said Letters Patent, for, to, and in the County of , and for, to, or in no other place or places; the same to be held and enjoyed by the said within and throughout the above specified territory, but not elsewhere, for his own use and behoof, and for the use and behoof of his legal representatives or assigns, to the full end of the term for which said Letters Patent or any reissue thereof are or may be granted, as fully and entirely as the same would have been held and enjoyed by me had this Assignment and Sale not been made.

In witness whereof I have hereunto set my hand and affixed my seal at , in the County of , Province of , Canada, this day of , A. D. 18 .

Signed, sealed and delivered in presence of:—
S. T.
R. D.

A. B. [SEAL.]

FORM 34.

ENDORSEMENT ON INFORMATION OR STATEMENT OF CLAIM.

See Exchequer Court Forms following Form 41.

FORM 35.

ASSIGNMENT OF PATENT, INCLUDING FUTURE IMPROVEMENTS.

Whereas I, A. B. , of the of , in the County of and Province of , Canada, did obtain Letters Patent of the Dominion of Canada, for certain improvements in , which Letters Patent bear date the day of , one thousand eight hundred and , and numbered .

And, whereas, I, the said A. B. , am now sole owner of said Patent.

And, whereas, C. D. , of the of , in the County of and Province of , is desirous of acquiring an interest therein.

Now, therefore, to all whom it may concern, be it known that for and in consideration of the sum of dollars, to me in hand paid (the receipt of which is hereby acknowledged) I have assigned, sold and set over, and by these presents do assign, sell and set over, unto the said C. D. *(here insert the interest assigned)* the right, title, and interest which I have in said invention and the Letters Patent (and any and all improvements now made, or which hereafter may be made by me, in or on said patented machine, or any machines of the same class or for the same purpose, and any and all Letters Patents which may hereafter be obtained in respect of such improvements, as the case may be).

The same to be held and enjoyed by the said C. D. , for his own use and behoof, and for the use and behoof of his legal representatives and assigns to the full end of the term for which said Letters Patent are granted, as fully and entirely as the same would have been held and enjoyed by me if this Assignment and Sale had not been made.

In testimony whereof I hereunto set my hand and affixed my seal this day of , one thousand eight hundred and .

[SEAL.]

Signed, sealed and delivered in presence of

FORM 36.

ASSIGNMENT OF PATENT INCLUDING CLAIMS FOR DAMAGES AND INFRINGEMENTS.

Whereas, Letters Patent of the Dominion of Canada were granted to me, A. B., of the of , in the County of , and Province of , Canada, which Letters Patent were dated , 18 , and numbered , for improvements in ;

And, whereas, C. D., of , the of , in the County of and Province of , is desirous of obtaining all the right, title and interest of me the said A. B., in and to said Letters Patent, and the improvements therein contained, and all claims and demands, both in law and equity, for damages and profits accrued or to accrue on account of the infringement of said Letters Patent, that I, the said A. B., have or may have;

Now, to all whom it may concern, be it known that for and in consideration of the sum of dollar , lawful money to me in hand paid by the said C. D. (the receipt of which is hereby acknowledged), I, the said A. B., have sold, assigned, transferred and set over, and do hereby sell, assign, transfer, and set over unto the said C. D., all the right, title and interest which I have, or may have, in and to the said improvements and the aforesaid Letters Patent No. , and any reissue of the same, throughout the Dominion of Canada, thereof; the same to be held and enjoyed by the said C. D., for his own use and behoof, and for the use and behoof of his heirs, executors, administrators and assigns, to the full end of the term for which said Letters Patent are granted, and all reissues thereof.

And I have, for the before named consideration assigned, sold and set over and do by these presents sell, assign and set over, unto the said C. D., his heirs, executors, administrators and assigns, all claims and demands, both in law and in equity, for damages or profits accrued or to accrue on account of the infringement of said Letters Patent, that I have or may have.

In witness whereof, I have hereunto set my hand and seal this day of , A. D., one thousand eight hundred and .

[SEAL.]

Signed, sealed and delivered in the presence of

FORM 37.

ASSIGNMENT OF PATENT WITH PROVISION FOR DIVISION OF PROFITS AND TO DEAL JOINTLY.

Whereas, , of of , in the County of , and Province of , Canada, did obtain Letters Patent of the Dominion of Canada, for certain improvements in , which Letters Patent bear date the day of , one thousand eight hundred and , and are numbered .

And, whereas, I, A.B., am now sole owner of said Patent:

And, whereas, C. D., of of , in the County of , and Province of , is desirous of acquiring an interest therein:

Now, therefore, to all whom it may concern, be it known that, for and in consideration of the sum of dollars, to me in hand paid (the receipt of which is hereby acknowledged), I, the said A. B., have assigned, sold and set over, unto the said C. D. *(here insert the interest conveyed)* the right, titles, and interest which I have in said invention and Letters Patent.

The same to be held and enjoyed by the said C. D. for his own use and behoof, and for the use and behoof of his legal representatives and assigns, to the full end of the term for which said Letters Patent are granted.

This assignment is made upon the following express condition, forming an inseparable part hereof, to which condition I, myself, heirs and assigns, assent by the act of signing this instrument, and to which condition said assignee for himself, heirs, and assigns, also assents by his signing of this instrument, or by doing or attempting to do any act under its authority; to wit, neither said Assignee nor myself shall have any right or power to make any license or other privilege under or relating to said Patent without that all the owners of the Letters Patent join in the same in writing; and neither of the owners shall have separately the right to make or sell or use any material part of the invention forming the subject-matter of said Letters Patent without that the party thus making or selling or using shall secure and pay to the other party, part owners of said Patent, such share of the profits arising from such manufacture, sale or use as the part of said Letters Patent owned by said other party bears proportion to the whole Letters Patent. And neither party hereto is to be accountable for or share in any losses made by the other on account of any independent manufacture.

And I, the said C. D., hereby assent and agree to conform to the foregoing conditions.

In witness whereof, we have hereunto set our hands and affixed our seals this day of , one thousand eight hundred and .

Signed, sealed and delivered in presence of } [SEAL.]

[SEAL.]

FORM 38.

LICENSE (PERSONAL), WITH QUARTERLY PAYMENTS.

This Agreement and license, made this day of 18 .
Between of the first part, and , of the second part, witnesseth,

That, whereas, Letters Patent were issued by the Dominion of Canada to on the day of , A. D. 18 , numbered for .

And, whereas, the said part of the second part, acknowledging the novelty and utility of said invention, and the validity of said Patent desirous of acquiring the right to under and according to said Letters Patent.

Now these presents witness that the said part of the first part, for and in consideration of the sum of dollar , to , paid by the said part of the second part, the receipt whereof is hereby acknowledged, and of the faithful performance of the covenants and agreements herein contained, made by the part of the second part, ha sold and granted, and do hereby sell and grant unto the said the right, license and privilege, to with any and all modifications of which the invention is susceptible, to the full extent of the grant contained in said Letters Patent or any reissue thereof, and to use, and to sell and deliver the for use, in any and all places.

And the said part of the second part, covenant and agree that will employ good materials and workmanship, and will conduct the business skilfully, so as to endeavour to make and maintain a good reputation for the invention, and will keep exact and full accounts of , and will allow the part of the first part or agents to examine books at all reasonable times. And that will make a full and sworn return to the part of the first part, or legal representatives, on the first day of January, April, July and October, of each year, showing the exact delivered during the three months prior to the first day of the month preceding, and that will then pay the license fee thereon as set forth below, by forwarding it to the place of business of the part of the first part, or will deposit the same to the credit of the part of the first part, or legal representatives in the Bank at or such other place as shall hereafter be mutually agreed upon.

A license fee of is to be well and truly paid by the part of the second part, on all , under and according to this invention, for which payment to be well and truly made to the party of the first part or his legal representatives, the said party of the second part binds himself and his legal representatives.

In case of a refusal or neglect of the part of the second part to fulfil the conditions of this agreement for thirty days, after having been solicited in writing so to do, then, on the serving of a notice in writing

on the part of the second part, or at his place of business, the part of the first part may declare this license void in thirty days from and after such service of notice, but otherwise it shall be and remain in full force and effect to the end of the term for which said Letters Patent are granted, and under all reissues thereof.

And it is understood and agreed that, in case of the termination of this license by reason of notice served as above, nothing herein contained shall release the part of the second part from the obligation to pay the royalty then already accrued at the date of such termination, nor relieve the part of the second part in any way from the position of an infringer, if continue thereafter to use the invention without a new license, which new license it shall be at the option of the part of the first part to grant or refuse.

The right, privilege and license hereby granted is not, nor is any part of it to be, transferable or assignable by the part of the second part; and it is not the intention to give to said part of the second part any right or privilege except what shall personally exercise; and not to have the power or right to in any way transfer or impart to another or others the right or privilege hereby granted; and the part of the second part hereby covenant and agree as a condition of the enjoyment of the right and privilege hereby granted; to stamp, print, or otherwise mark in a conspicuous manner, on each and every manufactured by under said Letters Patent, the words and figures as follows, to wit: ("Patented 18 .")

In witness whereof, the said parties have hereto set their hands and affixed their seals, the day and year first above written.

[SEAL.]

Signed, sealed and delivered
In the presence of

[SEAL.]

FORM 39.

MORTGAGE OF PATENT.

To all to whom these presents shall come, greeting:

Be it known, that for, and in consideration of the sum of dollar , received of C. D., of the of in the County of and Province of , Canada, I, A. B., of County of and Province of do hereby assign and mortgage to the said C. D., the whole, right, title and interest in and to Letters Patent of the Dominion of Canada, No , dated for an improvement in granted to

And I hereby, for myself and legal representatives, covenant with said assignee and mortgagee, his legal representatives and assigns, that I have

full right to assign and mortgage said Letters Patent in manner and form as above written, and that the interest hereby conveyed and mortgaged is free from all prior assignment, grant, mortgage, or other incumbrance whatever.

The condition of this assignment and mortgage is such that whereas I am justly indebted to the said C. D. in the sum of dollar , (as evidenced by my promissory note of even date herewith, payable to said mortgagee, or order from date with interest, *or as the case may be)*; now if the said indebtedness (or note) be well and truly paid according to its tenor, then this assignment shall be null and void, but otherwise to be of full force and effect.

In witness whereof, I have hereunto set my hand and affixed my seal this day of one thousand eight hundred and

[SEAL.]

Signed, sealed and delivered in the presence of

FORM 40.

MORTGAGE OF PATENT, WITH POWER TO SELL.

To all whom it may concern:

Be it known, that in consideration of the sum of dollar , received of C. D., of , County of , and Province of , Canada, I, A. B., of , County of , and Province of , do hereby assign and mortgage to the said C. D., the whole right, title and interest in and to Letters Patent for the Dominion of Canada, No. , dated , for an improvement in granted to . And I, for myself and legal representatives, covenant to and with said assignee and mortgagee, his legal representatives and assigns, that I have full right to assign and mortgage said invention and Letters Patent in manner and form as above written, and that the interest hereby conveyed and mortgaged is free from all prior assignment, grant, mortgage, or other incumbrance whatever.

The condition of this assignment and mortgage is such that whereas I am justly indebted to the said C. D. in the sum of (as evidenced by a promissory note of even date herewith, payable to said mortgagee or order years from date, with interest, *or as the case may be)*; now, if said indebtedness or note, or any renewal thereof, be well and truly paid according to its tenor, then this assignment shall be null and void, but otherwise to be of full force and effect.

And for the better securing the aforesaid payment, as well as to save the expense and delay of legal proceedings, I do hereby appoint , his heirs, executors, administrators, and assigns, my attorney, in fact, with power to sell, in case of default of payment at maturity, the aforesaid Letters Patent and the invention thereby secured, at public auction, giving such notice thereof as is required in sales on execution *(or as agreed on)*, and to execute a proper deed of assignment to the purchaser; and out of the proceeds of sale, to pay the said debt, together with interest, costs and charges, and the balance, if any, to the undersigned; hereby covenanting with all concerned to ratify and confirm all acts lawfully done in pursuance of this power.

In witness whereof, I have hereunto set my hand and affixed my seal this day of , A.D. 18 .

[SEAL.]

Signed, sealed and delivered in the presence of

FORM 41.

POWER OF ATTORNEY TO SELL RIGHTS.

To all to whom these presents shall come, greeting:

Be it known, that I, A. B., of of , in the County of and Province of , Canada, patentee and sole owner of Letters Patent of the Dominion of Canada, No. , for an improvement in , dated the day of , one thousand eight hundred and , do hereby constitute and appoint C. D., of the of , in the County of and Province of , my true and lawful attorney, with full power to make assignments, grants or licenses of any kind under said Letters Patent, with full power to sign my name to all such instruments, and in my name to receive and give receipt for all considerations in exchange for any of such rights; but with no power to bind me in any manner further than to make binding and legal all such assignments, grants and licenses.

This power to be of full force and effect until a revocation hereof in writing shall be duly recorded upon the records of the Canadian Patent Office at Ottawa, Canada, where this instrument will be found of record.

Witness my hand and seal this day of , one thousand eight hundred and .

[SEAL.]

Witness:

FORM 27.

SUMMONS.

In the Exchequer Court of Canada.

A. B. Plaintiff.

v.

C. D. Defendant.

Let the defendant, his solicitor or agent attend before the presiding Judge in Chambers, in the City of Ottawa, on , the day of next, at o'clock in the forenoon, or so soon thereafter as Chambers may be held, to show cause why the plaintiff should not obtain an order *(here set out the order sought).*

Upon this application will be read this summons, and the pleadings, and the affidavit of filed herein.

Dated at Chambers this day of A. D. 1893.

J. Ex. Ct.

FORM 28.

WARRANT FOR PARTICULARS.

In the Exchequer Court of Canada.

Monday, the day of A.D. 1893.

Between A.B., Plaintiff, and C.D., Defendant.

Before , in Chambers.

Upon the application of the plaintiff that the defendant do deliver particulars in writing under the 3rd, 4th, 5th, 6th, 7th and 8th paragraphs of his Statement of Defence upon hearing read the Summons, the pleadings herein and the affidavit of , and upon hearing what was alleged, it is ordered that the defendant do deliver particulars in writing under the 3rd paragraph of the Statement of Defence, stating in what respect they deny that the plaintiff's patented invention is new, and to show the dates and occasions when, and the places where, and the persons by whom the invention herein was in public use.

And that under the said 4th paragraph, that the said defendant do also deliver particulars in writing and point out in what respect the plaintiff had not complied with the conditions attached to the grant of his Letters Patent, and the particulars in which the said Letters Patent do not properly describe and claim the invention specified in said Letters Patent.

And that under the said 5th paragraph the defendant do give the serial number and the date of issue of the foreign Letters Patent, and the name and address of the person or persons to whom foreign Letters Patent had been issued for the same invention prior to the invention

by the plaintiff, and the countries in which said Letters Patent were granted.

And that under the 6th paragraph that the defendant do give the name of the book or publication, the name of its author or publisher, its date, and the page in which an alleged anticipation of the plaintiff's invention may be found, and where the said book or publication may be obtained.

And that under the 7th paragraph, that the defendant do give the dates when, and the places where, and the name and address of the person by whom the plaintiff's invention had been in use or on sale more than one year prior to the application of the plaintiff for Letters Patent in Canada.

And that under the 8th paragraph that the defendant do point out in what respect the defendant failed to comply with the condition as to manufacture or importation as alleged, and when and where the alleged importation more than one year after the date of the Plaintiff's said Letters Patent *(or as the case may be, according to the defence set up)*, took place.

And lastly, it is ordered that the foregoing particulars be given by the said defendant in writing to the plaintiff or his solicitor on or before the day of A.D. 1893, and that in default of the said defendant delivering in writing such particulars by the time aforesaid, that the said Defendant be precluded from giving any evidence at the trial under the said paragraphs of the said Statement of Defence in respect of which default shall have been made.

And that the costs of and incidental to this order be costs in the cause.

J. E. C.

Form 34.

ENDORSEMENT ON INFORMATION OR STATEMENT OF CLAIM.

Notice to the defendant within named:

You are required to file with the Registrar of the Exchequer Court of Canada, at his office at the City of Ottawa, your plea, answer, exception or demurrer, or otherwise make your defence to the within Information or Statement of Claim *(as the case may be)* within from the service hereof.

If you fail to file your plea, answer, exception or demurrer, or otherwise make your defence within the time above limited, you are to be subject to have such judgment, decree or order made against you as the Court may think just, upon the informant's (or plaintiff's) own showing, and if this notice is served upon you personally you will not be entitled to any further notice of the further proceedings in the cause.

NOTE.—This information (or statement of claim) is filed by A. B., etc., Her Majesty's Attorney-General for the Dominion of Canada, on behalf of Her Majesty, (or by , of the City of , Solicitor for the within named plaintiff, *as the case may be*).

FORM 42.

FIAT OF THE ATTORNEY-GENERAL OF CANADA.

Department of Justice—(Sci. fa.).

OTTAWA, day of , 189 .

IN THE EXCHEQUER COURT OF CANADA.

Her Majesty the Queen, at the relation of A. B., plaintiff, and C. D., defendant.

Upon the within named A. B., , giving a bond to the satisfaction of the Registrar of the Exchequer Court, with two sureties in the penal sum of one thousand dollars each, conditional that if the Letters Patent of Invention, granted to the said , be not repealed in the proceedings taken in the writ of *scire facias*, in the petition prayed for, or by the judgment thereon, then the said , A. B., , and the said sureties, their executors, or administrators, or any, or either of them shall well and truly pay or cause to be paid to the said , C. D., , his executors, administrators, or assigns, all costs, charges, damages or expenses which he the said , C. D., , shall or may be subject or put to, by reason of the said writ of *scire facias* or the judgment thereon.

Let the writ issue.

(Signed) *Attorney-General of Canada.*

FORM 43.

BOND IN $1,000 BY INFORMANT AND TWO SURETIES.

In the Exchequer Court of Canada.

Know all men by these presents:

That we, A. B., of the *(residence and calling)*, and E. F., of the *(residence and calling)*, are jointly and severally held, and firmly bound unto Her Majesty the Queen in the penal sum of one thousand dollars, for which payment well and truly to be made we bind ourselves, and each of us by himself, our, and each of our executors and administrators respectively firmly by these presents.

Sealed with our seals and dated the day of , A.D. 189 .

Whereas, Letters Patent of Invention for Canada, bearing date the day of , A.D. 189 , and registered in the Patent Office at Ottawa as No. , were granted to one , and of which said Letters Patent the said C. D. is now the sole and registered owner, and enjoying the full rights, benefits and privileges granted thereby.

And, whereas, the above bounden A. B. is desirous, for certain reasons, to impeach the said Letters Patent, and has prayed for the issue of a writ of *scire facias* from the Exchequer Court of Canada for the impeachment of the said writ, and which said reasons are set out in the proposed writ of *scire facias*.

And, whereas, the Honourable , Attorney-General for the Dominion of Canada, has allowed the said writ to be issued, in the name of Her Majesty the Queen, upon the above bounden A. B., giving a bond to the satisfaction of the Judge of the Exchequer Court of Canada, with two sureties in the penal sum of one thousand dollars each.

And, whereas, the above bounden E. F. and G. H. have been approved as sureties, and the above bond has been allowed and approved of by the Registrar of the Exchequer Court of Canada, as appears by his signature on the margin hereof.

Now the condition of this obligation is such that if the said patent of invention in the proceedings, taken in the writ of *scire facias*, to be issued as aforesaid, or by the judgment thereon, be not repealed, then the said A. B., E. F. and G. H., their executors or administrators, or any or either of them, shall well and truly pay or cause to be paid to the said C. D., his legal representatives, or assigns, all costs, charges, damages or expenses which may be awarded to the said C. D., or to which he, they, or either of them shall be found entitled by reason of the said writ of *scire facias* or the judgment thereon, then this obligation shall be void, otherwise to remain in full force and virtue.

In witness whereof the parties hereto have hereunto set their hands and seals.

Signed, sealed and delivered, in the presence of

NOTE.—The costs, according to English practice, are taxable as between solicitor and client, and it may be so stated in the bond.

FORM 44.

WRIT OF SCIRE FACIAS.

In the Exchequer Court of Canada.

{Seal Exch. Court.} Her Majesty the Queen, at the relation of A.B., plaintiff, and C.D., defendant.

{Stamp, $1. Stamp, $1.} Victoria by the grace of God of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith.

To the Sheriff of the County of or any other of our Sheriffs in the Dominion of Canada, greeting:

Whereas, we, by our Letters Patent, dated day of A.D. 189 , sealed with the Seal of our Patent Office at the City of

Ottawa, Dominion of Canada, signed by the Honourable , our Commissioner of Patents, and , and numbered , did grant unto of his executors, administrators, legal representatives and assigns for the period of years from the date thereof, a Patent for a new and useful improvement in a description of which invention is contained in the specification, of which a duplicate is thereunto attached and made an essential part thereof, for the exclusive right, privilege and liberty of making, constructing and using, and vending to others to be used in our Dominion of Canada, the said invention, subject to the provisions of the Patent Act and amendments thereto, and adjudication before any Court of competent jurisdiction.

And, whereas, the said , being desirous for the reasons hereinafter mentioned to impeach the first recited Letters Patent, bearing date the day of , 189 , granted to the said as aforesaid, has obtained a sealed and certified copy thereof and of the petition, affidavit, specification and drawings relating thereto, and has, in accordance with the provisions in that behalf contained in the said Act and the amendments thereto, filed the said sealed and certified copies of said Letters Patent, petition, affidavit, specification and drawings in the office of the Registrar of our Exchequer Court of Canada, and the said Letters Patent and documents aforesaid, are now of record in the said Court.

(Here set out the title and assignments, giving numbers and dates, if necessary, showing the title in the defendant.)

And, whereas, we are given to understand that our said Letters Patent, bearing date the day of , A. D. 189 , and numbered , issued to the said as aforesaid, were and are contrary to law in this, that the said did in the said petition attached to said Letters Patent, state that he had invented certain new and useful improvements in not known or used by others before his invention thereof.

And, whereas, the said , in the said affidavit attached to said Letters Patent, did swear that he verily believed that he was the inventor of the alleged new and useful improvements in , described and claimed in the specifications attached to said Letters Patent, and did swear that the several allegations contained in the said petition were respectively true and correct.

And, whereas, we are given to understand that the did not invent the said alleged invention in the said petition and Letters Patent No. , mentioned and claimed.

And also that the said was not the true and first inventor of the said alleged invention of an improvement in , in said Letters Patent No. , mentioned and claimed, but that was the true and first inventor thereof.

And also that the specification to said Letters Patent No. , granted to the said , as aforesaid, does not correctly and fully describe the nature of the invention claimed to be patented thereby.

And also that the specification to said Letters Patent No. , granted to the said as aforesaid, does not correctly describe the mode or modes of operating the said alleged invention in said Letters Patent No. , mentioned and claimed.

And also that no person skilled in the art to which the invention pertained, from the said specifications and drawings, would be able to manufacture and construct the said alleged invention without directions and information other than contained in said Letters Patent.

And also that the said supposed invention was not at the time of the said making of the said Letters Patent of any use, benefit or advantage to the public.

And also that the specification does not claim that which is new and for the use of which the said claims are exclusive property and privilege *(or such other facts as the circumstances warrant in the special case)*

Also that the said invention was in public use and on sale for more than one year prior to the defendant's application for Letters Patent in Canada, with his consent or allowance as such inventor.

Also that a prior foreign patent for the same invention was granted to defendant more than one year prior to his application for Letters Patent in Canada.

Also, that said alleged invention had been previously patented to others, and had, previous to the alleged invention by defendant, been described in books and printed publications in Canada, and had been previously known or used by others prior to his alleged invention thereof.

By reason and means of which said several premises the said Letters Patent so granted as aforesaid to the said , were, are and ought to be void and of no force and effect in law.

And we being willing that what is just in the premises should be done

Command you, our Sheriff of our said County of , or other said Sheriffs, that by good and lawful men of your bailiwick you give notice to the said , that before us in our said Exchequer Court of Canada, he be, and appear, within ten days from the service upon him of such notice and of a copy of this writ, inclusive of the day of such service, to show, if he has or knows anything to say, why the said Letters Patent No. , as aforesaid, so granted to him ought not, for the reason aforesaid, be adjudged to be void, vacated, cancelled and disallowed, and further, to do and receive these things which our said Court shall consider right in that behalf, and that you then return and have there the names of those persons by whom you shall have caused

such notice to be given to the said of this writ, together with a copy of this writ immediately after the execution thereof.

Witness the Honourable , Judge of the Exchequer Court of Canada, at Ottawa, the day of , in the year of our Lord, one thousand eight hundred and ninety-four, and 57th year of our reign.

(Signed) L. A., *Registrar.*
Ex. Ct. Can.

FORM 45.

WARRANT BY THE SHERIFF TO HIS BAILIFFS.

In the Exchequer Court of Canada.

Her Majesty the Queen, at the relation of A. B., plaintiff, and C. D., defendant.

To and both of my bailiffs.

By virtue of the writ of Our Lady the Queen, to me directed, a copy whereof is hereunto annexed, whereby I am commanded that by good and lawful men of my bailiwick, I shall make known to , in the said writ named, that be and appear in the Exchequer Court of Our said Lady the Queen, within ten days of the service upon , respectively, of a copy of the said writ and a notice of the same, to show if *(he, they* or *either of them)* have or know anything to say for *(himself* or *themselves)* why certain Letters Patent granted to the said for sole use and benefit, for an invention for alleged new and useful improvements in duplicating check-books as in the said writ mentioned *(or as the case may be)*, and why the enrolment of said Letters Patent for certain reasons, in the said writ mentioned, ought not to be cancelled, vacated and disallowed, and further, to do and receive those things which the said Court of Our said Lady the Queen, should consider right in that behalf.

Now I command you that you make known and give notice to the said that be and appear in the said Exchequer Court of Canada of Our said Lady the Queen, at the time in the said writ mentioned to show cause and to do and receive such things as by the said writ *(they are)* required, and as by the said writ I am commanded.

Given under my hand and seal of office and dated this day of , A. D. 189 .

Sheriff.

L. S.
SHERIFF'S
OFFICE.

FORM 46.

NOTICE TO THE DEFENDANT (PATENTEE), SIGNED BY TWO BAILIFFS AND SERVED WITH THE WRIT OF "SCI. FA."

In the Exchequer Court of Canada.

Between Her Majesty the Queen at the relation of A. B., plaintiff, and C. D., defendant.

To C. D., of the City of , in the Province of *(calling)*.

We *(names of two bailiffs)* and both of the of in the County of , duly authorized bailiffs of the Sheriff of , do hereby give you notice that there has been placed in the hands of the Sheriff of a writ of *fieri facias*, issued in this cause on the day of , A. D. 1893, a copy of which is hereto annexed.

And we further give you notice that you be and appear before Her Majesty the Queen in her Exchequer Court of Canada, within ten days from the service upon you of this notice and of the copy of the said writ of *scire facias* hereto annexed, inclusive of the day of such service, to show, if you have or know anything to say for yourself, why the Letters Patent, No. , referred to in said writ, ought not for the reasons in said writ set out to be adjudged void, vacated, cancelled and disallowed; and further, to do and receive those things which Her Majesty's said Court shall consider right in that behalf.

And further, take notice that in default of your appearing as hereby notified, judgment will be obtained against you.

Dated the day of , A. D. 1893.

(*Signatures of two bailiffs*).

FORM 47.

DECLARATION.

In the Exchequer Court of Canada.

Her Majesty the Queen, at the relation of A. B., plaintiff, and C. D., defendant.

DOMINION OF CANADA, }
To wit: }

Our Lady the Queen sent to her Sheriff of the *City of or County of* , in the Dominion of Canada, her writ clothed in these words:

WRIT OF SCIRE FACIAS.

In the Exchequer Court of Canada.

The Queen *versus* . (*Here copy out The Writ of Scire Facias No. 44 and add.*)

Whereupon, on this present day, that is to say, on the day of , A. D. 189 , the said Sheriff of the *City of* *or County of* , returned to our said Lady the Queen, in her Exchequer Court of Canada, that by and , good and lawful men of his bailiwick, he had given notice to the said C. D., as he the said Sheriff was by the said writ commanded, and thereupon the said by solicitors, comes.

Whereupon (Sir John Sparrow David Thompson, Knight, Commander of the Most Honourable Court of St. Michael and St. George), Attorney-General of the Dominion of Canada, Solicitor of our said Lady the Queen, who for our said Lady the Queen, prosecutes in this behalf, being present in Court in his own proper person, prays that the said Letters Patent No. , may be adjudged to be void, vacated, cancelled and disallowed, upon the grounds in said writ mentioned, and also upon the further ground that the said invention as comprised in said Letters Patent No. , as patented, was not at the time of the alleged invention thereof and is not of any use, benefit or advantage to the public.

Declared this day of , A. D. 1893, by

Solicitor for the plaintiff.

FORM 48.

PARTICULARS OF OBJECTIONS FILED AND SERVED WITH THE DECLARATION.

In the Exchequer Court of Canada.

Her Majesty the Queen, at the relation of A. B., plaintiff, and C. D., defendant.

Particulars of objections as to the validity of Letters Patent for Canada No. .

1. That C. D. was not the inventor of the invention claimed by said Letters Patent No. , but that , of , was the first and true inventor thereof.

2. That said invention was not and is not of any utility or benefit to the public.

3. That the specifications do not correctly and fully describe the nature of said alleged invention or the mode or modes or operating the same, inasmuch as (here describe in what respect they are defective), and are insufficient, ambiguous and misleading, so that an ordinary skilled

artisan upon reading the said specifications could not, with the sole aid thereof and without directions and information other than that contained in the said Patent, make or construct the said alleged invention.

4. That the said specificatiops do not claim that which is new.

5. That said alleged invention was in public use or on sale for more than one year prior to the defendant's application for Letters Patent in Canada with his consent or allowance as such inventor, to wit: by K. L., of , at the City of , etc.

6. That a prior foreign Patent for the same invention was granted to the defendant more than one year prior to his application for Letters Patent in Canada, to wit: on the day of A. D. 189 , in France , to , of .

7. That said alleged invention had been previously patented to others prior to the date of the invention by the defendant in divers countries, to wit: No. , to X. V., in Germany, on the day of , 189 ; to X. V., in Great Britain on the day of , 189 , under No. .

8. That said alleged invention had been previously known or used by others prior to defendant's alleged invention thereof, by divers persons, to wit: By G. H., of , at the City of , during the year ; by K. L., of , at the City of , during the year , etc.

9. That said alleged invention had been described in "Chambers' Encyclopædia," Edition of , under heading , p. , prior to defendant's alleged invention, as well as in a publication in Canada called "The Engineer," edited in Toronto, under date of day of , 1889.

(Or such other facts or matters which may be set up to destroy the Patent in question, referred to in note under section 33, pp. 326–9, etc.).

FORM 49.

In the Exchequer Court of Canada.

Between Her Majesty the Queen, at the relation of A. B., plaintiff, and C. D., defendant.

The day of , 189 .

PLEAS.

And the said C. D., by Solicitors, as to the first suggestion in the writ of *scire facias* issued herein, whereby it is suggested that in the said writ named, did not invent the said invention in the said writ mentioned, says that the said

did invent the said invention and that the several allegations contained in the petition filed by the said referred to in the said writ, were respectively true and correct.

2. And as to the second suggestion in the said writ contained, whereby it is suggested and alleged that the said was not the true and first inventor of the said alleged invention, but that one was the true and first inventor thereof, the defendant says that the said was the true and first inventor of the said invention and that the said was not the true and first inventor thereof.

3. And as to the third suggestion in the said writ contained, whereby it is suggested and alleged that the specification to the said Letters Patent granted to the said , does not correctly and fully describe the nature of the invention claimed to be patented thereby, the defendant says that the said specification does correctly and fully describe the nature of the said invention.

4. And as to the fourth suggestion in the said writ contained whereby it is suggested and alleged that the specification does not correctly describe the mode or modes of operating said alleged invention in said Letters Patent mentioned and claimed, the defendant says the said specification does correctly describe the mode or modes of operating the said invention.

5. And as to the fifth suggestion in the said writ contained whereby it is suggested and alleged, that no person skilled in the art to which the invention pertains, from said specifications and drawings, would be able to manufacture and construct the said alleged invention, without directions and information, other than contained in said Letters Patent, the defendant says that said specifications and drawings contain all the information requisite to enable a person skilled as aforesaid, to manufacture and construct the said invention.

6. And as to the sixth suggestion in the said writ contained, whereby it is suggested and alleged that the said specification does not clearly and distinctly state the contrivance and things which are thereby claimed as new, and for the use of which the said claims an exclusive privilege and property, the said says that the said specification does clearly and distinctly state the contrivances and things which are thereby claimed as new and for the use of which claims such exclusive privilege and property. *(And so on for the other suggestions in the writ).*

Delivered the day of , A. D. 189 , in the city of , Ontario.

Solicitors for the defendants.

N. B.—*To be varied to suit the circumstances of the case.*

FORM 50.

In the Exchequer Court of Canada.

Between Her Majesty the Queen, at the relation of A. B., plaintiff, and C. D., defendant.

JOINDER OF ISSUE.

The day of A. D. 1893.

And the said (Sir John Sparrow David Thompson), who prosecutes as aforesaid for our said Lady the Queen, joins issue upon the defendant's plea and every of them.

Delivered the day of , A. D. 189 .

Solicitors for the plaintiff.

FORM 51.

In the Exchequer Court of Canada.

GENERAL ORDER.—PROCEDURE, ETC.

In pursuance of the provisions of the 55th section of *The Exchequer Court Act* (50-51 Victoria, chapter 16, and 52 Victoria, chapter 38), it is ordered that the following rules shall be in force in respect of any action, suit, matter or proceeding that may be had or taken in the Exchequer Court of Canada under or by virtue of *The Exchequer Court Amendment Act*, 1891, (54-55 Victoria, chapter 26):

1. The process, practice, pleadings, times for taking proceedings, forms and modes of procedure prescribed by the General Rules and Orders of the Exchequer Court of Canada of the fourth of March, 1876, and by subsequent General Rules and Orders of the said Court shall apply to any action, suit, matter or proceeding that may be had or taken in the said Court under or by virtue of *The Exchequer Court Amendment Act*, 1891, and such General Rules and Orders shall, notwithstanding any exception or limitation contained therein, apply as well to cases in which the cause of action arises in the Province of Quebec as to other cases.

2. Subject to such General Rules and Orders, the practice and procedure from time to time in force in Her Majesty's High Court of Justice in England in respect of like actions, suits, matters or proceedings shall apply to any action, suit, matter or proceeding that may be had or taken in the Exchequer Court of Canada under or by virtue of *The Exchequer Court Amendment Act*, 1891.

Dated at Ottawa, this 13th day of November, 1891.

GEO. W. BURBIDGE,
J. E. C.

FORM 52*a*.

In the Exchequer Court of Canada.

GENERAL ORDER.

In pursuance of the 55th section of "The Exchequer Court Act," 50-51 Victoria, chapter 16, and 52 Victoria, chapter 38, it is ordered that the following rules shall be in force in respect to any proceeding that may be had or taken in the Exchequer Court of Canada to impeach any patent issued under "The Patent Act" and the amendments thereto:—

1. In any proceeding for the impeachment of any patent under the 34th section of "The Patent Act," as amended by the Act 53 Victoria, chapter 13, intituled "An Act to amend The Patent Act," the practice and procedure which in like proceedings were in force in Her Majesty's High Court of Justice in England immediately prior to the passing of the Act of the Parliament of the United Kingdom of Great Britain and Ireland, 46 and 47 Victoria, chapter 57, intituled "An Act to amend and consolidate the Law relating to Patents for Invention, Registration of Designs and Trade Marks," shall be followed as near as may be.

2. In any such proceeding the party seeking to impeach the patent may, in addition to any ground or cause for impeachment that might be relied on under the 34th section of the said Act, set up and rely upon any ground or cause mentioned in the 37th section of "The Patent Act," as amended by the Act 55-56 Victoria, chapter 24, intituled "An Act to further amend the Patent Act."

3. If in any case it is sought to impeach a patent for one or more of the grounds or causes mentioned in section 37 of "The Patent Act," and for no other cause, a sealed and certified copy of the Patent and of the petition, affidavit, specification and drawings thereunto relating may be filed in the office of the Registrar of the Court, and proceedings to have the same declared null and void may thereupon be taken by information in the name of the Attorney-General of Canada, or by a statement of claim at the suit of any person interested in accordance with the ordinary practice of the Court.

Dated at Ottawa, this 5th day of December, A.D. 1892.

GEO. W. BURBIDGE,
J. E. C.

FORM 52*b*.

GENERAL ORDER.

In the Exchequer Court of Canada.

In pursuance of the provisions contained in the 56th section of the Exchequer Court Act (50–51 Vic., and 52 Vic., c. 38), it is ordered that the following rules in respect of the matters, hereinafter mentioned, shall be in force in the Exchequer Court of Canada:—

1. Any consent in writing signed by the parties, or their attorneys, may, by permission of the Registrar, be filed, and shall thereupon become an order of Court.

2. Whenever a claim is referred to the Court by the head of any Department of the Government of Canada, a consent in writing, signed by the parties or their attorneys, that such claim shall be heard without pleadings, may be filed with the Registrar, and shall thereupon become an order of Court.

3. The Court may, on the application of any party, order that any such claim shall be heard without pleadings.

4. Every such claim shall be ripe for hearing as soon as such order is taken out.

5. Rule III. of the Exchequer Court of Canada is hereby repealed, and the following substituted therefor:

RULE III.

Special case may be stated for opinion of Court.

The parties to any cause or matter may concur in stating the questions of law arising therein in the form of a special case for the opinion of the Court. Every such special case shall be divided into paragraphs, numbered consecutively, and shall concisely state such facts and documents as may be necessary to enable the Court to decide the questions raised thereby. Upon the argument of such case, the Court and the parties shall be at liberty to refer to the whole contents of such documents, and the Court shall be at liberty to draw from the facts and documents stated in any such special case any inference, whether of fact or law, which might have been drawn therefrom, if proved at trial.

Dated at Ottawa, this 8th day of February, A. D. 1894.

GEO. W. BURBIDGE, *J. E. C.*

FORM 52.

The Patent Act of 1872, 35 Vic., chap. 26, sec. 6.

"Sec. 6. Any person having invented any new and useful art, machine, manufacture or composition of matter, not known or used by others before his invention thereof, and not being in public use or on sale for more than one year previous to his application, in Canada, with the consent or allowance of the inventor thereof, may, on a petition to that effect presented to the Commissioner, and on compliance with the other requirements of this Act, obtain a patent granting to such person an exclusive property therein; and the said patent shall be under the seal

of the Patent Office and the signature of the Commissioner or the signature of another member of the Privy Council, and shall be good and avail to avail to the grantee, his executors, administrators or assigns, for the period mentioned in such patent, but no patent shall issue for an invention having an illicit object in view or abstract theorem."

Form 53.

REISSUE.

Under 12 Vic., ch. 24, sec. 7 (1849)

"7. That whenever any patent heretofore granted or hereafter to be granted as aforesaid shall be inoperative or invalid by reason of a defective or insufficient description or specification, if the error have or shall have arisen from inadvertency, accident or mistake, and without any fraudulent or deceptive intention, it shall be lawful for the patentee to surrender such patent and to obtain a new patent to be issued to him for the same invention for the residue of the unexpired period of the original patent, in accordance with the patentee's corrected description and specification; and in case of his death or of any assignment by him made of the original patent, a similar right shall vest in his executor, administrator or legal representative, and the patent so reissued, together with the corrected description and specification thereof, shall have the same effect and operation in law on the trial of all actions thereafter commenced for causes subsequently accruing, as if the same had been originally filed in such corrected form before the issuing of the original patent."

Form 54.

DISCLAIMER.

Under 12 Vic., ch. 24, sec. 8 (1849).

Sec. 8. "And be it enacted, that whenever, by mistake, accident, or inadvertence, and without any wilful default or intent to defraud or mislead the public; any patentee shall have made his specification of claim too broad, claiming more than that of which he was the original or first inventor, some material and substantial part of the thing patented, being truly and justly his own, or shall have in his specification claimed to be the original and first inventor or discoverer, of any material or substantial part of the thing patented, of which he was not the first and original inventor, and shall have no legal or just right to claim the same, in every such case the patentee, his executor, administrator, legal

representative or assign, whether of a whole or a fractional interest thereof, may make disclaimer of such parts as he shall not claim to hold by virtue of the patent or assignment thereof, stating in the said disclaimer the extent of his interest in such patent, and such disclaimer shall be in writing attested to by one witness, and recorded in the office of the said Secretary and shall be thereafter taken and considered as part of the original specification, to the extent of the interest possessed in the patent or right secured thereby by the disclaimant or by those claiming by or under him subsequent to the entry thereof, but such disclaimer shall not affect any actions pending at the time of its entry except so far as may relate to the question of unreasonable neglect or delay in filing the same; and the patent shall be deemed good and valid for so much of the invention or discovery as shall be truly and *bonâ fide* his own or not disclaimed provided it shall be a material and substantial part of the thing patented, and be definitely distinguished from other parts so claimed without right as aforesaid; and such patentee, his executor or legal representative and assigns, whether of the whole or a fractional interest therein as aforesaid, shall be entitled to maintain a suit at law or in equity on such patent for any infringement of so much of the invention or discovery as shall be *bonâ fide* his own, as aforesaid, notwithstanding such disclaimer or larger specification, as aforesaid; and in case of judgment or verdict in his favour, he shall not be entitled to recover costs against the defendant unless he shall have entered as aforesaid in the office of the Provincial Secretary, the said disclaimer of all that part of the thing patented so claimed without right: Provided also, that no person bringing such suit shall be entitled to the benefits contained in this section who shall have unreasonably neglected or delayed to enter in the said office the disclaimer as aforesaid."

FORM 55.

Under 12 Vic., ch. 24, sec. 22 (1849).

Section 22. "Every person or corporation established in this Province having purchased, constructed, invented or discovered as aforesaid, any new machine, manufacture or composition of matter, prior to the application of a patent therefor by a person claiming to be the inventor or discoverer thereof, shall possess the right to use and vend to others to be used, the specific machine, manufacture or composition of matter so made, purchased or introduced, without liability to the patentee or any other person interested in such invention; and no patent shall be held to be invalid by reason of such purchase, sale or use, prior to the application for such patent as aforesaid, except on proof of abandonment of such invention to the public or that such sale or prior use existed for more than one year prior to such application for a patent."

FORM 59.

TERMS OF PATENTS IN THE PRINCIPAL COUNTRIES OF THE WORLD.

Country.	Legal Term.	Term Covered by 1st Fee.	When Taxes Must be Paid.	WHO MAY OBTAIN A PATENT.
United States	17 years	17 years	None	*The inventor or his assignee.
Canada	18 "	6 "	Before end of 6th and 12th years	*The inventor or his assignee.
Great Britain	14 "	4 "	Annually after 4th year.	‡The inventor or an importer, whether a firm or corporation.
Germany	15 "	1 "	"	‡+Anyone.
France	15 "	1 "	"	+*Anyone.
Patent of addition	Expires with original patent.	Full term	None	||
Argentine Republic.	5, 10 or 15 years	Full term elected.	"	*The inventor or his assignee.
Patent of addition	Expires with original patent.	Full term	"	
Austria	15 years	1 year	Annually	*+Anyone.
Belgium	20 "	1 "	"	‡++Anyone.
Patent of addition	Expires with original patent.	Full term	None	||
Brazil	15 years	1 year	Annually	*The inventor or his assignee.
Patent of addition	Expires with original patent.	Full term	None	||
India	14 years	4 years	Annually	‡¶The inventor or his assignee.
Italy	15 "	1 "	"	‡†The inventor or his assignee.
Patent of addition	Expires with original patent.	Full term	None	||
Mexico	20 years	20 years	"	*The inventor or his lawful representative.
New South Wales	14 "	14 "	"	The inventor or importer, or their legal representatives or assigns.
New Zealand	14 "	4 "	Before 4th and 7th yrs.	‡The inventor or his assignee.
Portugal	1, 5, 10 or 15 years.	Full term	None	+*Anyone.
		A patent of prolongation may be obtained, before the expiry of a patent, to extend it to the full term.		

Queensland	14 years	4 years	Before 4th and 7th yrs., or annually	‡The inventor or his assignee.
Russia	3, 5 or 10 years	Full term	None	*The inventor or his assignee.
Patent of Importation	1, 2, 3, 4, 5, 6 years	"	"	§
South Australia	14 years	3 years	Before end of 3rd and 7th years	*Inventor or his assignee.
Spain	20 "	1 "	Annually	°The inventor or an importer.
Patent of Importation	5 and 10 years	1 "	"	‡
Patent of Addition	Expires with original patent.	Full term	None	‖
Sweden	15 years	1 year	Annually	‡The inventor or his assignee.
Patent of Addition	Expires with original patent.	Full term	None	‖
Norway	15 years	1 year	Annually	‡The inventor or his assignee.
Patent of Addition	Expires with original patent.	Full term	None	‖
Switzerland	15 years	1 year	Annually	‡The inventor or his assignee.
Patent of Addition	Expires with original patent.	Full term	None	‖
Tasmania	14 years	3 years	Before end of 3rd and 7th years	*The inventor or an importer.
Victoria	14 "	3 "	Before end of 3rd and 7th years	‡The actual inventor, his legal representatives or assigns.
West Australia	14 "	4 "	Before end of 4th and 7th years	‡Inventor.
Letters of Registration for W. A	Expire with foreign patent on which they are based.	Full term	None	The bonâ fide holder of a foreign patent.

†The inventor's consent in writing should be kept by the applicant as a proof that he was duly authorized to apply for the Patent, as otherwise his Patent might be voided.

°In Spain an inventor holding a prior foreign Patent may obtain a ten-year Patent therefor. An importer of an invention, the subject of a prior foreign Patent, may obtain only a five-year Patent.

*In these countries, Patents based on prior foreign Patents expire at the end of the legal term of the foreign Patent having the shortest term.

†In these countries, Patents based on prior foreign Patents expire at the end of the legal term of the foreign Patent having the longest term, the total duration of the Patent not to exceed the legal term for which it was granted.

¶An Indian Patent will expire with the actual expiration of a prior foreign Patent for the same invention, unless there exists a British Patent, when the Indian Patent expires with the actual expiration of the British Patent.

‡In these countries an extension of time may be obtained for the payment of taxes.

‖A Patent of Addition is a Patent for improvements on an original patented invention.

§A Patent of Importation is a Patent for an invention which is the subject of a prior foreign Patent.

APPENDIX III.

THE PATENT ACT OF CANADA.

Revised Statutes of Canada, c. 61 (A.D., 1886), "*An Act respecting Patents of Invention*," as it stands amended subsequent to the session of 1894 of the House of Commons of Canada.

N.B.—The side notes of the various sections may be found collected in the contents of Chapter 2, near the commencement of this book.

(PART I. OF BOOK.)

Her Majesty, by and with the advice and consent of the Senate and House of Commons of Canada, enacts as follows :—

SHORT TITLE.

1. This Act may be cited as "*The Patent Act*," 35 V., c. 26, s. 53.

INTERPRETATION.

2. In this Act, unless the context otherwise requires,—

(*a*) The expression "the Minister" means the Minister of Agriculture ;

(*b*) The expression "Commissioner" means the Commissioner of Patents, and the expression "Deputy Commissioner" means the Deputy Commissioner of Patents ;

(*c*) The expression "invention" means any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement in any art, machine, manufacture or composition of matter ;

(*d*) The expression "legal representatives" includes heirs, executors, administrators and assigns or other legal representatives. *For notes to secs. 1 and 2 and sub-sections of sec. 2, see pp. 21-25.*

(PART II. OF BOOK).

PATENT OFFICE AND APPOINTMENT OF OFFICERS.

3. There shall be attached to the Department of Agriculture, as a branch thereof, an office which shall be called the "Patent Office" ; and the Minister of Agriculture for the time being shall be the Commissioner of Patents. 35 V., c. 26, s. 1, *part*. *For note see p. 25.*

4. The Commissioner shall receive all applications, fees, papers, documents and models for patents, and shall perform and do all acts and things requisite for the granting and issuing of patents of invention; and he shall have the charge and custody of the books, records, papers, models, machines and other things belonging to the Patent Office. 35 V., c. 26, s. 1, *part.*

5. The Governor in Council may appoint a Deputy Commissioner of Patents, whose salary shall be two thousand eight hundred dollars per annum, and may, from time to time, appoint such officers and clerks under such Deputy Commissioner as are necessary for the purposes of this Act, and such Deputy Commissioner, officers and clerks shall hold office during pleasure.

2. The Deputy Commissioner of Patents shall, subject to the head of the Department to which the Patent Office may be, at any time, attached, oversee and direct the officers, clerks and employees in the Patent Office and shall have general control of the business thereof, and shall perform such other duties as are assigned to him by the Governor in Council. 35 V., c. 26, s. 4, *part*; The Patent Act (1886), 51 V., c. 18, s. 1. *For note see p. 26.*

6. The Commissioner shall cause a seal to be made for the purposes of this Act, and may cause to be sealed therewith every patent and other instrument and copy thereof issuing from the Patent Office. 35 V., c. 26, s. 2, *part.* *For note see pp. 26, 27.*

(PART III. OF BOOK.)

APPLICATIONS FOR PATENTS.

7. Any person who has invented any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement in any art, machine, manufacture or composition of matter, which was not known or used by any other person before his invention thereof, and which has not been in public use or on sale with the consent or allowance of the inventor thereof, for more than one year previously to his application for patent therefor in Canada, may, on a petition to that effect, presented to the Commissioner, and on compliance with the other requirements of this Act, obtain a patent granting to such person an exclusive property in such invention: *For notes see pp. 27-71.*

2. No patent shall issue for an invention which has an illicit object in view, or for any mere scientific principle or abstract theorem. 35 V., c. 26, s. 6, *part.* *For notes see pp. 71-73.*

8. Any inventor who elects to obtain a patent for his invention in a foreign country before obtaining a patent for the same invention in Canada, may obtain a patent in Canada, if the same be applied for within one year from the date of the issue of the first foreign patent for

such invention; and, if within three months after the date of the issue of a foreign patent, the inventor gives notice to the Commissioner of his intention to apply for a patent in Canada for such invention, then no other person having commenced to manufacture the same device in Canada during such period of one year, shall be entitled to continue the manufacture of the same after the inventor has obtained a patent therefor in Canada, without the consent or allowance of the inventor; and under any circumstances, if a foreign patent exists, the Canadian patent shall expire at the earliest date on which any foreign patent for the same invention expires. 35 V., c. 26, s. 7, The Patent Act (1886); 55 and 56 V., c. 24, s. 1 (1892). *For notes see pp. 73-83.*

9. Any person who has invented any improvement on any patented invention, may obtain a patent for such improvement; but he shall not thereby obtain the right of vending or using the original invention, nor shall the patent for the original invention confer the right of vending or using the patented improvement. 35 V., c. 26, s. 9. *For notes see pp. 83-86.*

10. Every inventor shall, before a patent can be obtained, make oath, or when entitled by law to make an affirmation instead of an oath, shall make an affirmation, that he verily believes that he is the inventor of the invention for which the patent is asked and that the several allegations in the petition contained are respectively true and correct: 35 V., c. 26, s. 11.

2. In the event of the inventor being dead, such oath or affirmation shall be made by the applicant, and shall state that he verily believes that the person whose assignee or legal representative he is, was the inventor of the invention for which the patent is solicited, and that the several allegations in the petition contained are respectively true and correct: 35 V., c. 26, s. 11.

3. Such oath or affirmation may be made before a minister plenipotentiary, *chargé d'affaires*, consul, vice-consul, or consular agent, a judge of any court, a notary public, a justice of the peace, or the mayor of any city, borough or town, or a commissioner for taking affidavits, having authority or jurisdiction within the place where the oath may be administered. 35 V., c. 26, s. 11; 36 V., c. 44, s. 3; The Patent Act (1886), 55-56 V., c. 24, s. 2 (1892). *For notes see pp. 86-91.*

11. The applicant for a patent shall, for the purposes of this Act, elect his domicile at some known and specified place in Canada, and shall mention the same in his petition for a patent. 35 V., c. 26, s. 12. *For note see p. 91.*

12. The applicant shall, in his petition for a patent, insert the title or name of the invention, and shall, with the petition, send in a specification in duplicate of the invention and an additional or third copy of the claim or claims. 35 V., c. 26, s. 13, The Patent Act (1886); 56 V., c. 34, s. 1. *For notes see pp. 91-98.*

13. The specification shall correctly and fully describe the mode or modes of operating the invention, as contemplated by the inventor; and shall state clearly and distinctly the contrivances and things which he claims as new and for the use of which he claims an exclusive property and privilege:

2. Such specification shall bear the name of the place where, and the date when it is made, and shall be signed by the inventor, if he is alive, and if not, by the applicant, and by two witnesses to such signature of the inventor or applicant:

3. In the case of a machine, the specification shall fully explain the principle and the several modes in which it is intended to apply and work out the same:

4. In the case of a machine, or in any other case in which the invention admits of illustration by means of drawings, the applicant shall also, with his application, send in drawings in duplicate, showing clearly all parts of the invention; and each drawing shall bear the signature of the inventor, if he is alive, and if not, of the applicant, or of the attorney of such inventor or applicant, and shall have written references corresponding with the specification; but the Commissioner may require further drawing or dispense with any of them, as he sees fit:

5. One duplicate of the specification and of the drawings, if there are drawings, shall be annexed to the patent, of which it shall form an essential part, and the other duplicate shall remain deposited in the patent office:

6. The Commissioner may, in his discretion, dispense with the duplicate specification and drawing, and in lieu thereof cause copies of the specification and drawing, in print or otherwise, to be attached to the patent, of which they shall form an essential part. 35 V., c. 26, s. 14 —36 V., c. 44, s. 4. *For notes see pp. 98-114.*

14. In all cases in which the invention admits of representation by model, the applicant, if required by the Commissioner, shall furnish a model of convenient size, exhibiting its several parts in due proportion; and when the invention is a composition of matter, the applicant, if required by the Commissioner, shall furnish specimens of the ingredients, and of the composition, sufficient in quantity for the purpose of experiment. If such ingredients or composition be of an explosive or dangerous character, they shall be furnished with such precautions as are prescribed in the requisition therefor. 35 V., c. 26, s. 15, The Patent Act; 55-56 V., c. 24, s. 3. *For notes see pp. 114-117.*

15. No application for a patent shall be withdrawn without the consent in writing of each and every registered assignee of such patent or any part thereof. 35 V., c. 26, s. 38, *part.* The Patent Act, 55 and 56 V., c. 24, s. 4. *For notes see pp. 117, 118.*

(PART IV. OF BOOK.)

REFUSAL TO GRANT PATENTS.

16. The Commissioner may object to grant a patent in any of the following cases :—

(*a*) When he is of opinion that the alleged invention is not patentable in law ;

(*b*) When it appears to him that the invention is already in the possession of the public, with the consent or allowance of the inventor ;

(*c*) When it appears to him that there is no novelty in the invention ;

(*d*) When it appears to him that the invention has been described in a book or other printed publication before the date of the application, or is otherwise in the possession of the public ;

(*e*) When it appears to him that the invention has already been patented in Canada or elsewhere, if the case is one within the eighth section of this Act, unless the Commissioner has doubts as to whether the patentee or the applicant is the first inventor. 35 V., c. 26, s. 40. *For notes see pp. 119-150.*

17. Whenever the Commissioner objects to grant a patent as aforesaid, he shall notify the applicant to that effect and shall state the ground or reason therefor, with sufficient detail to enable the applicant to answer, if he can, the objection of the Commissioner. 35 V., c. 26, s. 41. *For notes see pp. 150-151.*

18. Every applicant who has failed to obtain a patent by reason of the objection of the Commissioner, as aforesaid, may, at any time within six months after notice thereof has been addressed to him or his agent, appeal from the decision of the Commissioner to the Governor-in-Council. 35 V., c. 26, s. 42. *For notes see p. 152.*

(PART V. OF BOOK.)

CONFLICTING APPLICATIONS.

19. In case of conflicting applications for any patent, the same shall be submitted to the arbitration of three skilled persons, two of whom shall be chosen by the applicants, one by each, and the third of whom shall be chosen by the Commissioner or by the Deputy Commissioner, or by the person appointed to perform the duty of that officer ; and the decision or award of such arbitrators, or of any two of them, delivered to the Commissioner in writing, and subscribed by them or any two of them, shall be final, as far as concerns the granting of the patent :

2. If either of the applicants refuses or fails to choose an arbitrator, when required so to do by the Commissioner ; and if there are only two such applicants, the patent shall issue to the opposing applicant :

3. If there are more than two conflicting applications, and if the persons applying do not all unite in appointing three arbitrators, the Commissioner or the Deputy Commissioner or person appointed to perform the duty of that officer, may appoint the three arbitrators for the purposes aforesaid:

4. The arbitrators so named shall subscribe and take, before a judge of any court of record in Canada, an oath in the form following, that is to say:—

"I, the undersigned (*A. B.*), being duly appointed an arbitrator under the authority of '*The Patent Act*,' do hereby solemnly swear (*or affirm, as the case may be*), that I will well and truly perform the duty of such arbitrator on the conflicting applications of (*C. D.* and *E. F.*) submitted to me:"

5. The arbitrators, or any one of them, when so sworn, may summon before them any applicant or other person, and may require him to give evidence on oath, orally or in writing (*or on solemn affirmation, if such applicant or person is entitled to affirm in civil cases*), and to produce such documents and things as such arbitrators deem requisite to the full investigation of the matters into which they are appointed to examine, and they shall have the same power to enforce the attendance of such applicants and other persons, and to compel them to give evidence, as is vested in any court of justice in civil cases, in the Province in which the arbitration is held: but no such applicant or person shall be compelled to answer any question, by his answer to which he might render himself liable to a criminal prosecution:

6. The fees for the services of such arbitrators shall be a matter of agreement between the arbitrators and the applicants, and shall be paid by the applicants who name them, respectively, except those of the arbitrator or arbitrators named by the Commissioner, which shall be paid by the applicants jointly. 35 V., c. 26, s. 43, *part*. *For notes see pp. 154-162.*

(PART VI. OF BOOK.)

GRANT AND DURATION OF PATENTS.

20. Every patent granted under this Act shall contain the title or name of the invention, with a reference to the specification, and shall grant to the patentee and his legal representatives, for the term therein mentioned, from the granting of the same, the exclusive right, privilege and liberty of making, constructing and using, and vending to others to be used, the said invention, subject to adjudication in respect thereof before any court of competent jurisdiction:

2. In cases of joint applications, the patents shall be granted in the names of all the applicants. 35 V., c. 26, s. 10, *part*, and s. 16;—36 V., c. 44, s. 5. *For notes see pp. 163-165.*

21. Every patent shall be issued under the seal of the Patent Office and the signature of the Commissioner or of the Deputy Commissioner, and when duly registered, shall be good, and shall avail the grantee and his legal representatives for the term mentioned in the patent: 35 V., c. 26, s. 6, *part*, and s. 18, Patent Act (1886); 56 V., c. 34, s. 2.

2. The Commissioner may require that any patent, before it is signed by the Commissioner or by any other member of the Queen's Privy Council for Canada, acting for him, and before the seal hereinbefore mentioned is affixed to it, shall be examined by the Minister of Justice; and if such examination is so required, the Minister of Justice shall, accordingly, examine it, and if he finds it conformable to law, he shall certify accordingly, and such patent may then be signed, and the seal affixed thereto. 35 V., c. 26, s. 6, *part*, and s. 18. *For notes see pp. 166-168.*

22. The term limited for the duration of every patent of invention issued by the Patent Office shall be eighteen years; but at the time of the application therefor it shall be at the option of the applicant to pay the full fee required for the term of eighteen years, or the partial fee required for the term of six years, or the partial fee required for the term of twelve years: 46 V., c. 19, s. 1, Patent Act (1886); 55, 56 V., c. 24, s. 5 (1892).

2. If a partial fee only is paid, the proportion of the fee paid shall be stated in the patent, and the patent shall, notwithstanding anything therein or in this Act contained, cease at the end of the term for which the partial fee has been paid, unless before the expiration of the said term the holder of the patent pays the fee required for the further term of six or twelve years, and obtains from the Patent Office a certificate of such payment in the form which is, from time to time, adopted, which certificate shall be attached to and refer to the patent, and shall be under the signature of the Commissioner or of the Deputy Commissioner: 46 V., c. 19, s. 1, Patent Act (1886); 55, 56 V., c. 24, s. 5; 56 V., c. 34, s. 3.

3. If such second payment, together with the first payment, makes up only the fee required for twelve years, then the patent shall, notwithstanding anything therein or in this Act contained, cease at the end of the term of twelve years, unless at or before the expiration of such term the holder thereof pays the further fee required for the remaining six years, making up the full term of eighteen years, and obtains a like certificate in respect thereof. 46 V., c. 19, s. 1, The Patent Act (1886); 55, 56 V., c. 24, s. 5. *For notes see pp. 168-172.*

(PART VII. OF BOOK.)

REISSUE OF PATENTS.

23. Whenever any patent is deemed defective or inoperative by reason of insufficient description or specification or by reason of the patentee claiming more than he had a right to claim as new, but at the same time it appears that the error arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention, the Commissioner may, upon the surrender of such patent and the payment of the further fee hereinafter provided, cause a new patent, in accordance with an amended description and specification made by such patentee, to be issued to him for the same invention for any part or for the whole of the then unexpired residue of the term for which the original patent was, or might have been granted:

2. In the event of the death of the original patentee or of his having assigned the patent, a like right shall vest in his assignee or his legal representatives:

3. Such new patent, and the amended description and specification, shall have the same effect in law, on the trial of any action thereafter commenced for any cause subsequently accruing, as if the same had been originally filed in such corrected form before the issue of the original patent:

4. The Commissioner may entertain separate applications, and cause patents to be issued for distinct and separate parts of the invention patented, upon payment of the fee for a reissue for each of such reissued patents. 35 V., c. 26, s. 19;—38 V., c. 14, s. 1. *For notes see pp. 173-194.*

(PART VIII. OF BOOK.)

DISCLAIMERS.

24. Whenever, by any mistake, accident or inadvertence, and without any wilful intent to defraud or mislead the public, a patentee has made his specification too broad, claiming more than that of which he or the person through whom he claims was the first inventor,—or has, in the specification, claimed that he or the person through whom he claims was the first inventor of any material or substantial part of the invention patented, of which he was not the first inventor, and to which he had no lawful right—the patentee may, on payment of the fee hereinafter provided, make disclaimer of such parts as he does not claim to hold by virtue of the patent or the assignment thereof:

2. Such disclaimer shall be in writing, and in duplicate, and shall be attested in the manner hereinbefore prescribed in respect of an application for a patent; one copy thereof shall be filed and recorded in the office of the Commissioner, and the other copy thereof shall be attached to the patent and made a part thereof by reference, and such

disclaimer shall thereafter be taken and considered as part of the original specification :

3. Such disclaimer shall not affect any action pending at the time of its being made, except in so far as relates to the question of unreasonable neglect or delay in making it :

4. In case of the death of the original patentee, or of his having assigned the patent, a like right shall vest in his legal representatives, any of whom may make disclaimer :

5. The patent shall thereafter be deemed good and valid for so much of the invention as is truly the invention of the disclaimant, and is not disclaimed, if it is a material and substantial part of the invention, and is definitely distinguished from other parts claimed without right ; and the disclaimant shall be entitled to maintain an action or suit in respect of such part accordingly. 35 V., c. 26, s. 20. *For notes see pp. 195-211.*

(PART IX. OF BOOK.)

ASSIGNMENTS.

25. The patent may be granted to any person to whom the inventor, entitled under this Act to obtain a patent, has assigned or bequeathed the right of obtaining the same, or in default of such assignment or bequest, to the legal representatives of the deceased inventor. 35 V., c. 26, s. 8 ; 36 V., c. 44, s. 2. *For notes see pp. 212-214.*

26. Every patent issued for an invention shall be assignable in law, either as to the whole interest or as to any part thereof, by any instrument in writing ; but such assignment, and every grant and conveyance of any exclusive right to make and use and to grant to others the right to make and use the invention patented, within and throughout Canada or any part thereof, shall be registered in the Patent Office in the manner, from time to time, prescribed by the Commissioner for such registration ; and every assignment affecting a patent for invention shall be null and void against any subsequent assignee, unless such instrument is registered as hereinbefore prescribed, before the registration of the instrument under which such subsequent assignee claims. 35 V., c. 26, s. 22. *For notes see pp. 214-241.*

27. In cases of joint applications or grants, every assignment from one or more of the applicants or patentees to the other or others, or to any other person, shall be registered in like manner as other assignments. 35 V., c. 26, s. 10, *part*. *For notes see pp. 241-242.*

(PART X. OF BOOK.)

IMPEACHMENT AND OTHER LEGAL PROCEEDINGS IN RESPECT OF PATENTS.

28. A patent shall be void, if any material allegation in the petition or declaration of the applicant hereinbefore mentioned in respect of such patent is untrue, or, if the specifications and drawings contain more or less than is necessary for obtaining the end for which they purport to be made, when such omission or addition is wilfully made for the purpose of misleading; but, if it appears to the Court that such omission or addition was an involuntary error, and if it is proved that the patentee is entitled to the remainder of his patent *pro tanto*, the Court shall render a judgment in accordance with the facts, and shall determine as to costs, and the patent shall be held valid for such part of the invention described, as the patentee is so found entitled to; and two office copies of such judgment shall be furnished to the Patent Office by the patentee, one of which shall be registered and remain of record in the office, and the other of which shall be attached to the patent, and made a part of it by a reference thereto. 35 V., c. 26, s. 27. *For notes see pp. 243-245.*

29. Every person who, without the consent in writing of the patentee, makes, constructs or puts in practice any invention for which a patent has been obtained under this Act or any previous Act, or who procures such invention from any person not authorized by the patentee or his legal representatives to make or use it, and who uses it shall be liable to the patentee or his legal representatives in an action of damages for so doing; and the judgment shall be enforced, and the damages and costs that are adjudged shall be recoverable in like manner as in other cases in the Court in which the action is brought. 35 V., c. 26, s. 23. *For notes see pp. 245-269.*

30. Any action for the infringement of a patent may be brought in any Court of record having jurisdiction, to the amount of damages claimed, in the Province in which the infringement is alleged to have taken place, and which is also that one of the said Courts which holds its sittings nearest to the place of residence or of business of the defendant; and such Court shall decide the case and determine as to costs. 35 V., c. 26, s. 24, *part*. *For notes see pp. 270-286.*

31. In any action for the infringement of a patent, the Court, if sitting, or any Judge thereof if the Court is not sitting, may, on the application of the plaintiff or defendant respectively, make such order for an injunction, restraining the opposite party from further use, manufacture or sale of the subject matter of the patent, and for his punishment in the event of disobedience of such order, or for inspection or account, and respecting the same and the proceedings in the action, as the Court or Judge sees fit, but from such order, an appeal shall lie under the same circumstances, and to the same Court, as from other judgments or orders

of the Court in which the order is made. 35 V., c. 26, s. 24, *part. For notes see pp. 286-324.*

32. Whenever the plaintiff, in any such action, fails to sustain his action, because his specification and claim embrace more than that of which he was the first inventor, and it appears that the defendant used or infringed any part of the invention justly and truly specified and claimed as new, the Court may discriminate,—and the judgment may be rendered accordingly. 35 V., c. 26, s. 25. *For notes see pp. 325-326.*

33. The defendant, in any such action, may plead specially as matter of defence, any fact or default which, by this Act, or by law, renders the patent void; and the Court shall take cognizance of that special pleading and of the facts connected therewith, and shall decide the case accordingly. 35 V., c. 26, s. 26. *For notes see pp. 326-331.*

34. Any person who desires to impeach any patent issued under this Act may obtain a sealed and certified copy of the patent and of the petition, affidavit, specification and drawings thereunto relating, and may have the same filed in the office of the prothonotary or clerk of the Superior Court for Lower Canada in Quebec, or of any of the divisions of the High Court of Justice for Ontario, or of the Supreme Court in Nova Scotia, or of the Supreme Court in New Brunswick, or of the Supreme Court of Judicature in Prince Edward Island, or of the Supreme Court in British Columbia, or of the Court of Queen's Bench in Manitoba, or of the Supreme Court in the North-West Territories, according to the domicile elected by the patentee, as aforesaid, or in the office of the Registrar of the Exchequer Court of Canada,—which Courts, respectively, shall adjudicate on the matter and decide as to costs; and if the domicile elected by the patentee is in the District of Keewatin, the Court of Queen's Bench of Manitoba shall have jurisdiction until there is a Superior Court in such District, after which such Superior Court shall have jurisdiction. 35 V., c. 26, s. 29; 37 V., c. 44, s. 1; 38 V., c. 14, s. 8; 49 V., c. 25, s. 14. The Patent Act (1886). 53 V., c. 13, s. 1.

2. The patent and documents aforesaid shall then be held as of record in such Courts respectively, so that a writ of *scire facias* under the seal of the Court, grounded upon such record, may issue for the repeal of the patent, for cause as aforesaid, if, upon proceedings had upon the writ in accordance with the meaning of this Act, the patent is adjudged to be void. 35 V., c 26, s. 29; 37 V., c. 44, s. 1; 38 V., c. 14, s. 8; 49 V., c. 25, s. 14. *For notes see pp. 332-341.*

35. A certificate of the judgment avoiding any patent shall, at the request of any person filing it to make it of record in the Patent Office, be entered on the margin of the enrolment of the patent in the Patent Office, and the patent shall thereupon be, and be held to have been void and of no effect, unless the judgment is reversed on appeal as hereinafter provided, 35 V., c. 26, s. 30. *For notes see pp. 341-342.*

36. The judgment declaring or refusing to declare any patent void shall be subject to appeal to any Court having appellate jurisdiction in other cases decided by the Court by which the judgment declaring or refusing to declare such patent void, was rendered. 35 V., c. 26, s. 31. *For notes see pp. 342-343.*

(PART XI. OF BOOK.)

FORFEITURE OF PATENTS.

37. Every patent granted under this Act shall be subject, and be expressed to be subject, to the following conditions :—

(*a*) That such patent and all the rights and privileges thereby granted shall cease and determine, and that the patent shall be null and void at the end of two years from the date thereof, unless the patentee or his legal representatives, or his assignee, within that period or any authorized extension thereof, commence, and after such commencement, continuously carry on in Canada the construction or manufacture of the invention patented, in such a manner that any person desiring to use it may obtain it, or cause it to be made for him at a reasonable price, at some manufactory or establishment for making or constructing it in Canada ;

(*b*) That if, after the expiration of twelve months from the granting of a patent, or any authorized extension of such period, the patentee or patentees, or any of them, or his or their representatives, or his or their assignee, for the whole or a part of his or their interest in the patent, imports, or causes to be imported into Canada, the invention for which the patent is granted, such patent shall be void as to the interest of the person or persons importing or causing to be imported as aforesaid :

2. Any question which arises as to whether a patent, or any interest therein, has or has not become void, under the provisions of this section, may be adjudicated upon by the Exchequer Court of Canada, which Court shall have jurisdiction to decide any such question upon information in the name of the Attorney-General of Canada, or at the suit of any person interested :

3. This section shall not be held to take away or affect the jurisdiction which any Court other than the Exchequer Court of Canada possesses. 35 V., c. 26, s. 28 ; 38 V., c. 14, s. 2 ; 45 V., c. 22, s. 1. The Patent Act (1886). 53 V., c. 13, s. 2 (1890) ; 54, 55 V., c. 33, s. 1 (1891) ; 55, 56 V., c. 24, s. 6 (1892).

2. Whenever a patentee has been unable to carry on the construction or manufacture of his invention within the two years hereinbefore mentioned, the Commissioner may, at any time not more than three

months before the expiration of that term, grant to the patentee an extension of the term of two years on his proving to the satisfaction of the Commissioner that he was, for reasons beyond his control, prevented from complying with the above condition :

3. The Commissioner may grant to the patentee, or to his legal representatives or assignee for the whole or any part of the patent, an extension for a further term not exceeding one year, beyond the twelve months limited by this section, during which he may import or cause to be imported into Canada the invention for which the patent is granted, if the patentee or his legal representatives, or assignee for the whole or any part of the patent, show cause, satisfactory to the Commissioner, to warrant the granting of such extension ; but no extension shall be granted unless application is made to the Commissioner at some time within three months before the expiry of the twelve months aforesaid, or of any extension thereof. 35 V., c. 26, s. 28 ; 38 V., c. 14, s. 2 ; 45 V., c. 22, s. 1. *For notes see pp. 344-404.*

(PART XII. OF BOOK.)

CAVEATS.

38. Any intending applicant for a patent who has not yet perfected his invention and is in fear of being despoiled of his idea, may file, in the Patent Office, a description of his invention so far, with or without plans, at his own will ; and the Commissioner, on payment of the fee in this Act prescribed, shall cause the said document, which shall be called a caveat, to be preserved in secrecy, with the exception of delivering copies of the same whenever required by the said applicant or by any judicial tribunal,—but the secrecy of the document shall cease when the applicant obtains a patent for his invention :

2. If application is made by any other person for a patent for any invention with which such caveat may, in any respect, interfere, the Commissioner shall forthwith give notice, by mail, of such application, to the person who has filed such caveat, and such person shall, within three months after the date of mailing the notice, if he wishes to avail himself of the caveat, file his petition and take the other steps necessary on an application for a patent, and if, in the opinion of the Commissioner, the applications are conflicting, like proceedings may be had in all respects as are by this Act provided in the case of conflicting applications :

3. Unless the person filing a *caveat* makes application within one year from the filing thereof for a patent, the Commissioner shall be relieved from the obligation of giving notice, and the caveat shall then remain as a simple matter of proof as to novelty or priority of invention, if required. 35 V., c. 26, s. 39. *For notes see pp. 405-409.*

(PART XIII. OF BOOK.)

PATENT FEES.

39. The following fees shall be payable before an application for any of the purposes herein mentioned shall be received by the Commissioner, that is to say :—

Full fee for 18 years	$60 00
Partial fee for 12 years	40 00
Partial fee for 6 years	20 00
Fee for further term of 12 years	40 00
Fee for further term of 6 years	20 00
On lodging a *caveat*	5 00
On asking to register a judgment *pro tanto*	4 00
On asking to register an assignment or any other document affecting or relating to a patent, and for each and every patent mentioned in the notice given under section 8 of this Act	2 00
On asking to attach a disclaimer to a patent	2 00
On asking for a copy of patent with specification	4 00
On petition to reissue a patent after surrender, and on petition to extend a former patent to the whole of Canada for every unexpired year of the duration of the provincial or sub-patent, the fee shall be at the rate of	4 00

On office copies of documents, not above mentioned, the following charges shall be made :—

For every single or first folio of certified copy	0 25
For every subsequent hundred words (fractions from and under fifty not being counted, and over fifty being counted for one hundred)	0 10

35 V., c. 26, s. 34, The Patent Act (1886); 53 V., c. 13, s. 3; 55-56 V., c. 24, s. 7; 56 V., c. 34, s. 4. *For notes see pp. 410-413.*

40. For every copy of drawings, the person applying shall pay such sum as the Commissioner considers a fair remuneration for the time and labour expended thereon by any officer of the Patent Office or of the department or person employed to perform such service. 35 V., c. 26, s. 35. *For note see p. 413.*

41. The said fees shall be in full of all services performed under this Act, in any such case, by the Commissioner or any person employed in the Patent Office. 35 V., c. 26, s. 36. *For note see p. 413.*

42. All fees received under this Act shall be paid over to the Minister of Finance and Receiver-General, and shall form part of the Consolidated Revenue Fund of Canada, except such sums as are paid for copies of drawings when made by persons not receiving salaries in the Patent Office. 35 V., c. 26, s. 37. *For note see p. 413.*

43. No person shall be exempt from the payment of any fee or charge, payable in respect of any services performed for such person under this Act; and no fee, when paid, shall be returned to the person who paid it except:—

(*a*) When the petition is not susceptible of being patented; or

(*b*) When the petition for a patent is withdrawn.

And in every such case the Commissioner may return the fee paid less the sum of ten dollars. 35 V., c. 26, s. 38. *For note see p. 414.*

(PART XIV. OF BOOK.)

44. The Government of Canada may, at any time, use any patented invention, paying to the patentee such sum as the Commissioner reports to be a reasonable compensation for the use thereof. 35 V., c. 26, s. 21. *For notes see pp. 414-417.*

45. No patent shall extend to prevent the use of any invention in any foreign ship or vessel, if such invention is not so used for the manufacture of goods to be vended within or exported from Canada. 35 V., c. 26, s. 47. *For note see pp. 417-418.*

46. Every person who, before the issuing of a patent, has purchased, constructed or acquired any invention for which a patent *is* afterwards obtained under this Act, shall have the right of using and vending to others the specific article, machine, manufacture or composition of matter patented and so purchased, constructed or acquired before the issue of the patent therefor, without being liable to the patentee or his legal representatives for so doing; but the patent shall not, as regards other persons, be held invalid, by reason of such purchase, construction or acquisition or use of the invention, by the person first aforesaid or by those to whom he has sold the same, unless the same was purchased, constructed, acquired or used, with the consent or allowance of the inventor thereof, for a longer period than one year before the application for a patent therefor—making the invention one which had become public and in public use. 35 V., c. 26, s. 48. *For notes see pp. 418-428.*

47. All specifications, drawings, models, disclaimers, judgments and other papers, except caveats, shall be open to the inspection of the public at the Patent Office, under such regulations as are adopted in that behalf. 35 V., c. 26, s. 44. *For notes see pp. 428-429.*

48. Clerical errors which occur in the framing or copying of any instrument in the Patent Office, shall not be construed as invalidating the same, but when discovered they may be corrected under the authority of the Commissioner. 35 V., c. 36. s. 45. *For notes see pp. 429-432.*

49. If any patent is destroyed or lost, a certified copy thereof may be issued in lieu thereof, upon the person who applied therefor paying the fees hereinbefore prescribed for office copies of documents. 35 V., c. 26, s. 49; the Patent Act (1886); 53 V., c. 13, s. 4 (1890). *For notes see pp. 432-433.*

50. Every Court, judge and person whomsoever shall take notice of the seal of the Patent Office and shall receive the impression thereof in evidence, in like manner as the impressions of the Great Seal are received in evidence, and shall also take notice of and receive in evidence, without further proof and without production of the originals, all copies or extracts certified under the seal of the Patent Office to be copies of or extracts from documents deposited in such office. 35 V., c. 26, s. 2, *part.* *For notes see pp. 433-434.*

51. No officer or employee of the Patent Office shall buy, sell or acquire or traffic in any invention or patent, or in any right to a patent; and every such purchase and sale, and every assignment or transfer thereof by or to any officer or employee, as aforesaid, shall be null and void, but this provision shall not apply to any original inventor, or to any acquisition by bequest. 35 V., c. 26, s. 4, *part.* *For notes see pp. 434-435.*

52. The Commissioner may, from time to time, subject to the approval of the Governor-in-Council, make such rules and regulations, and prescribe such forms, as appear to him necessary and expedient for the purposes of this Act,—and notice thereof shall be given in *The Canada Gazette;* and all documents, executed in conformity with the same and accepted by the Commissioner, shall be held valid, so far as relates to proceedings in the Patent Office. 35 V., c. 26, s. 3. *For notes see pp. 435-441.*

53. The Commissioner shall cause a report to be prepared annually and laid before Parliament of the proceedings under this Act, and shall, from time to time, and at least once in each year, publish a list of all patents granted, and may with the approval of the Governor-in Council, cause such specifications and drawings as are deemed of interest, or essential parts thereof, to be printed, from time to time, for distribution or sale. 35 V., c. 26, s. 5; 36 V., c. 44, s. 1. *For notes see pp. 441-445.*

(PART XV. OF BOOK.)

OFFENCES AND PENALTIES.

54. Every patentee under this Act shall stamp or engrave on each patented article sold or offered for sale by him the year of the date of the patent applying to such article, thus: "Patented, 1886," or as the case may be; or when, from the nature of the article, this cannot be done, then by affixing to it, or to every package wherein one or more of

such articles is or are enclosed, a label marked with a like notice; and any such patentee selling or offering for sale any such patented article not so marked, or not enclosed in a package so marked, shall be liable to a penalty not exceeding one hundred dollars, and in default of the payment of such penalty, to imprisonment for a term not exceeding two months. 38 V., c. 14, s. 3. *For notes see pp. 446-449.*

55. Every person who writes, paints, prints, moulds, casts, carves, engraves, stamps or otherwise marks upon anything made or sold by him, and for the sole making or selling of which he is not the patentee, the name or any imitation of the name of any patentee for the sole making or selling of such thing, without the consent of such patentee,—or who, without the consent of the patentee, writes, paints, prints, moulds, casts, carves, engraves, stamps, or otherwise marks upon anything not purchased from the patentee, the words "patent," "letters patent," "Queen's Patent," "patented," or any word or words of like import, with the intent of counterfeiting or imitating the stamp, mark, or device of the patentee, or of deceiving the public and inducing them to believe that the thing in question was made or sold by or with the consent of the patentee or his legal representatives; or who offers for sale as patented any article not patented in Canada, for the purpose of deceiving the public, is guilty of a misdemeanour, and liable to a fine not exceeding two hundred dollars, or to imprisonment for a term not exceeding three months, or to both. 35 V., c. 26, s. 50. *For notes see pp. 449-455.*

56. Every person who wilfully makes or causes to be made any false entry in any register or book, or any false or altered copy of any document relating to the purposes of this Act, or who produces or tenders any such false or altered document in evidence, knowing the same to be such, is guilty of a misdemeanour, and shall be liable to be punished by fine and imprisonment accordingly. 35 V., c. 26, s. 51. *For notes see p. 455.*

(PART XVI. OF BOOK.)

PATENTS ISSUED UNDER FORMER ACTS.

57. Every patent issued under any Act of the Parliament of Canada, or of the legislature of the late Province of Canada, or of the legislature of any Province now forming part of Canada, shall remain in force for the same term and for the same extent of territory as if the Acts under which they were issued had not been repealed, but subject to the provisions of this Act in so far as the same are applicable to them:

2. The Commissioner may, upon the application of the patentee named in any such patent, who is the inventor of the subject matter of the patent, if the subject matter of the patent has not been known or used, and has not, with the consent of the patentee, been on sale in any of the other Provinces of Canada, issue, on payment of the proper fees

in that behalf, a patent under this Act, extending such Provincial patent over the whole of Canada, for the remainder of the term mentioned in the Provincial patent. 35 Vic, c. 26, s. 32;—38 V., c. 14, s. 6. *For notes see pp. 456-457.*

58. Every patent heretofore issued by the Patent Office in respect of which the fee required for the whole or for any unexpired portion of the term of fifteen years, has been duly paid according to the provisions of the law under which such patent was issued in that behalf, has been and shall be deemed to have been issued for the terms of fifteen years, subject, in case a partial fee only has been paid, to its ceasing on the same conditions in which patents hereafter issued are to cease under the operation of this Act. 46 V., c. 19, s. 1, *part.* *For notes see pp. 457-459.*

59. Every patent issued prior to the eighth day of April, one thousand eight hundred and seventy-five, under the Acts respecting patents then in force in Canada, shall extend over the Province of Prince Edward Island for the remainder of the term mentioned therein. 38 V., c. 14, s. 4, *part.* *For notes see pp. 459-460.*

SECTIONS 8 AND 9 OF 55-56 VIC., C. 24 (1892).

Sec. **8.** (Patent Act Amendment of 1892.) On each application for a patent, a thorough and reliable examination shall be made by competent examiners to be employed in the Patent Office for that purpose. 55-56 V., c. 24, s. 8. *For note see p. 460.*

Sec. **9.** (Patent Act Amendment of 1892.) This Act shall only apply to patents issued after the passing hereof: 55-56 V., c. 24, s. 9. *For note see p. 460.*

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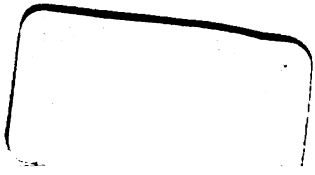
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